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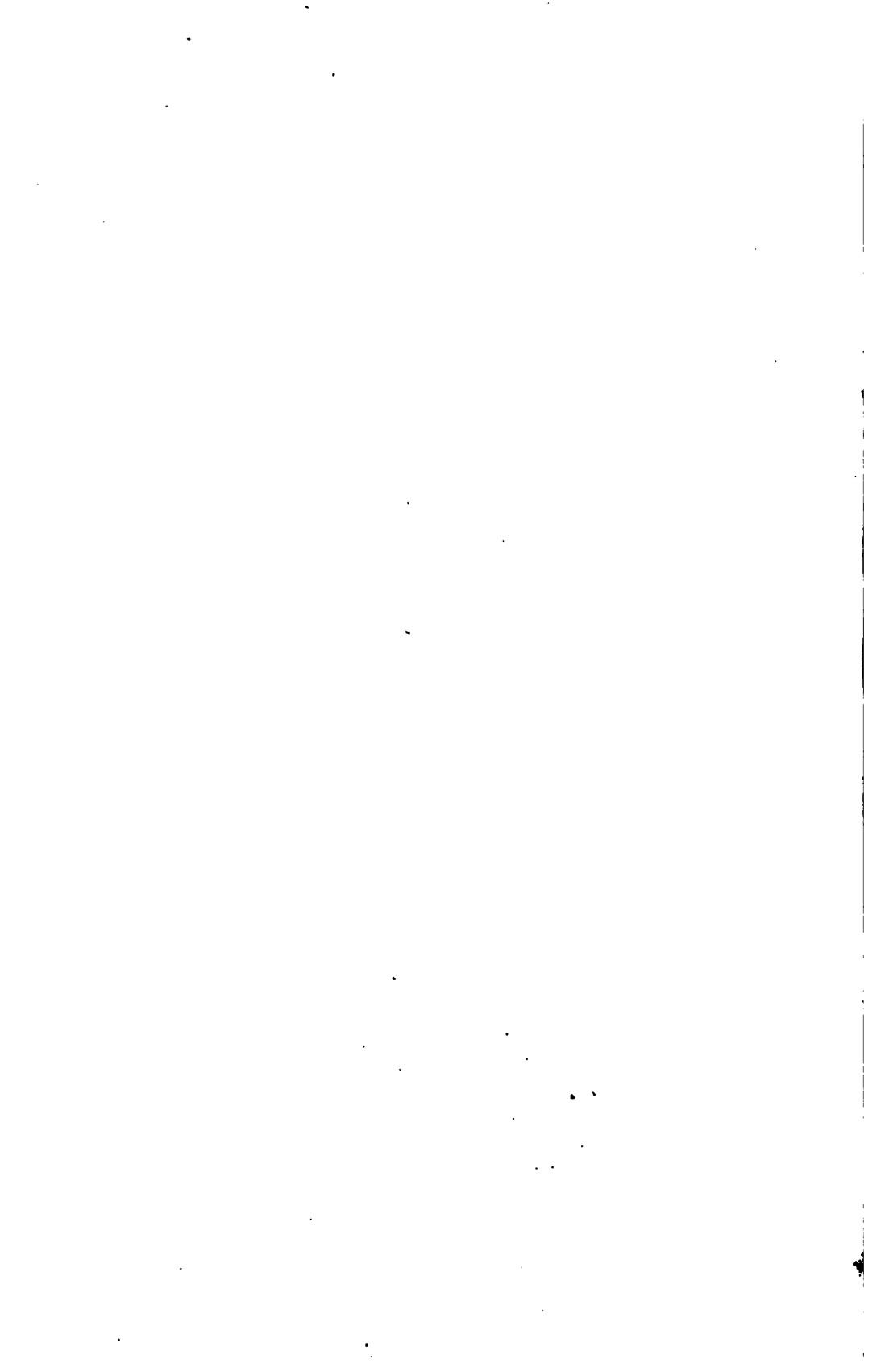
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BRODIX'S AMERICAN AND ENGLISH PATENT CASES.

VOL. VI.

DECISIONS
"ON THE LAW OF
PATENTS FOR INVENTIONS

RENDERED BY

THE UNITED STATES SUPREME COURT.

FROM THE BEGINNING,

15 HOWARD, - 21 HOWARD,
1853. 1858.

EDITED AND ANNOTATED

BY

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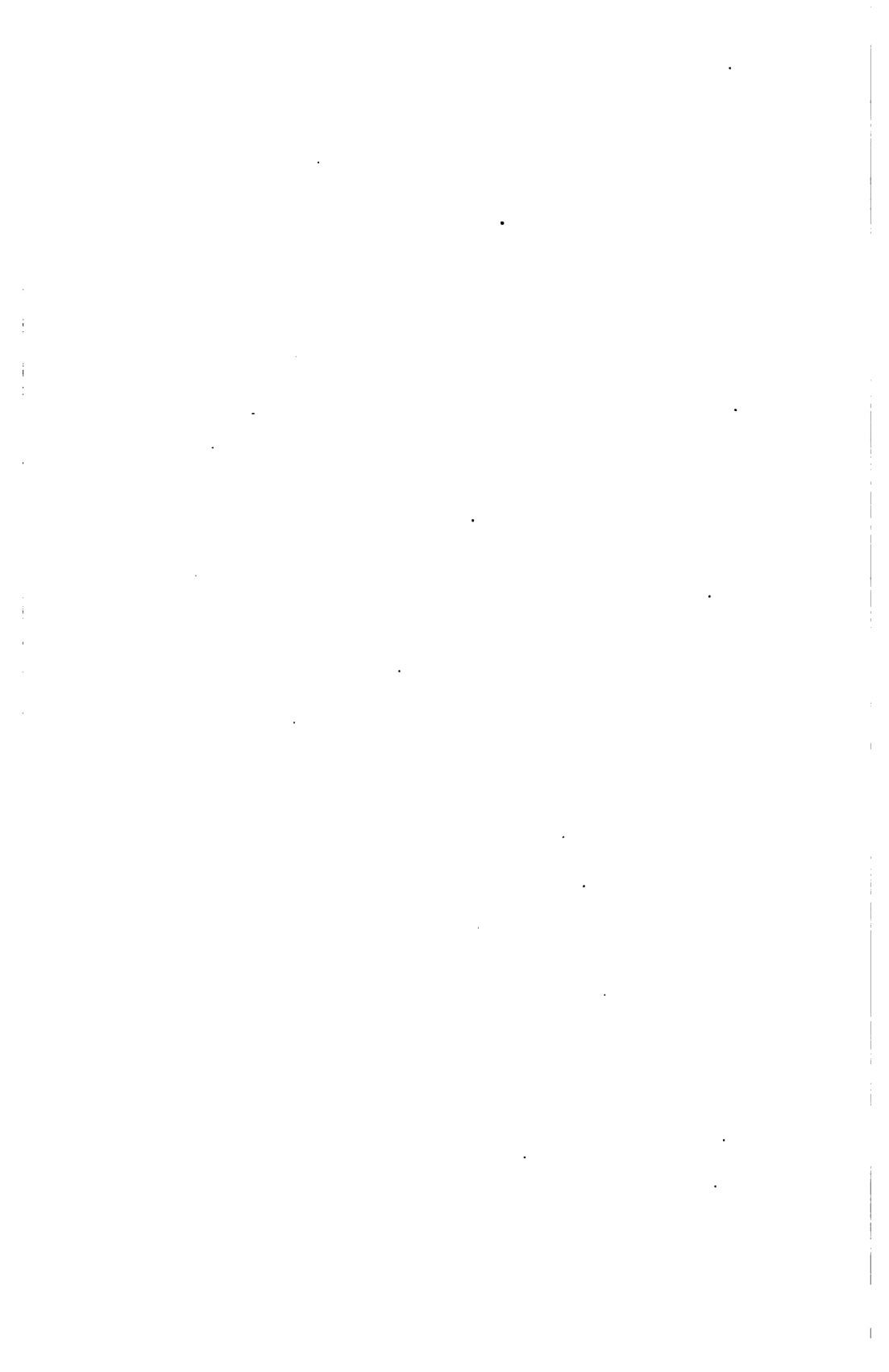


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TABLE OF ABBREVIATIONS
OF THE TITLES OF REPORTS AND WORKS OF LAW USED IN
THIS VOLUME.

- Abb. (C. C.) U. S.—Abbott's Circuit & District Courts.
Abb. N. C.—Abbott's New Cases (N. Y.).
Abb. Pat. Law.—Abbott's Patent Laws of all Nations.
Ad. & E.—Adolphus & Ellis, England Q. B.
Ad. & E. N. S.—Adolphus & Ellis, England Q. B., New Series.
Adolph. & Ellis.—Adolphus & Ellis, England Q. B.
Ala.—Alabama State Reports.
Allen.—Allen, Massachusetts Reports.
Amb.—Ambler, England Ch.
Am. L. J.—American Law Journal.
Am. & Eng.—American & English Patent Cases.
Atk.—Atkyn's England Ch.
B. & A.—Banning & Arden, Patent Cases, U. S.
Bald.—Baldwin, U. S. Circuit Court.
Barbour.—Barbour, New York Supreme Court.
Barbour's Ch. Pr.—Barbour's Chancery Practice.
Barn. & Ad.—Barnewall & Adolphus, England K. B.
Barn. & Ald.—Barnewall & Alderson, England K. B.
Barn. & Cres.—Barnewall & Cresswell, England K. B.
Beav.—Beavan, England.
Bing.—Bingham, England C. P.
Bissett on Part.—Bissett on Partnerships.
Black.—Black, U. S. Supreme Court.
Blackford.—Blackford, Indiana Reports.
Blatch.—Blatchford, U. S. Circuit Court.
Bligh.—Bligh, England.
Bos. & P.—Bosanquet & Puller, England C. P.
Boulenois *Traité des Statutes*.
Bouv.—Bouvier's Institutes of American Law.
B. & P.—Bosanquet & Puller, England C. P.
Bro. Ch.—Brown, England, Ch.
Brock.—Brockenborough, U. S. Circuit Court
Brod. & Bing.—Broderip & Bingham, England C. P.
Brodix.—Brodix's American & English Patent Cases.
Brunn. Col. C.—Brunner's Collected Cases, U. S. Circuit Court.
C. & H.—Coventry & Hughes' Digest.

TABLE OF ABBREVIATIONS.

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- C. & P.—Carrington & Paine, England N. P.
 Calv. Part.—Calvert's Parties to Suits in Equity.
 Camp.—Campbell, England N. P.
 Car. & Kir.—Carrington & Kirwan, England N. P.
 Car. & Payne.—Carrington & Payne, N. P. England.
 C. D.—Commissioner of Patents Decisions, U. S.
 Chit. Stat.—Chitty's Statutes of Practical Utility.
 Clark & F.—Clark & Finelly's House of Lords Reports.
 Cliff.—Clifford, U. S. Circuit Court.
 Collyer on Part.—Collyer on Partnership.
 Comstock.—Comstock, New York Reports.
 Compt., Mees. & Roe.—Compton, Meeson & Roscoe, England.
 Cond. Rep.—Peters' Condensed Reports, U. S. Supreme Court.
 Conk. Treat.—Conkling's Treatise of Jurisdiction and Practice of U. S. Courts.
 Conn.—Connecticut State Reports.
 Cow.—Cowen, New York Reports.
 Coxe.—Coxe's New Jersey Reports.
 Cranch.—Cranch, U. S. Supreme Court.
 Cromp. & J.—Crompton & Jervis' English Exchequer Reports.
 Ct. of Clms.—Court of Claims, U. S.
 Curt.—Curtis on Patents, U. S.
 Curt. Com.—Curtis' Commentaries on U. S. Courts.
 Curtis on Pats.—Curtis on Patents, U. S.
 Dall.—Dallas, U. S. & Pennsylvania Reports.
 Dana.—Dana, Kentucky Reports.
 Dan'l.—Daniell's Ex. & Eq. Reports.
 Daniell's Ch. P.—Daniell's Chancery Pleading & Practice.
 Denio.—Denio, New York Reports.
 Dev. & Bat.—Devereux & Battle, North Carolina Reports.
 Duer.—Duer, New York Superior Ct. Reports.
 Eden on Injunctions.—Eden on Injunctions, England.
 El. & B.—Ellis & Blackburn, England Q. B.
 Ellis & Blackburn.—Ellis & Blackburn, England Q. B.
 Eng. L & Eq.—English Law & Equity Reports (American Reprint).
 Exch. R.—Exchequer Reports, England.
 Fed. Rep.—Federal Reporter, U. S. Circuit Reports.
 Fish.—Fisher's Patent Cases, U. S.
 Fish. Pat. Rep.—Fisher's Patent Report, U. S.
 Flip.—Flippin, U. S. Circuit Court.
 G. & J.—Gill & Johnson, Maryland Reports.
 Gale.—Gale, England Exch.
 Gall.—Gallison, U. S. Circuit Court.
 Gallis.—Gallison, U. S. Circuit Court.
 Gill.—Gill's Maryland Reports.
 Godson on Pats.—Godson on Patents.
 Greenl. Ev.—Greenleaf's Law of Evidence.
 Hale's *De Jure Maris*.
 Hale's *Treatise de Portibus Maris*.
 Halstead.—Halstead, New Jersey Reports.

TABLE OF ABBREVIATIONS.

- Harding.—Harding, Kentucky Reports.
Hare.—Hare, England.
Harris.—Harris, Pennsylvania.
H. Blackst.—Henry Blackstone, England C. P.
Hill.—Hill, New York Reports.
Hindmarch.—Hindmarch on Patents, England.
Holmes.—Holmes, U. S. Circuit Court.
Holroyd on Pats.—Holroyd on Patents, England.
Holt, N. P.—Holt, England N. P.
How.—Howard, U. S. Supreme Court.
Hun.—Hun, New York Supreme Court.
Ir. Eq.—Irish Equity Reports.
Johns.—Johnson, New York.
Jur.—The Jurist, England.
Kent's Comm.—Kent's Commentaries, U. S.
Law. Rep.—Law Reporter.
Law & Equity Rep.—Law & Equity Reporter, New York.
L. ed.—Lawyer's Edition of U. S. Supreme Court Reports.
L. & E.—English Law & Equity Reports (American Reprint).
Leigh.—Leigh, Virginia Reports.
MacA.—MacArthur, Supreme Court of D. C.
MacA. P. C.—MacArthur's Patent Cases, U. S.
McAl.—McAllister, U. S. Circuit Court.
McL.—McLean, U. S. Circuit Court.
McLean.—McLean, U. S. Circuit Court.
Mas.—Mason, U. S. Circuit Court.
Mason.—Mason, U. S. Circuit Court.
Mass.—Massachusetts Reports.
Mees. & W.—Meeson & Welsby, England Ex.
Merwin.—Merwin on Patentability of Inventions.
Mo.—Missouri State Reports.
Moo. & R.—Moody & Robinson, England N. P.
Moore.—Moore, England.
Ms. D. C.—Manuscript Cases, District of Columbia.
Munf.—Munford, Virginia Reports.
Myrne & Craig.—Myrne & Craig, England Ch.
Nev. & M.—Nevile & Manning, England K. B.
N. H.—New Hampshire Reports.
N. Y.—New York Court of Appeals.
O. G.—Official Gazette of U. S. Patent Office.
Ohio.—Ohio State Reports.
Ont. App. R.—Ontario Ct. of Appeals, Canada.
Ont. Rep.—Ontario Reports, Canada.
Op. of Atty-Gen.—Opinions of Attorney-Generals, U. S.
Paige.—Paige, New York Chancery Reports.
Paine.—Paine, U. S. Circuit Court.
Palmer's Prac.—Palmer's Practice in House of Lords on Appeals & Writs of Error.
Pet.—Peters, U. S. Supreme Court.

TABLE OF ABBREVIATIONS.

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- Peters C. C. R.—Peters, U. S. Circuit Court Reports.
Phila. R.—Philadelphia Reports.
Phil. Ch.—Phillipa, England Chancery.
Phil. on Pats.—Phillips on Patents.
Phillim. Int. Law.—Phillimore's International Law.
Phillips on Pats.—Phillips on Patents.
Pick.—Pickering, Massachusetts, Vols. 18-41.
Pitts. R.—Pittsburg Reports.
Price.—Price, England Exchequer.
Rand.—Randolph, Virginia Reports.
Rep.—The Reporter, U. S.
Robb.—Robb, U. S. Patent Cases.
Seaton's Forms of Decrees.—Seaton's Forms of Decrees.
Sedgwick on Damages.—Sedgwick on Damages.
Simon N. S.—Simon, England, New Series.
S. & R.—Sergeant & Rawle's Pennsylvania Reports.
South.—Southard, New Jersey Reports.
Stark.—Starkie, England N. P.
Starkie.—Starkie, England N. P.
Story.—Story, U. S. Circuit Court.
Story on Agency.—Story on Agency.
Story Com.—Story's Commentaries.
Story's Con. Laws.—Story on Conflict of Laws.
Story's Eq. Jur.—Story's Equity Jurisdiction, U. S.
Sumn.—Sumner, U. S. Circuit Court.
Taney.—Taney, U. S. Circuit Court.
Turner & Venable Ch. Prac.—Turner & Venable Chancery Practice.
Tyrn.—Tyrnhitt, England Ex.
Uguart's Prac.—Uguart's Practice in House of Lords on Appeals & Writs of Error.
Ure's Dict. of Arts.—Ure's Dictionary of Arts.
U. S.—United States Supreme Court Reports.
Vattel.—Vattel, Law of Nations.
Vaughn.—Vaughn, England C. P.
Vern.—Vernon, England Ch.
Vernon.—Vernon, England Ch.
Ves.—Vesey, England Ch.
Ves. Jr.—Vesey, Jr., England.
Vesey & B.—Vesey & Beames, England Ch.
Walker on Pats.—Walker on Patents.
Wall.—Wallace, U. S. Supreme Court.
Wall. Jr.—Wallace, Jr., U. S. Circuit Court.
Wash.—Washington, U. S. Circuit Court.
Watts & Serg.—Watts & Sergeant, Pennsylvania Reports.
Web. P. C.—Webster's Patent Cases, England.
Web. on Pats.—Webster on Patents.
Web. on Sub. Mat.—Webster on Subject-matter, England.
Wend.—Wendell, New York State Court.
West. L. J.—Western Law Journal, U. S.

TABLE OF NAMES OF JUSTICES.

W. H. & Gord.—Welsby, Hurlstone & Gordon, England Exch.
 Whar. Dig.—Wharton's Digest.
 Whart.—Wharton, Pennsylvania Reports.
 Wheat.—Wheaton, U. S. Supreme Court.
 Wheat. Law of Nations.—Wheaton's History of the Law of Nations.
 Whit.—Whitman's U. S. Supreme Court Patent Cases.
 W. & M.—Woodbury & Minot, U. S. Circuit Court.
 Wood. & Minot.—Woodbury & Minot, U. S. Circuit Court.
 W. Va.—West Virginia Reports.
 You. & Coll. Ch.—Younge & Collyer, England Ch.
 Young & Jervis —Young & Jervis, England Exch.

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DECISIONS
or
THE SUPREME COURT
or
THE UNITED STATES
■■■
PATENT CASES.

FRANCIS O. J. SMITH, PLAINTIFF, *v.* HEMAN B. ELY, HENRY O'REILLY, ROBERT W. McCOY, THOMAS MOODIE, MICHAEL B. BATEHAM, LINCOLN GOODALE, WRAY THOMAS, ALBERT B. BUTTLES, AND ROBERT NEIL.

15 How. 187-142. Dec., 1858.

[Bk. 14, L. ed. 634; 1 Whit. 838.]

1. The questions which go to the merits having been fully heard and decided in *O'Reilly v. Morse*, 15 How. 62 [5 Am. & Eng. 483], the motion to argue the points certified overruled and the case remanded to the Circuit Court (p. 7).

[Citations in the opinion of the Court:]

(1) *O'Reilly v. Morse*, 15 How. 62; 5 Am. & Eng. 483, p. 7.

THIS cause came up from the Circuit Court of the United States for the District of Ohio, upon a certificate of division in opinion between the judges thereof.

An action was brought by Smith, as the assignee of Morse and Vail, against Ely, O'Reilly, and others, for an

Statement of the case.

infringement of Morse's patent-rights to the telegraph, which are particularly set forth in the report of the preceding case.

The first count of the declaration was upon the patent of 1840, surrendered and reissued in 1846.

The second count was upon the patent for improvements in transmitting and recording intelligence by the use of the motive-power of electricity. Both of these patents were surrendered, and reissued in 1848.

The defendants filed eighteen pleas. On the second, third, fourth, fifth, and tenth, the plaintiff took issue. He demurred to the remaining pleas, and upon some of these demurrers the court were divided.

All that need be stated in explanation of the case will be to state the difference of opinion and refer to the pleas.

And afterwards, to wit, on the 23d day of October, being in the year and at the time of said court last mentioned, "this cause came on to be heard at the present term upon the demurrers filed by the plaintiff to the sixth, seventh, eighth, ninth, eleventh, twelfth, thirteenth, fourteenth, fifteenth, sixteenth, seventeenth, and eighteenth special pleas of the defendants. And thereupon, the arguments of counsel being heard, and due deliberation being had, the opinion of the judges of said court were divided as to the following questions, to wit:

I. Upon the demurrer to the sixth and seventh pleas respectively, whether the said letters patent to the said Morse are void, for the reason that the same do not on their face respectively express that they are to run for fourteen years from the date of the patent issued to said Morse in the kingdom of France.

II. Whether, upon the demurrer to the eighth, ninth, and eighteenth pleas, said letters patent to said Morse assume, as to the matter alleged in said eighteenth plea, to patent a principle, or a thing which is not an art, machine, manufacture, or composition of matter, or any improvement on any art, machine, manufacture, or composition of matter; and if so, whether, and to what extent, said letters patent, or any part thereof, are void in consequence thereof;

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and also whether said pleas are bad, respectively, for the reason that they assume to answer certain material and substantial parts of the plaintiff's claim, without averring that there are no other material and substantial parts embraced in his claim, which can be distinguished from the other parts averred to be so claimed without right, and on which he would be entitled to recover.

III. Whether, upon the demurrers to the fourteenth and fifteenth pleas, said patent, issued April 11, 1846, and re-issued June 13, 1848, is void; and if so, to what extent; for the reason that it embraces, as a material and substantial part thereof, a material and substantial part of a former patent issued to said Morse.

IV. Whether, upon the demurrers to the eighth, ninth, fourteenth, and fifteenth pleas, said letters patent issued to said Morse are void, for the reason, as averred in said pleas, that he was not the original and first inventor of the several matters in said pleas respectively set forth; but the same had been, prior to said invention by said Morse, known and used in a foreign country.

The substance of these pleas was as follows:

6th. This plea alleges that on the 18th of August, 1838, Morse took out a patent in France for the same invention patented to him in his letters of June 20, 1840; but that the latter were made to run fourteen years from date, instead of fourteen years from the date of the French letters.

7th. This plea states the same as the sixth, and that Morse's French patent was issued more than six months next before he filed the specifications and drawings annexed to the letters patent of June 20, 1840.

Upon the demurrers to these two pleas the court were divided, as mentioned in the first question of division.

8th. The plea sets out with the patents of 1840, as reissued, and then alleges that "the use of the motive-power of the electric or galvanic current, however developed, for marking or printing intelligible characters, signs, or letters, at any distances," is a substantial and material part of the thing patented; and it states that Morse was not the original and first inventor or discoverer of the thing pat-

Statement of the case.

ented, but that the same was known before to one Dr. Steinheil, of Munich, and used on a line from Munich to Bogenhausen.

The principles claimed and patented in the letters of 1840, referred to in the eighth and ninth pleas, are as follows, to wit:

"What I specially claim as my invention and improvement, is making use of the motive power of magnetism, when developed by the action of such current or currents, substantially as set forth in the foregoing description of the first principal part of my invention, as means of operating, or giving motion to, machinery which may be used to imprint signals upon paper, or other suitable materials, or to produce sounds in any desired manner, for the purpose of telegraphic communication at any distances."

"Eighth. I do not propose to limit myself to the specific machine, or parts of machinery, described in the foregoing specification and claims; the essence of my invention being the use of the motive-power of the electric or galvanic current, which I call electro-magnetism, however developed, for marking or printing intelligible characters, signs, or letters, at any distances, being a new application of that power, of which I claim to be the first inventor or discoverer."

9th. In this plea, the defendants allege that the mode and process of propelling and connecting currents of electricity or galvanism, through two or more metallic conductors, is a substantial and material part of the thing patented in the letters of 1840; and they aver that Morse was not the original and first inventor or discoverer thereof, but the same was known to one Edward Davy, in England.

18th. In this plea, the defendants allege that "the use of motive-power of the electro-galvanic current, however developed, for marking and printing intelligible characters, signs, or letters, at any distances," is a substantial and material part of the thing patented, and is distinctly claimed by the patentee in the specification; and he avers that the thing so patented and claimed is not any art, machine, manufacture, or composition of matter, or any improvement on them.

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The demurrs to these three pleas raise the question secondly certified to this court.

14th. In this plea, the defendants sets out the patent of 1846, as reissued to, and states that "the combination of a pen lever, pen point or points, and roller," mentioned in the patent, is a substantial and material part of the thing patented; and they aver that it was before known, and formed a part of an electro-magnetic telegraph for which Morse had taken out letters patent in 1840.

15th. In this plea, the defendants allege that "the mode of combining two or more circuits of electricity or galvanism, mentioned and described in the specification annexed to the said letters patent as an improvement, is a substantial and material part of the thing patented;" and they aver that in electro-magnetic telegraphs, before known, modes of combining, on the same principle described in the specification, two or more circuits of electricity or galvanism existed, and formed a part thereof, to wit, in one patented to Morse, June 20, 1840; to Edward Davy, of London, July 4, 1838, by the Queen of Great Britain. This plea also states that Morse, in patent of 1846, does not specify and point out the improvement in the said mode of combining two or more circuits made by him, so as to distinguish the same from the said modes before known and patented by him and by Davy.

The third question certified to this court is raised by demurrs to these two pleas.

The fourth question is raised by demurrs to pleas eight, nine, fourteen, and fifteen, above set forth.

Mr. Chief Justice TANEY delivered the opinion of the court.

The plaintiff in error is the assignee, within a certain tract of country, of the two patents granted to Morse for his electro-magnetic telegraph, one in 1840, and the other in 1846, and both reissued in 1848. And this action was brought in the Circuit Court for the District of Ohio, for infringements of both of these patents, within the limits assigned to the plaintiff.

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The defendants did not proceed in their defense in the manner authorized by the Act of Congress, but pleaded the general issue, and seventeen special pleas. Upon some of these pleas issue was joined, and others were demurred to; and upon the argument of the demurrs the judges of the court were divided in opinion on the following questions, which they have certified for decision to this court:

"I. Upon the demurrer to the sixth and seventh pleas respectively, whether the said letters patent to the said Morse are void, for the reason that the same do not on their face respectively express that they are to run for fourteen years from the date of the patent issued to said Morse in the kingdom of France.

"II. Whether, upon the demurrer to the eighth, ninth, and eighteenth pleas, said letters patent to said Morse assume, as to the matter alleged in said eighteenth plea, to patent a principle, or a thing which is not an art, machine, manufacture, or composition of matter, or any improvement on any art, machine, manufacture, or composition of matter; and, if so, whether, and to what extent, said letters patent, or any part thereof, are void in consequence thereof; and also, whether said pleas are bad, respectively, for the reason that they assume to answer certain material and substantial parts of the plaintiff's claim, without averring that there are no other material and substantial parts embraced in his claim, which can be distinguished from the other parts averred to be so claimed without right, and on which he would be entitled to recover.

"III. Whether, upon the demurrs to the fourteenth and fifteenth pleas, said patent, issued April 11, 1846, and reissued June 13, 1848, is void; and, if so, to what extent; for the reason that it embraces, as a material and substantial part thereof, a material and substantial part of a former patent issued to said Morse.

"IV. Whether, upon the demurrs to the eighth, ninth, fourteenth, and fifteenth pleas, said letters patent issued to said Morse are void, for the reason, as averred in said pleas, that he was not the original and first inventor of the several matters in said pleas respectively set forth; but the

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same had been, prior to said invention by said Morse, known and used in a foreign country."

The questions certified, so far as they affect the merits of the case, have all been substantially decided in the case of *Morse et al. v. O'Reilly et al.* [5 Am. & Eng. 483], at the present term. But several questions are presented, by the certificate, upon the construction of the pleas and the extent of the admissions made by the demurrsers, and the legal effect of such admissions upon the plaintiff's right of action.

In relation to the questions which go to the merits, as they have been already fully heard and decided in the case above mentioned, they are not open for argument in this case ; and it would be a useless and fruitless consumption of time to hear an argument upon the technical questions alone ; for however the points of special pleading might be ruled by this court, they could have no material influence on the ultimate decision of the case, because, if it is found that errors in pleading have been committed by either party, injurious to his rights, an opportunity ought and would certainly be afforded him to correct them in some subsequent proceeding, so as to bring the real points in controversy fairly before the court.

For these reasons, the motion of the counsel for the defendants, for leave to argue the points certified, is overruled, and the case remanded to the Circuit Court.

Under such circumstances, we deem it proper to remand the case, without argument, to the Circuit Court for the District of Ohio, where either party may amend his pleadings, and where the defendants, if they can distinguish their case from that above mentioned, will have an opportunity of being heard.

ORDER. This cause came on to be heard on the transcript of the record from the Circuit Court of the United States for the District of Ohio, and on the points or questions on which the judges of the said Circuit Court were opposed in opinion, and which were certified to this court for its opinion agreeably to the acts of Congress in such

Notes and Citations.

case made and provided; and its appearing to this court that the said questions, so far as they affect the merits of the case, have been substantially decided by this court, at this term, in the case of O'Reilly *et al.* v. Morse *et al.*, it is thereupon now here ordered and adjudged by this court, that this cause, without argument, be, and the same is hereby, remanded to the said Circuit Court, with directions to permit either party to amend his pleadings, and also to allow the defendants an opportunity to distinguish their case, if they can, from that above referred to.

Patents in suit:

- No. 1,647. Morse, S. F. B. June 20, 1840. Electric Telegraph.
Reissue No. 79, January 15, 1846. Reissue No. 117, June
13, 1848, *a.**
No. 4,453. Morse, S. F. B. April 11, 1846. Electric Telegraph.
Reissue No. 118, June 18, 1848, *b.*

OTHER SUITS ON SAME PATENT:

- Smith *v.* Selden, 1849. 1 Blatchf. 475; Fish. Pat. Rep. 298, *a, b.*
Smith *v.* Ely, 1849. 5 McL. 76; Fish. Pat. Rep. 339, *a, b.*
Smith *v.* Clark, 1850. 3 Am. L. J. 155; 1 Brunner's, Col. C.,
345, *b.*
Smith *v.* Downing, 1850. 1 Fish. 64, *a, b.*
Morse *v.* Bain, 1851. 9 West. L. J., 106, *b.*
French *v.* Rogers, 1851. 1 Fish. 133, *a.*
Smith *v.* Cummings, 1852. 1 Fish. 152, *a.*
O'Reilly *v.* Morse, 1853. 15 How. 62; 1 Whit. 763 [5 Am. &
Eng. 483], *a, b.*
Clum *v.* Brewer, 1855. 2 Curt. 506, *a.*
Western Telegraph Co. *v.* Magnetic Telegraph Co., 1858. 21
How. 456, *a.*
Western Telegraph Co. *v.* Penniman, 1858. 21 How. 460, *a.*

* The letter *a* or *b* following the patent is repeated after the title of the case to indicate that the suit was on that particular patent.

Dec., 1853.]

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Cited:

IN TEXT-BOOKS:

2 Abb. Pat. Law, 1886, pp. 63, 64.

Statement of the case.

ELIJAH PHELPS, PLAINTIFF IN ERROR v.
JACOB MAYER.

15 How. 160-161. Dec., 1858.

[Bk. 14, L. ed. 643; 1 Whit. 844.]

Bill of exceptions. Transcript of record.

1. Where the verdict was rendered on December 13, and the bill of exceptions was filed on the next day and no exceptions were taken on the trial, *held* there were no exceptions before the court (p. 11).
2. To make a bill of exceptions valid, it must appear by the transcript, not only that the instructions were given or refused at the trial, but also that the party who complains of them excepted to them while the jury were at the bar (p. 11).
3. The bill of exceptions need not be drawn out in form and signed before the jury retires, but it must be taken in open court, and must appear, by the certificate of the judge, who authenticates it, to have been so taken (p. 12).

[Citations in the opinion of the Court:]

(1) Sheppard v. Wilson, 6 How. 265, p. 12.

(Mr. Justice CURTIS did not sit in this cause, having been of counsel for the patentee.)

THIS case was brought up by writ of error from the Circuit Court of the United States for the District of Indiana.

It is not necessary to state either the facts or arguments of the case, inasmuch as it went off upon a point of practice.

It was argued by Mr. Ewing, for the plaintiff in error, and by Mr. Jernegan, for the defendant in error.

Mr. Jernegan thus noticed the point upon which the case went off:

A preliminary objection arises. It appears from the record that the verdict was rendered on the 13th of Decem-

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ber, and the bill of exceptions filed on the 14th. No exceptions were taken on the trial. It is therefore too late now to object to the instructions of the court, or its refusal to give the instructions required. *Poole v. Lessee of Fleeger*, 11 Peters, 185; *Compart v. Hedges*, 6 Blackford, 417; *Cully v. Doe*, 11 Adolph. & Ellis, 1008, note.

Mr. Chief Justice TANEY delivered the opinion of the court.

This action was brought by the plaintiff in error against the defendant in the Circuit Court of the United States for the District of Indiana, for the infringement of the plaintiff's rights under a patent granted to him for a new and useful improvement in the application of hydraulic power. The case was submitted to a jury under certain directions from the court, and the verdict and judgment were for the defendant.

This writ of error is brought for the purpose of revising this judgment; and the case has been fully argued upon the charge given by the Circuit Court, and also upon its refusal to give sundry directions to the jury which were requested by the plaintiff.

But although it appears, by the certificate of the judge, sent up as part of the record, that these instructions were given and refused at the trial, yet it also appears that no exception was taken to them while the jury remained at bar. The verdict was rendered on the 13th of December, and the next day the plaintiff came into court and filed his exception. There is nothing in the certificate from which it can be inferred that this exception was reserved pending the trial and before the jury retired.

The defendant in error now objects that this exception was too late, and is not therefore before this court upon the writ of error. We think this objection cannot be overcome.

It has been repeatedly decided, by this court, that it must appear by the transcript, not only that the instructions were given or refused at the trial, but also that the party who complains of them excepted to them while the jury

Order.

were at the bar. The statute of Westminster 2d, which provides for the proceeding by exception, requires, in explicit terms, that this should be done; and if it is not done, the charge of the court, or its refusal to charge as requested, forms no part of the record, and cannot be carried before the appellate court by writ of error. It need not be drawn out in form and signed before the jury retire; but it must be taken in open court, and must appear, by the certificate of the judge who authenticates it, to have been so taken.

Nor is this a mere formal or technical provision. It was introduced and is adhered to for purposes of justice; for if it is brought to the attention of the court that one of the parties excepts to his opinion, he has an opportunity of reconsidering or explaining it more fully to the jury. And if the exception is to evidence, the opposite party might be able to remove it by further testimony, if apprised of it in time.

This subject was fully considered in the case of *Sheppard v. Wilson*, 6 How., 275, where the cases previously decided in this court, affirming the rule above stated, are referred to.

There being, therefore, no exception before the court, and no error being assigned or appearing in the other proceedings, the judgment of the Circuit Court must be affirmed with costs.

ORDER. This cause came on to be heard on the transcript of the record from the Circuit Court of the United States for the District of Indiana, and was argued by counsel; on consideration whereof, it is now here ordered and adjudged by this court, that the judgment of the said Circuit Court in this cause be, and the same is hereby, affirmed with costs.

AFFIRMED WITH COSTS.

Cited:**IN SUPREME COURT OF UNITED STATES:**

U. S. v. Breitling, 1857. 20 How. 252; Bk. 15, L. ed. 900.
Suydam v. Williamson, 1857. 20 How. 438; Bk. 15, L. ed. 978.

Notes and Citations.

Dredge *v.* Forsyth, 1862. 2 Bl. 563; Bk. 17, L. ed. 253.
Mays *v.* Fritton, 1874. 20 Wall. 414. Bk. 22, L. ed. 389.
Stanton *v.* Embrey, 1877. 93. U. S. 548; Bk. 23, L. ed. 983.
U. S. *v.* Carey, 184. 110 U. S. 51; Bk. 28, L. ed. 67.

IN CIRCUIT COURTS:

Locke *v.* United States, September, 1866. 2 Cliff. 574.

IN TEXT-BOOKS:

Walker on Pats., 1883, p. 385.

Syllabus.

ARTEMAS L. BROOKS, IGNATIUS TYLER, WILLIAM W. WOODWORTH (AS ADMINISTRATOR OF WILLIAM WOODWORTH, DECEASED, AND ALSO AS GRANTEE), AND JAMES G. WILSON, APPELLANTS, *v.* JOHN FISKE AND NICHOLAS G. NORCROSS, DOING BUSINESS UNDER THE FIRM OF FISKE & NORCROSS.

15 How. 212-232. Dec., 1853.

[Bk. 14, L. ed. 665; 1 Whit. 846.]

Claim, why required. Construction of claims. Particular patent construed. Sustained and not infringed. Infringement of a combination. Fraud in reissuing.

1. Under Act 1836, § 6, the claim is required so that the public may know what they are prohibited from doing during the existence of the monopoly and what they are to have at the end of the term, as a consideration for the grant (p. 40).
2. The claim is not to be taken alone, but in connection with the specification and drawings, (p. 41).
3. Reissue No. 71. Woodworth, July 8, 1845. Planing mill
Construed to be for a combination of three elements (p. 43).
4. If a combination has three different known parts, and the result is proposed to be accomplished by the union of all the parts, arranged with reference to each other, the use of two of these parts only combined with a third, which is substantially different in the manner of its arrangement and connection with the others, is not the same combination, and no infringement (p. 45).
5. Procuring a reissue to cover the use of a device, not hinted at as necessary in the original claim and specification, raises a question of fraud committed on the public, by giving such matter the date of the original discovery, and thereby overreaching similar inventions made between the date of the original and reissued patent, (p. 46).

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6. The combination of three elements claimed in reissue No. 71, *held* not infringed by the different combination in Norcross' Patent No. 7,087, February 12, 1850, Planing Machine, which is a novel and independent invention (p. 47).

[Citations in the opinion of the Court:]

- (1) Hastings *v.* Brown, 1 Ellis & Blackburn 453, p. 40.
(2) Evans *v.* Eaton, 7 Wheat. 356; 4 Am. & Eng. 356, p. 40.

(Mr. Justice CURTIS did not sit in this cause, having been of counsel for the patentee.)

THIS was an appeal from the Circuit Court of the United States of the District of Massachusetts, sitting as a court of equity.

The appellants were the owners of the Woodworth patent for a planing-machine, the documents respecting which are set forth *in extenso* in the report of the case of Wilson *v.* Rousseau, 4 Howard, 646 [4 Am. & Eng. 436]. They filed a bill against the appellees for an injunction to restrain them from using a certain planing-machine, known as the Norcross machine, upon the ground that it was an infringement of their letters patent. Other matters were brought into the bill, which it is not material here to state.

In their answer, the appellees say that they have jointly, under the firm of Fiske & Norcross, and not otherwise, used one planing-machine, and no more, since December 25, 1849, at their mill in said Lowell, and nowhere else; but they believe, and therefore aver, that said machine is not the same in principle and mode of operation as the said Woodworth machine, but is substantially different therefrom, and contains none of the combinations claimed in the said Woodworth patent, but is a new and different invention, secured to said Norcross by letters patent, duly granted and issued to him by the United States of America, on the 12th day of February, in the year one thousand eight hundred and fifty; to which, or a duly certified copy thereof, they refer as an exhibit with this their answer, for the purpose of showing the substantial difference between said machines.

The answers then admit the filing of the bill of complaint charged in this bill to have been filed against them

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in 1844, and the making of the agreement recited in this bill; but they say that the machine referred to in that agreement, and which they were then using, was constructed according to a patent granted to one Hutchinson, on the 16th of July, 1839, but they admit that it embraced the first combination claimed in the Woodworth amended patent. The answers further contain the following averments:

"And these defendants, further answering, say that they believe, and therefore aver, that the said Woodworth patent is void in part, for want of novelty in the first claim therein, to wit, for the employment of rotating planes in combination with rollers, or any analogous device, to keep the board in place; the same thing, substantially, having been before patented in France, to wit, in 1817 and 1818, by Sir Lewis Victor, Joseph Mari Roguin, and in 1825 by Sir Leonore Thomas de Manneville, and described in the printed publication commonly called Brevets d'Inventions, vol. 23, pages 207 to 212, plates 27 and 28, and vol. 41, pages 111 to 116, plate 12; and these defendants refer also to the Hill machine, mentioned in the said patent of Norcross as publicly used by Joseph Hill, of Lynn, prior to the pretended invention of the said combination by the said William Woodworth, deceased."

"And these defendants further say that they believe, and therefore aver, that the said patent issued to William W. Woodworth, July 8, 1845, is not for the same invention as the original patent issued to William Woodworth, December 27, 1828, exclusive of the part disclaimed January 2, 1843, as alleged in the plaintiffs' bill."

"And these defendants, further answering, say that they are informed by numerous and able experts, and they verily believe, and therefore aver, that the machine used by them, and patented by said Norcross as aforesaid, is not an infringement of the said Woodworth patent, nor of any rights of the plaintiffs under the same; and they pray that the question of infringement may be tried by a jury, under the direction of the court."

To this answer, a general replication was filed.

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Much evidence was taken, and in March, 1852, the cause came on to be heard upon the bill annexed, general replication, and the proofs taken therein before the judge of the District Court, Mr. Justice Curtis having been of counsel in the case. The court adjudged that the machine made and used by the defendants, and complained of in the said bill, is not an infringement of the rights secured to the complainants under and by virtue of the letters patent reissued and granted to William W. Woodworth, administrator, on the 8th day of July, in the year one thousand eight hundred and forty-five, referred to in the said bill, and under and by virtue of the several mesne conveyances recited in the said bill; and thereupon the court doth order, adjudge, and decree that the complainants' said bill be, and the same hereby is, dismissed with costs.

The complainants appealed to this court.

(The specification and drawings of reissued letters patent No. 71, granted Woodworth, July 8, 1845, Planing Mills, was as follows:)

"The schedule referred to in these letters patent, and making part of the same:

"To all whom it may concern: Be it known that the following is a full, clear, and exact description of the method of planing, tonguing, and grooving plank or boards, invented by William Woodworth, deceased, and for which letters patent of the United States were granted to him on the 27th day of December, in the year one thousand eight hundred and twenty-eight, the said letters patent having been surrendered for the purpose of describing the same invention, and pointing out in what it consists, in more clear, full, and exact terms than was done in the original specification.

"Amended Specification."

"The plank or boards which are to be planed, tongued, or grooved are first to be reduced to a width, by means of circular saws, by reducing wheels, or by any other means. When circular saws are used for this purpose, two such saws should be placed upon the same shaft, on which they

W. Woodworth,

Wood Planing Machine,

No. 71,

Reissued July 8, 1845.

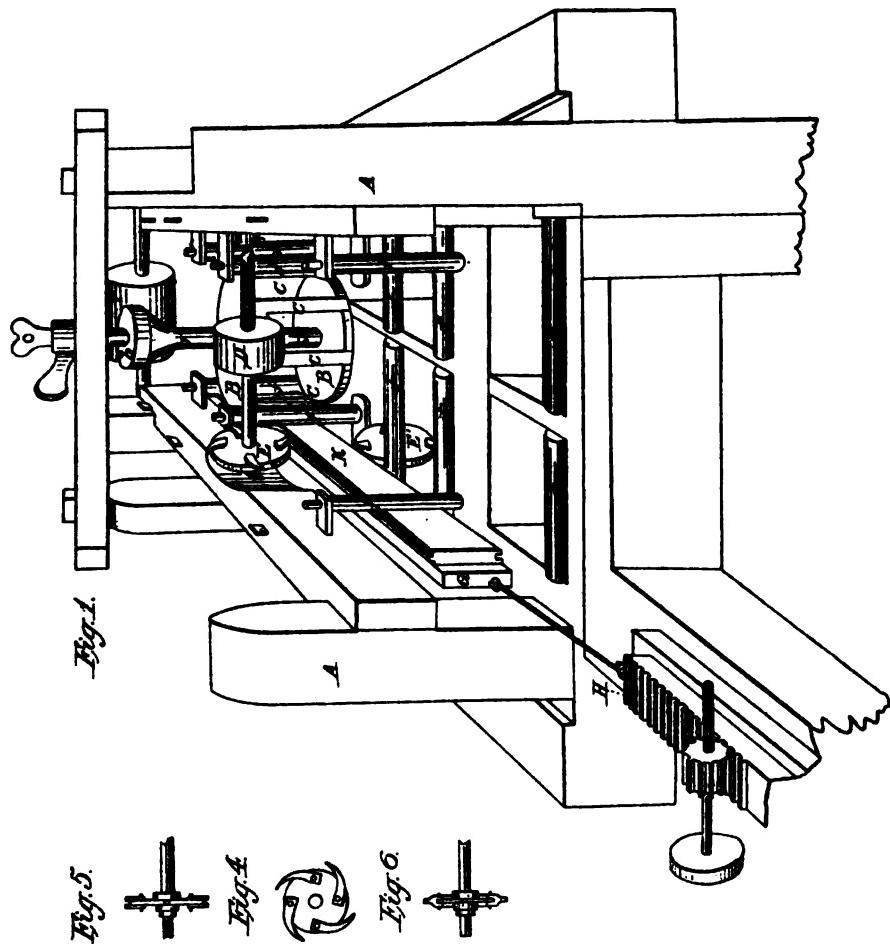


Fig. 5.



Fig. 4.



Fig. 6.



Fig. 3.

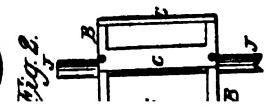
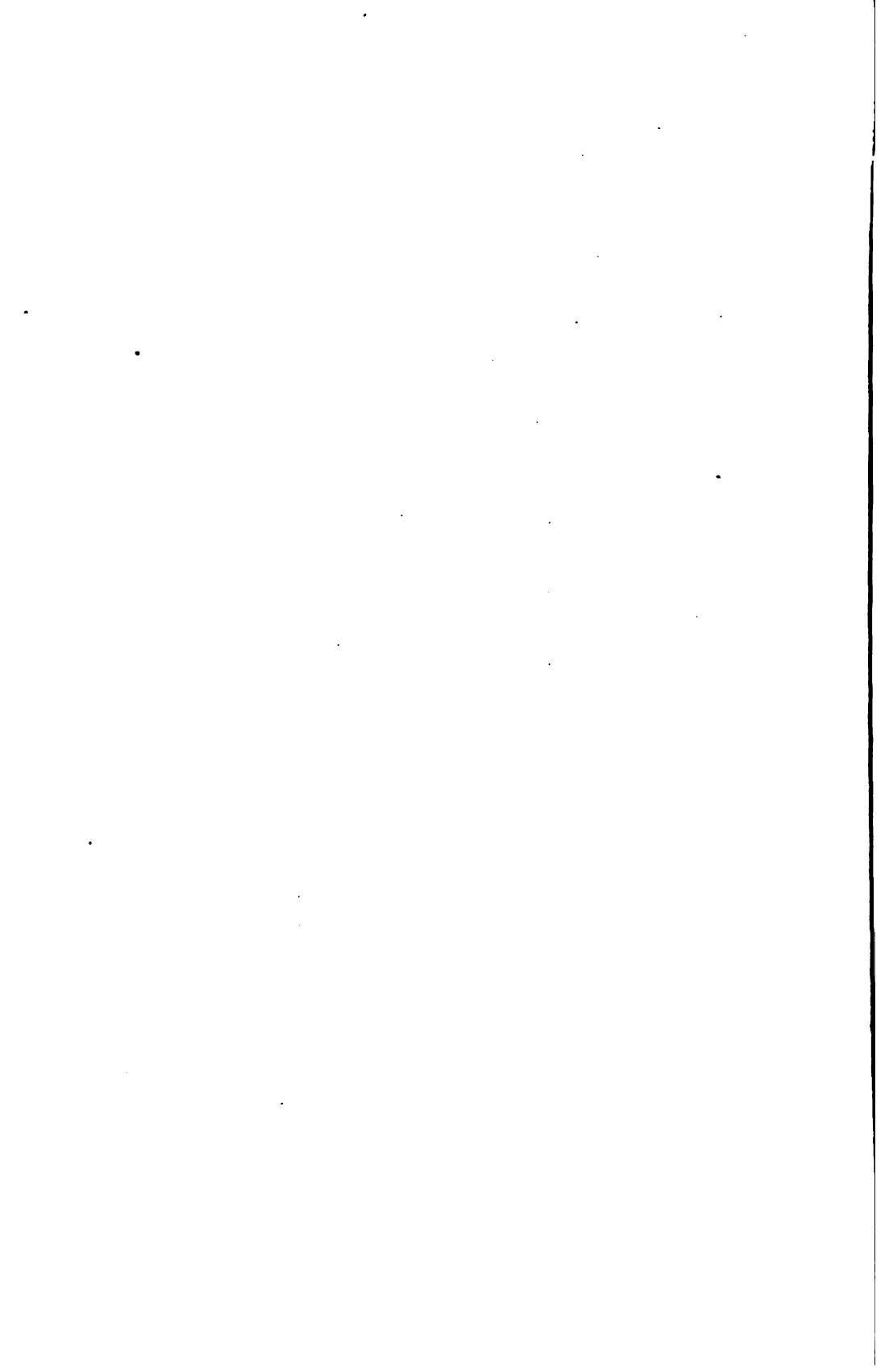


Fig. 2.



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are to be capable of adjustment, so that they may be made to stand at any required distance apart; under these, the board or plank is to be forced forward, and brought to the width required. This apparatus and process do not require to be further explained, they being well understood by mechanicians.

"When what has been above denominated reducing-wheels are used, these are to consist of revolving cutting-wheels, which resemble in their construction and action the planing and reducing wheel to be presently described; these are to be made adjustable, like the circular saws, but the latter are preferred for this purpose. The plank may be reduced to a width on a separate machine.

"When the plank or boards have been thus prepared, (on a separate machine), they may be placed on or against a suitable carriage, resting on a frame or platform, so as to be acted upon by a rotary cutting or planing and reducing wheel, which wheel may be made to revolve either horizontally or vertically, as may be preferred. The carriage which sustains the plank or board to be operated upon may be moved forward, by means of a rack and pinion, by an endless chain or band, by geared friction-rollers, or by any of the devices well known to machinists for advancing a carriage, or materials to be acted upon, in machines for various purposes. The plank or board is to be moved on towards the cutting edges of the cutters or knives on the planing-cylinder, so that its knives or cutters, as they revolve, may meet and cut the plank or board in a direction contrary to that in which it is made to advance; the edges of the cutters are, in this method, prevented from coming first into contact with its surface, and are made to cut upward from the reduced part of the plank toward said surface, by which means their edges are protected from injury by gritty matter, and the board or plank is more evenly and better planed than when moved in the reversed direction.

"After the board or plank passes the planing-cylinder, and as soon or fast as the planing cylinder has done its work on any part of the board or plank, the edges are

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brought into contact with two revolving cutter-wheels, one of which wheels is adapted to the cutting of the groove, and the other to the cutting of the two rebates that form the tongue. When the axis of the planing and reducing wheel stands vertically, the grooving and tonguing wheels are placed one above the other, with the plank edgewise between them. When the axis of the planing-wheel stands horizontally, these wheels are on the same horizontal plane with each other, standing on perpendicular spindles.

"The grooving-wheel consists of a circular plate fixed on an axis, and having one, two, three, four, or more cutters, which are to be screwed, bolted, or otherwise attached to it, the edges of which cutters project beyond the periphery of the plate to such distance as is required for the depth of the groove. Their thickness may be such as is necessary for its width. They are, of course, so situated as to cut the groove in the middle of the edge of the board, or as nearly so as may be required. The tonguing-wheel is similar in form to the grooving-wheel, but it has cutters on each of its sides, or otherwise so formed and arranged as to cut the two rebates which are necessary to the formation of the tongue.

"The grooving and tonguing cutters, at the same time, and by the same operation, reduce the board or plank to an exact width throughout. When the axis of the planing-wheel is placed vertically, the knives or cutters may be made to plane two planks at the same time, the planks being in this case moved in contrary directions, and so as to meet the edges of the revolving knives or cutters. When the machine is thus constructed, a second pair of grooving and tonguing wheels may be made to operate in the same way with those above described. A machine to operate upon a single plank or board, and having the axis of the planing-wheel placed horizontally, will, however, be more simple and less expensive than that intended to operate on two planks simultaneously.

"In the accompanying drawing, fig. 1 is a perspective representation of the principal operating parts of the machine, when arranged and combined for planing, tonguing,

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and grooving, and when so arranged as to be capable of planing two planks at the same time, the axis of the planing-wheel being placed vertically. A A is a stout, substantial frame of the machine, which may be of wood or iron, and may be varied in length, size, and strength, according to the work to be done. B B are the heads of the planing-cylinder, and C C the knives or cutters, which extend from one to the other of said heads, to the peripheries of which they may be attached, by means of screws. The knives, C C, with the faces forming a planing angle, may be placed in a line with the axis, J, of the cylinder, or they may stand obliquely thereto, as may be preferred; but in the latter case the edge should form the segment or portion of a helix; b represents a pulley near to the upper end of the axis, J; and I, a pulley, or drum, which may be made to revolve by horse, steam, or other motive power, and from which a belt may extend around the pulley, b, to drive the planing-cylinder and other parts of the machinery. G is the carriage which is represented as being driven forward by means of a rack and pinion, H; against this carriage, the plank, K, which is to be planed, tongued, and grooved, is placed, and is made to advance with it. It will be manifest, however, that the plank may be moved forward by other means, as, for example, by an endless chain or band passing around drums or chain-wheels, or by means of geared friction-wheels borne up against it. To cause the carriage and plank to move forward readily, there may be friction-rollers, f f f, placed horizontally, and extending under them; the rollers, f f f, which stand vertically, are to be made to press against the plank and keep it close to the carriage, and thus prevent the action of the cutters from drawing the plank up from its bed, in cutting from the planed surface upward; they may be borne against it by means of weights or springs, in a manner well known to machinists. In a single horizontal machine, the horizontal friction-rollers may be geared, and the pressure-rollers placed above them, to feed the board, with or without the carriages, a bed-plate being used directly under the planing-cylinder.

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"Fig. 2 is a separate view of the planing-cylinder, with its knives or cutters, and fig. 3 an end view of one of the heads. E E are the revolving cutters, or tonguing and grooving wheels, and D D whirls upon their shafts, which may be driven by bands, or otherwise, so as to cause said wheels to revolve in the proper direction.

"Fig. 4 is a side view of one of these wheels; fig. 5 is an edge view of the tonguing-wheel; and fig. 6 an edge view of the grooving-wheel, the latter being each shown with two cutters in place. The number of cutters on these wheels may be varied, but they are represented and furnished with four. The cutters may be fixed on the sides of circular plates, with their edges projecting beyond the periphery of said plate.

"The edges of the plank, as its planed part passes the planing-cylinder, are brought in contact with the above-described tonguing and grooving wheels, which are so placed upon their shafts as that the tongue and groove shall be left at the proper distance from the face of the plank, the latter being sustained against the planing-cylinder by means of the carriage or bed-plate, or otherwise, so that it cannot deviate, but must be reduced to a proper thickness, and correctly tongued and grooved.

"In fig. 1, above referred to, only one carriage and one pair of cutter-wheels are shown, it not being deemed necessary to represent those on the opposite side, they being similar in all respects.

"Fig. 7 represents the same machine, with the axis of the planing-cylinder placed horizontally, and intended to operate on one plank only at the same time. A A is the frame; B B, the heads of the planing-cylinder; C C, the knives or cutters attached to said heads. To meet the different thicknesses of the planks or boards, the bearings of the shaft or cylinder may be made movable, by screws or other means, to adjust it to the work; or the carriage or bed-plate may be made so as to raise the board or plank up to the planing-cylinder. E and E' are the revolving cutters, or tonguing and grooving wheels, which are placed upon vertical shafts, having upon them pulleys, D D, around

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which pass belts or bands from the main drum, I, to which a revolving motion may be given by any adequate motive power.

" From the drum, I, a belt, L, passes also around the pulley, b, on the shaft of the planing-cylinder, and gives to it the requisite motion. There may, in this machine, be a horizontal carriage, moved forward by a rack and pinion, in a manner analogous to that represented in fig. 1; but, in the present instance, the plank is supposed to be advanced by means of one or two pairs of friction or feed rollers, shown at f'f'; the uppermost, f'f', of the pairs of rollers may be held down by springs or weighted levers, which it has not been thought necessary to show in this drawing, as such are in common use. The lowermost of these rollers may be fluted, or made rough on their surfaces, so as to cause friction on the under side of the plank. M M' are pulleys on the axles of these lower rollers, which are embraced by bands, N N', which also pass around a pulley, O, on a shaft which crosses the frame, A A, and has a pulley, T, on it, which is embraced by the belt, P, on a pulley, Q, on the shaft of the main drum, I. These bands and pulleys serve to give motion to the feed-rollers, as will be readily understood by inspecting the drawing. R R are guide-strips, used in place of the rollers used for the same purpose, and also for bearing or friction rollers, when the machine is vertical, to direct one edge of the plank, and against its opposite edge. Any pressure may be used, equal to the weight of the board or plank, when worked in a vertical position. One of the cutter-wheels should be made adjustable, to adapt it to stuff of different widths.

" The planing-cylinder, and, likewise, the cutter, or tonguing and grooving wheels, may be constructed in the manner represented in figures 2, 3, 4, 5, and 6, and herein-before fully described. One of the heads of the planing-wheel may be made movable, to accommodate its width to the width of the boards or plank to be planed.

" The respective parts of this machine may be varied in size, as may also the velocity of the motion of the planing-cylinders and cutter-wheels; but the following has been

Statement of the case.

found to answer well in practice: The planing-cylinder, having four knives or cutters, may be twelve inches in diameter, and may make two thousand and upward revolutions in a minute. In a machine like that shown in fig. 7, the main drum, I, may be two feet in diameter, and may be driven with the speed of five hundred and upward revolutions in a minute. The pulleys on the planing-cylinder, and on the cutter-wheels, may be six inches in diameter. The plank should be moved forward at the rate of about one foot for every hundred revolutions of the cutter-wheel; and, of course, the diameter of the feed-rollers, and of the pulleys by which they are turned, must be so graduated as to produce this result. The size and speed of the above parts of this machine may be, in some degree, varied; but the above have been found to work well.

"Having thus fully described the parts, and combination of parts, and operation of the machine for planing, tonguing, and grooving boards or plank, and shown various modes in which the same may be constructed and made to operate, without changing the principle or mode of operation of the machine, what is claimed therein as the invention of William Woodworth, deceased, is the employment of rotating planes, substantially such as herein described, in combination with the rollers, or any analogous device, to prevent the boards from being drawn up by the planes, when cutting upward, or from the reduced or planed to the unplaned surface, as described.

"And, also, the combination of the rotating planes with the cutter-wheels for tonguing and grooving, for the purpose of planing, tonguing, and grooving boards, &c., at one operation, as described. And, also, the combination of the tonguing and grooving cutter-wheels for tonguing and grooving boards, and at one operation, as described.

"And, finally, the combination of either the tonguing or the grooving cutter-wheel for tonguing or grooving boards, &c., with the pressure-rollers, as described, the effect of the pressure-rollers in these operations being such as to keep the boards, &c., steady, and prevent the cutters from drawing the boards toward the centre of the cutter-wheels, while

Statement of the case.

it is moved through by machinery. In the planing operation, the tendency of the plane is to lift the boards directly up against the rollers; but in the tonguing and grooving, the tendency is to overcome the friction occasioned by the pressure of the rollers.

“WILLIAM W. WOODWORTH,
“Administrator of William Woodworth, deceased.”

“Witnesses:

“JAMES MILHOLLAND,
“CHAS. M. KELLER.”

NICHOLAS G. NORCROSS, OF MIDDLESEX COUNTY, MASSACHUSETTS, LETTERS PATENT No. 7087, DATED FEBRUARY 12, 1851.

The schedule referred to in these letters patent and making part of the same.

To all persons to whom these presents shall come:

Be it known that I, NICHOLAS G. NORCROSS, of the county of Middlesex, and State of Massachusetts, have invented an improved machine for planing boards, plank, or various other articles, and I do hereby declare that my said invention is fully described and represented in the following specification and accompanying drawings, letter, figures, and references thereof.

In the month of April, or thereabouts, of the year eighteen hundred and twenty-eight, or some time previous thereto, as I have been informed and as I believe it will appear by reference to certain affidavits filed in the United States Court at Baltimore, as well as in some other of the courts of the United States, one Hill (Daniel Hill, I think, was his name, although of this I am not positive), now or late of Stoneham, or thereabouts, in the State of Massachusetts, invented and put into successful operation a machine for planing boards. My invention, hereinafter described, contains an improvement on the said machine, and renders it capable of reducing or planing a board to an equal thickness throughout its length. The machine of the said Hill was capable of planing or reducing a

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board on one side, or removing from such side a stratum or layer of wood of an equal thickness, and so as to leave the board of unequal thickness previous to and at the time of its reduction by the said machine.

My invention also contributes greatly towards the protection from fire of any building in which my improved machine may be placed and operated, thereby not only effecting a reduction of risk of loss but a consequent reduction in the price of insurance. It has been very difficult, if not impossible, to procure insurance on planing mills on account of the constant danger of their taking fire, owing to the great amount of shavings made by the rotary planes, and such shavings being scattered about on the machinery, and over the floor of the room in which the planing machine may be at work. The destruction of planing mills by fire is such a common occurrence that most, if not all, insurance offices deem insurance on them so hazardous as to either cause them to utterly refuse to insure on them or to do so at a very exorbitant premium. As hereinbefore mentioned my invention renders such mills comparatively safe, and thereby not only protects property but life.

Before proceeding to describe my invention, I will remark that I deem it proper to point out the principal peculiarities of the said Hill's machine, and for this purpose I have represented it in figures 1 and 2, of the accompanying drawings, the former figure being a top view of it, while the latter is a vertical, central, and longitudinal section of it, as I have seen it exhibited in model.

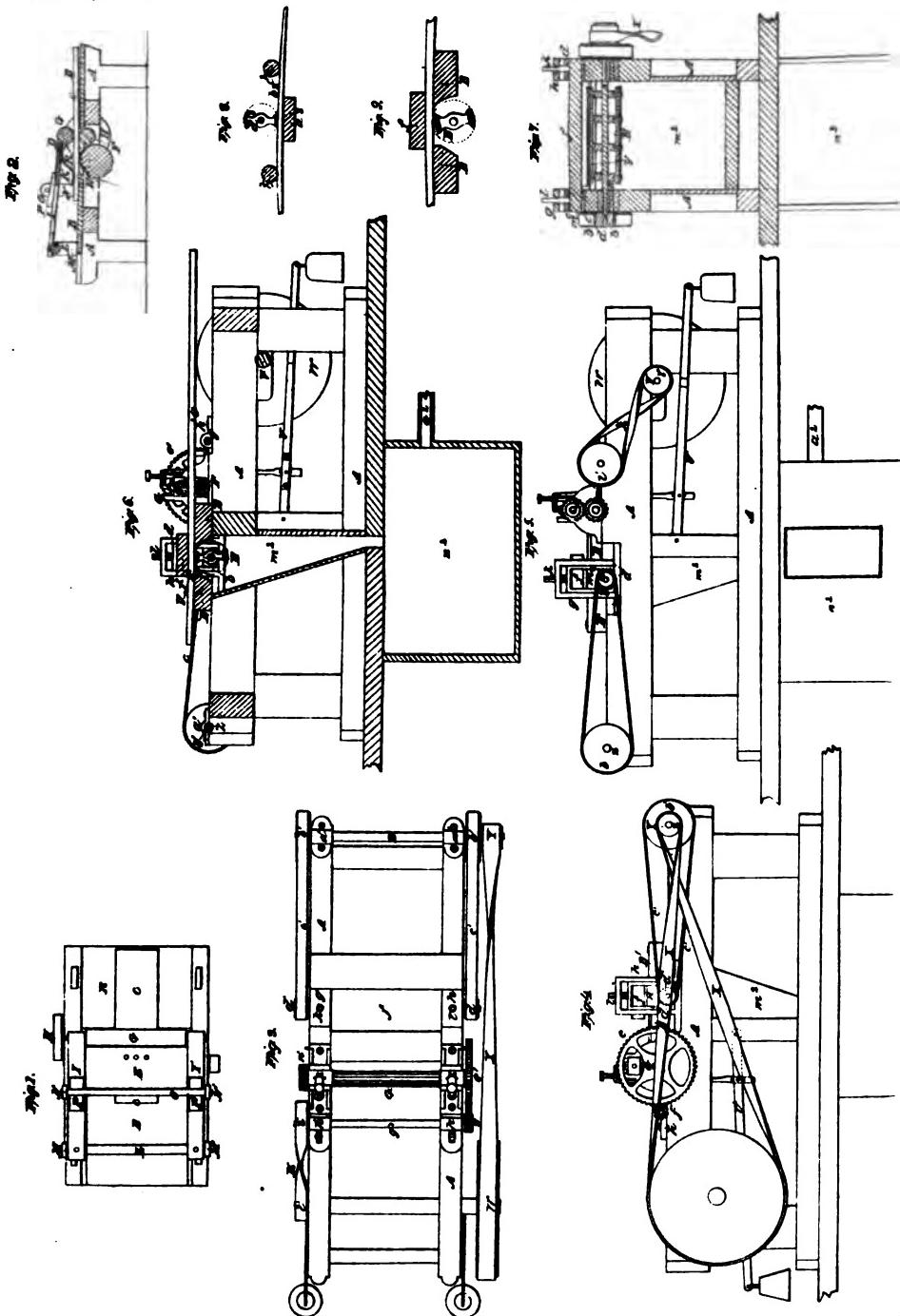
In the said figures, that is in either one or both of them, as the same may appear, A is a table, frame, or bench, of which B B is the top board or platform on which the plank or board to be planed or reduced, was made to rest and move during the operation of planing it, the said plank being represented at C. There was an opening transversely made through the platform B B, as seen at D. A rotary cutter or plane, E, was placed below and within the said opening, and made to revolve in such manner as to carry its cutter or cutters against the under side of the plank C, and reduce it or remove the wood therefrom.

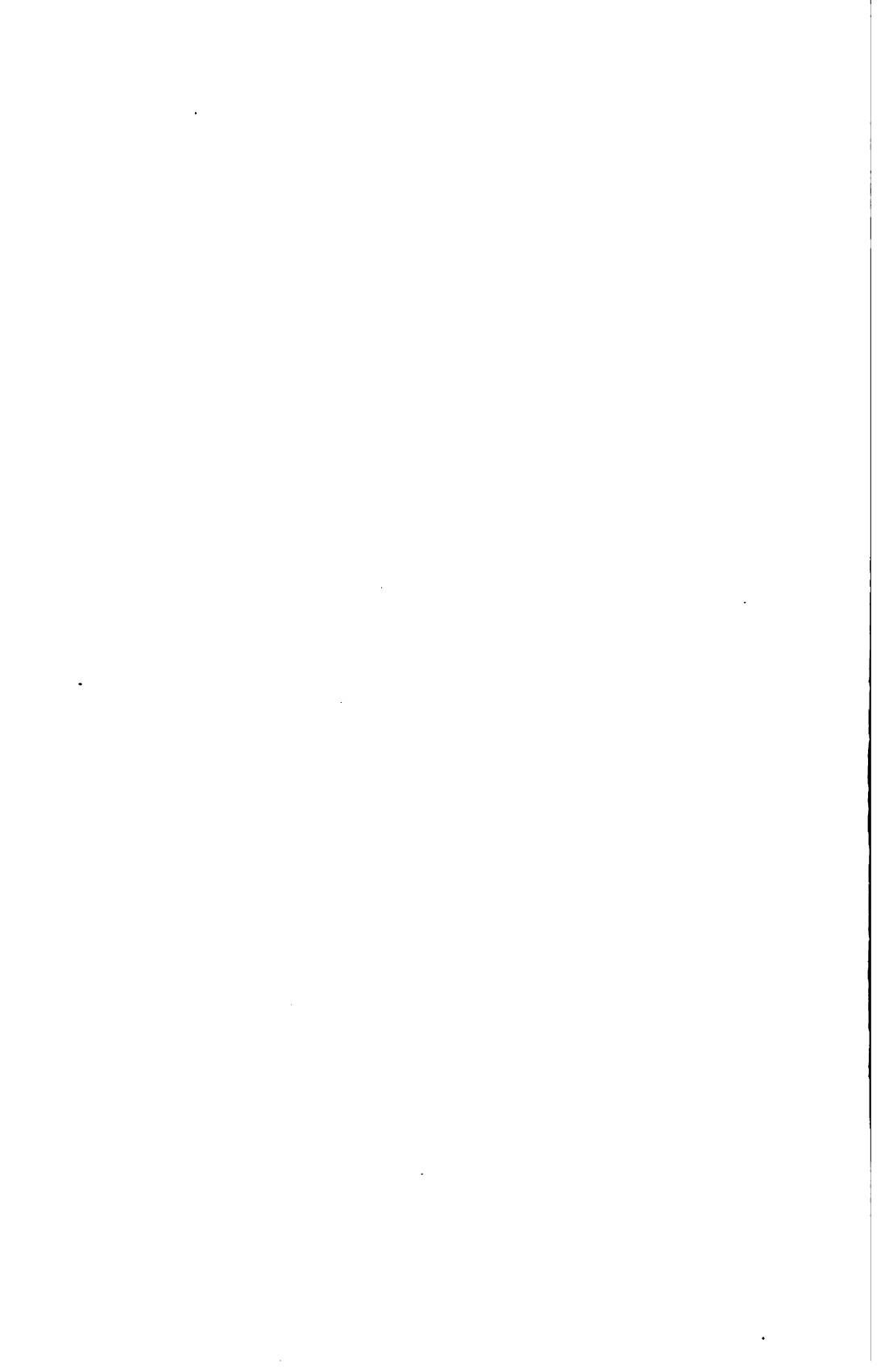
N.C. Norcross,

Wood Planing Machine,

No 7,087.

Patented Feb. 12, 1850.





Statement of the case.

F and G were two feed-rollers arranged transversely of the machine, and in other respects as seen in figs. 1 and 2. One of them, viz., F, was put in revolution by means of a pulley, H, and a band which proceeded from some suitable mover. The other roller, G, was arranged within a frame consisting of two wooden spring-bars, I I', united together by transverse bars or pieces, K, L, the latter of which bars had journals at its ends, which journals were supported and turned in bearings made in or on the tops of two posts or standards, M M', extended upwards from the frame, as seen in the drawings.

Two other posts or standards, N N', also extended up from the main frame and between the cylinder, G, and the posts, M M', the said two standards, N N', being connected together by a cross-bar, O, placed somewhat above the spring-bars, I I'. A wedge, P or P', was driven between the bar, O, and each of the spring-bars, and for the purpose of pressing the roller, G, down upon the plank, while this said plank rested on the lower roller, F. From the under-side of the transverse piece, K, a spring-plate, R, extended and rested, or was pressed upon, the plank, C, over or in the vicinity of the rotary-cutter. By means of the feed-rollers, F and G, the plank was advanced or moved upon the bench, B B, and over the rotary plane, the said plank being kept down upon the bench or from rising up therefrom by means of the pressure upon it of spring R, and the upper roller G, which yielded to the variations of thickness of the plank as it passed under them. The platform B B, preserved the board from being drawn downwards and towards the rotary-cutter in a direction from its planed to its unplaned surface. Such is or was in substance the machine of the said Hill, and having explained it I shall now proceed to specify my invention.

Fig. 3 of the accompanying drawings exhibits a top view of my improved planing machine. Fig. 4 is an elevation of one side of it. Fig. 5 is an elevation of the other side of it. Fig. 6 is a central, longitudinal and vertical section of it. Fig. 7 is a transverse and vertical section of it taken through the axis of the rotary planing-cylinder.

Statement of the case.

In the said drawings of figures 3, 4, 5, 6 and 7, A represents the main frame of the machine which may be constructed in any proper manner, and of wood or any other suitable material. B B' is a stationary platform or bed, fixed on the top part of the main frame, and made in two parts, B and B', placed at a suitable distance asunder to admit the rotary-plane, cylinder, or cutter, E, to be placed and made to operate between them. The said rotary-plane has its journals *a a*, fig. 7, supported in boxes, *b b*, confined in a frame composed of two vertical end frames, *c d*, and a horizontal and transverse rest or bar, *f*, the frames, *c d*, being respectively supported in stationary guide frames or puppets, *g h*, fastened on the main frame, and so made as to allow of a free and simultaneous vertical movement either upwards or downwards of the said frames, *c d*, the rest-bar *f*, and the planing-cylinder, E. In other words, the said planing-cylinder and the said rest-bar should be so connected together, or by mechanism, that when one rises the other shall rise in the same proportion, and when one falls or is depressed, the other shall fall or be depressed in the same degree.

The distance between the circle of revolution of the rotary-plane and the under side of the rest-bar determines the thickness of a plank to be planed, and for the sake of being able to plane a plank or board to any desirable thickness, as circumstances may require, either the rest-bar, *f*, or the planing-cylinder, or both, may be provided with suitable mechanical contrivances by which their distance apart may be adjusted or regulated. The mode of accomplishing this I have exhibited in the drawings. It consists of screws, *k l*, tapped into and through the top parts of the frames, *c d*, and made to screw against the rest-bar. It further consists of one or more blocks, *m n*, placed underneath each end of the rest-bar, and between it and the adjacent box of the journal of the rotary-plane, the said block or blocks being of the proper thickness to carry the circle of revolution of the rotary-plane at the required distance from the rest-bar. I, however, do not intend to limit my invention to the employment of such or any other mode

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of adjusting the distance of the rest-bar from the rotary planing-cylinder, as I intend to employ any method which will answer the purpose. The rest-bar and the planing-cylinder should be so supported by their guide-frames as to freely rise or fall without any improper lateral or endwise vibration or movement. In order to cause the front end of the board to pass on to the part B' of the platform, such part B' has the upper surface of it near the cutting-cylinder bevelled or chamfered down, as seen at x in fig. 6.

In the operation of planing a board or piece of wood it passes between the rest-bar and the planing-cylinder, the latter being drawn or so kept up to the board by the former, as to cause it to reduce the board to an equal thickness throughout its whole extent. The under-surface or part of the board is reduced to parallelism with the upper surface of it which always, throughout the operation, rests against the rest-bar, and in consequence of its being supported on the part B, of the platform B B', it elevates the rest-bar in accordance with any increase of thickness, and consequently causes the rest-bar to draw the planing-cylinder towards or up into the board, or in a direction from the unplanned under surface to the planed under surface of the said board.

For impelling the board towards and over the rotary cutting-cylinder we employ one or more sets of feed-rollers, F G. The roller, F, should be made so as to freely revolve on its journals, while in other respects it should be stationary. The other roller (G) should not only be capable of rotating but of rising and falling, so as to adapt itself to the varying thickness of the board. For this purpose it is borne down towards the other roller by means of one or more springs, or by weighted levers, U U', and suitable bearing-rods or contrivances, such as are in common use for such purpose. The said feed-rollers are connected by gears m' n' . The board as it passes between them and the rotary cutter-cylinder and the rest-bar is seen at C, in fig. 6.

The main driving shaft is placed as seen at V, in the drawings. It is put in motion by any suitable power, and has a large pulley, W, on one end, and around which pulley

Statement of the case.

an endless crossed belt, X, extends, and from thence passes to and about a small pulley, Y, fixed on one end of a horizontal transverse shaft, Z, placed at the opposite end of the main frame as seen in figures 3, 4, 5, 6. The said shaft revolves in boxes, $a' a'$, and has two pulleys, $b' b'$, fixed to it, around each of which one of two endless belts, $c' c'$, passes, and thence passes around one of two pulleys, $d' d'$, fixed on the axle or shaft of the rotary-cutter cylinder, E, the whole being as seen in the drawings. By such means the rotary-cylinder is put in rapid revolution when the main shaft is made to revolve.

On one end of the axle of the lower feed-roller, F, a large gear-wheel, e' , is fixed, the same being made to engage with a toothed pinion, f' fixed on one end of a transverse horizontal shaft, g' , which plays or rotates in boxes, $h' h'$, and has a pulley, i' , on its other end. An endless crossed band, k' , passes around the pulley, i' , and also around a pulley, l' , fixed on one end of the driving-shaft, the whole being as seen in the drawings. By such means the lower feed-roller is revolved when the main shaft is put in rotation.

A horizontal bar or throat piece, y , may be arranged with its upper surface parallel with the under surface of the rest-bar, f , and on a level or very little above the level with the extreme upper part of the circle of revolution of the cutting edge of the cutters of the planing cylinder. The said bar is further arranged in front of the said cylinder and across the machine, and is fastened firmly at its ends to the frames, $c d$. The board as it advances beyond the planing cylinder passes between the bar, y , and the rest, f , and is kept up to the rest by means of the said bar.

From the under side of the bench or platform, B B', and below the rotary cutter-cylinder, a box or conductor, m^2 , is made to extend downwards, and to partially enclose the rotary cutter-cylinder, E, that is to say, the rotary cylinder is arranged within the upper part of the conductor in such manner that the shavings or wood removed by it from the board shall pass or be thrown into the said conductor. This conductor should be made so close that no shavings

Statement of the case.

or chips can escape from out its sides while the machine is in operation, the object of it being to collect the shavings or chips and preserve them from accidental contact with fire. This conductor may be a close box of itself, or it may lead down and open into a close box or chamber formed under it or under the planing machine, such close box or chamber being seen at n^2 , in figures 4, 5, 6, 7. The said conductor and its chamber, or either of them, may be made in any suitable manner so as to protect the shavings from fire. They may be made fire-proof if desirable, and there may be applied to either one or both of them, one or more suitable openings and doors to said openings for the purpose of removing the accumulated shavings, as circumstances may require.

My improvement of applying or arranging the rotary cylinder so as to cut against the under side of the board, and combining with the cylinder so placed, a fire protecting conductor or conductors, and chamber for the collection of the shavings, is of great value, as it not only protects property but life from danger of fire. Such a contrivance may also be applied to a rotary-cutter when arranged so as to have its axis either vertical or inclined between a vertical and horizontal position. In planing machines which have the rotary-cutter cylinder placed above the board the shavings are thrown out upon the same, and in various directions, and lodge upon the floor and machine, so as to be very liable to being thrown or carried in contact with a stove or whatever may cause them to take fire. Besides the above, there is a great deal of fine dust made by such machines which, floating in the atmosphere, is inhaled into the lungs of workmen, and thereby becomes injurious to health. Such fine dust, to a great extent if not entirely, is thrown down into the conductor or fire-protection chamber, and in consequence thereof the operatives are greatly protected thereby from its injurious influences on their lungs.

As the rapid revolution of the rotary-cylinder causes it to operate on the air somewhat like a common fire-blower, there will be a current or currents of air more or less rapid created in the shaving conductor or chamber. In order

Statement of the case.

that such currents may not be injurious and be rendered advantageous, a ventilating pipe, a^2 , may be inserted in and made to lead out of some proper part of either the conductor or the chamber below the same, and be carried therefrom out of the building or into such an apartment or place as circumstances may require, and when so carried it may be made to open either into the external atmosphere, or elsewhere, as may be most convenient. The currents of air which are caused to rush into the conductor operate to prevent the escape of any dust or shavings out of the top of the same, and they also operate at the same time to force the dust and shavings downwards.

Should the weight of the rotary-cutter cylinder, its rest and their mechanical connections, not be found sufficient to press the board down against the platform, B B', with the force required in order to perform good work, an additional weight may be placed on the top of the rest f , or said rest may have one or more springs or analogous contrivances adapted to it, and the standards or puppets, $g\ h$.

I would remark that I lay no claim to the invention of pressure-rollers, nor their application in any machinery for the purpose of holding or keeping any particular part of said mechanism against some other parts thereof while the former may be in motion, nor do I claim the employment of either rotating or stationary planes, made in any manner, either alone or in combination with rollers, or any analogous device, to prevent the boards from being drawn up by the planes when cutting upwards, or from the reduced or planed to the unplaned surface, for I believe such contrivances have been in common use, and been common property, for at least twenty-one years or more, as will be seen, as I believe, and either in whole or in part, by reference to the specification of the patent granted in the United States of America, on the twenty-first day of June, A. D. 1828, to one John Hale, of the County of Worcester, and State of Massachusetts. And, as will also be seen, as I believe, and either in whole or in part, by reference to the descriptions of patents granted in France, and on the ninth of March, A. D. 1825, and twenty-eighth of April, A. D. 1825, to

Statement of the case.

one Manneville, which descriptions are to be found in volume XLI. of the French work entitled, "Descriptions des Machines et Procedes consignes dans les Brevets d'Inventions de Perfectionnement et d'Importation." And, as will further be seen, as I believe, and either in whole or in part, by reference to the specifications of the patents granted in France on the fifteenth day of March, A. D. 1817, and the thirtieth day of March, 1818, to one Rogerin, the same being described in volume XXIII. of the said French work.

Although the hereinbefore mentioned machine of the hereinbefore mentioned Hill, could not reduce a board to an equal thickness throughout, when not of such equal thickness, yet it contained a means of preventing the board from being drawn towards the rotary-planes while they were in operation, the said means being the bench or platform, B B'.

In the rotary planing machines, when the rotary-cutter cylinder is disposed above the board, while the rest is placed beneath it, it is customary, and generally necessary, to curve convexly and transversely the rest, so that the board in passing over the same is curved, the curve being produced by the operation of the pressure-rollers. This will be understood by reference to fig. 8, which represents in sections the rest, rotary-cutter, pressure-rollers, and board, a^3 being the rest, b^3 the board, $c^3 c^3$ the pressure-rollers, and d^3 the rotary-cutter. Such curving of the rest, a^3 , in a convex manner, produces a strain on the grain or fibres of the top surface of the board, which not only tends to tear or throw up the fibres more or less, but to loosen the knots, so that they are often disengaged from the boards by the rotary knives of the cylinder. The said mode of forming the rest, and presenting the board to the cutters, becomes necessary in such an arrangement of mechanism in order to prevent vibration of the board, and consequent inequalities or irregularities in its planed surface.

In my improved machine, instead of making with a convex curve that part of the rest, f (fig. 6), against which the board rests, I construct it with a *concave* curve on its under

Statement of the case.

side, somewhat as seen in fig. 9, which denotes a section of the rest, cutter, and adjacent parts, on a somewhat larger scale than they are shown in fig. 6. The part, B, of the bench is formed and applied to the rest, f, or made to *extend under* it in such manner as in connection with the concave surface of the rest to cause the board, as it passes between the rotary-cutter E, and the rest f, to bend a little and present a concave surface to the action of the cutting-cylinder. In this way the fibres or grain of the wood, at or near the surface reduced, become condensed, and so as to grasp the knots more firmly, and thereby prevent them, to a great extent, from being thrown out or removed by the cutters when they pass in contact with them. Besides the advantage of so preserving the knots, the surface of the board, by the fibres of the wood being contracted or condensed, is planed in a much better and smoother manner than it is when the rest is made convex, as before described.

What I claim as my invention is the combination of the rotary planing-cylinder, E, and the rest, f, with the mechanism by which the two can be freely moved up or down simultaneously and independently of the bed or platform, B B', or any analogous device, substantially in the manner and for the purpose of reducing a board to equal thickness throughout its length, all as hereinbefore specified.

I also claim the above described improvement of making the under side of the rest concave, in combination with so extending the part, B, under the rest, f, and applying it to the concave part thereof, as to cause the board as it passes across the rest to be bent and presented with a concave surface to the operation of the rotary-cutter planing-cylinder substantially as specified; the same being for the purpose hereinbefore mentioned.

In testimony whereof I have hereto set my signature,
this thirty-first day of October, A. D. 1849.

NICHOLAS G. NORCROSS.

Witnesses:

R. H. EDDY,

F. GOULD.

Opinion of the court.

It was argued by *Mr. Keller* and *Mr. G. T. Curtis*, for the appellants, and by *Mr. Whiting*, for the appellees.

The reporter finds himself unable to give an intelligible explanation of the arguments of counsel, without introducing engravings, which would be out of place in a law book. In fact, models were used in the argument before the court. He is compelled, therefore, to omit all the arguments of counsel.*

Mr. Justice CATRON delivered the opinion of the court.

The bill before us was filed against Fiske & Norcross by the assignees of Woodworth's patented machine for planing boards, and of tonguing and grooving them.

It is alleged that a planing-machine patented to Norcross, and used by the defendants, was substantially, in its combination, and in the result it produced, the same as that assigned to the complainants for a district in which the defendants' machine was used ; that the complainants' patent was the elder, and that the use of Norcross' machine was an infringement of that invented by William Woodworth.

The Circuit Court dismissed the bill on the hearing ; and it is this decree we are called on to revise. The contest in the court below could hardly have been more stringent ; and much consideration was obviously bestowed on the case by the judge who decided it, as appears from his opinion, which is laid before us, the accuracy of which opinion, and the decree founded on it, we are called on to examine. Before doing so, it is proper to state that the machine used by the defendants does not tongue and groove boards, and that this part of Woodworth's machine is not in controversy.

It is insisted that Woodworth's monopoly extends to his mode of reducing a plank to an equal thickness ; and a principal question is whether the patentee sets up any such claim. It is provided, by the sixth section of the act of 1835, that in case of any machine the inventor shall fully explain the principle, and the several modes in which he

[* It is these omissions of the official reporter to supply which is one of the aims of this publication.—ED.]

Opinion of the court.

has contemplated the application of that principle or character by which it may be distinguished from other inventions, "and shall particularly specify and point out the part, improvement, and combination which he claims as his own invention or discovery." An improvement of a machine is here claimed as having been invented, and the statute requires that such improvement shall be particularly specified; it is to be done in writing, and the applicant is to swear that he believes he is the first inventor of the improvement. This is required, so that the public may know what they are prohibited from doing during the existence of the monopoly, and what they are to have at the end of the term, as a consideration for the grant.

In the words of Lord Campbell, in *Hastings v. Brown*, 1 Ellis & Blackburn, 453, "The patentee ought to state distinctly what it is for which he claims a patent, and describe the limits of the monopoly," or in the language of this court in *Evans v. Eaton*, 7 Wheat., 356 [4 Am. & Eng. 105], "It is for the purpose of warning an innocent purchaser, or other person using the machine, of his infringement, and at the same time of taking from the inventor the means of practicing upon the credulity or fears of other persons, by pretending that his invention was different from its ostensible objects."

Have these requirements been complied with by Woodworth, as respects a claim for planing boards to an equal thickness? He obtained a patent for his machine in 1828, which was surrendered by his executor, in 1845, for want of a proper specification, and a second patent issued; and on this reissued patent the case rests. For its better understanding, we give extracts from the claim and specification; they are the same that were relied on by the Circuit Court, and are as follows: "What is claimed therein as the invention of William Woodworth, deceased, is the employment of rotary planes, substantially such as herein described, in combination with rollers, or any analogous device, to prevent the boards from being drawn up by the planes, when cutting upwards, or from the reduced or planed to the unplaned surface, as described."

Opinion of the court.

And afterwards, "The effect of the pressure-rollers in these operations being such as to keep the boards, etc., steady, and prevent the cutter from drawing the boards towards the centre of the cutter-wheel, whilst it is moved through by machinery. In the planing operation, the tendency of the plane is to lift the boards directly up against the rollers; but in the tonguing and grooving, the tendency is to overcome the friction occasioned by the pressure of the rollers."

This language, so far from claiming the new truth or the result now contended for as the invention or discovery, does not describe, or even suggest, either of them.

The claim, or summing up, however, is not to be taken alone, but in connection with the specification and drawings. The whole instrument is to be construed together. But we are to look at the others only for the purpose of enabling us correctly to interpret the claim.

The specification begins by saying, "The following is a full, clear, and exact description of the method of planing, tonguing and grooving plank or boards, invented by William Woodworth, deceased."

Here the invention is denominated a method of planing, tonguing, and grooving, but not of reducing to a uniform thickness.

The specification then, after describing the mode of preparing the board, proceeds thus: "When the plank or boards have been thus prepared (on a separate machine), they may be placed on or against a suitable carriage, resting on a frame or platform, so as to be acted upon by a rotary cutting or planing and reducing wheel, which wheel may be made to revolve either horizontally or vertically, as may be preferred. The carriage which sustains the plank or board to be operated upon may be moved forwards, by means of a rack and pinion, by an endless chain or band, by geared friction-rollers, or by any of the devices well known to machinists for advancing a carriage, or materials to be acted upon, in machines for various purposes. The plank or board is to be moved on towards the cutting edges of the cutters or knives on the planing cylinder, so

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that its knives or cutters, as they revolve, may meet and cut the plank or board in a direction contrary to that in which it is made to advance; the edges of the cutters are, in this method, prevented from coming first into contact with its surface, and are made to cut upwards from the reduced part of the plank towards said surface, by which means their edges are protected from injury by gritty matter, and the board or plank is more evenly and better planed than when moved in the reversed direction."

There is afterwards a reference to, and explanation of, the drawings, as follows: "In the accompanying drawings, figure 1 is a perspective representation of the principal operating parts of the machine, when arranged and combined for planing, tonguing and grooving, and when so arranged as to be capable of planing two planks at the same time, the axis of the planing-wheel being placed vertically."

And again: "The rollers, *fff*, which stand vertically, are to be made to press against the plank and keep it close to the carriage, and thus prevent the action of the cutters from drawing the plank up from its bed, in cutting from the planed surface upwards; they may be borne against it by means of weights or springs, in a manner well known to machinists. In a single horizontal machine, the horizontal friction-rollers may be geared, and the pressure-rollers placed above them, to feed the board, with or without the carriage, a bed-plate being used directly under the planing-cylinder."

And afterwards, in describing the process for tonguing and grooving, he says: "The edges of the plank, as its planed part passes the planing-cylinder, are brought into contact with the above-described tonguing and grooving wheels, which are so placed upon the shafts as that the tongue and groove shall be left at the proper distance from the face of the plank, the latter being sustained against the planing-cylinder by means of the carriage or bed-plate, or otherwise, so that it cannot deviate, but must be reduced to a proper thickness, and correctly tongued and grooved."

"To meet the different thicknesses of the plank or

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boards, the bearings of the shaft of the cylinder must be made movable, by screws or other means, to adjust it to the work; or the carriage or bed-plate may be made so as to raise the board or plank up to the planing-cylinder."

The means to produce the result of reducing the board to an equal thickness, in a horizontal machine, are the pressure-rollers, *ff*, above the plank, operating in connection with two feed-rollers; and the pressure-rollers, says the specification, "may be held down by springs or weighted levers, which it has not been necessary to show in this drawing, as such are in common use." These rollers are not claimed as new, but are here admitted to be old, and to have been in common use when the patent was granted. Nor is any intimation given in the specification or claim that the pressure-rollers were intended to be used in any combination, for the purpose of reducing a board to an equal thickness. In the description of the original machine, patented in 1828, the pressure-rollers are not mentioned at all, but they are set forth as having belonged to the original machine in the amended specification of 1845; and which last-described machine, experts declare, materially differs from the original as patented in 1828. But as it is not necessary, in this case, to go into the allegation of variance set forth in the answer, we will proceed at once to examine the question of infringement. And to do this, we must first inquire what Woodworth's claim to novelty of combination and invention is. His rotary cutter-wheel is old, his bed-plate is old, and his pressure-rollers are old likewise.

The invention relied on is a new combination in the machine of three elements, to produce the result of planing a plank against its motion through the machine; and the claim of monopoly is the employment of rotary planes, in combination with the face of a bench, and pressure-rollers, to prevent the board from being drawn up by the planes when cutting upwards, or from the reduced or planed to the unplanned surface, as described.

As the board advances on the rotary cutters, they will strike it thirty times in a second, and violently tend to lift

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it into the knives; and to keep it down to the bench, a strong pressure is required. And in the next place, the cutters being over the horizontal bed, and stationary, at a fixed distance from it, and the board pressed down to it so forcibly as to crush out the winds in warped lumber, the machine will, of necessity, reduce the board to an equal thickness throughout.

Norcross' planing-machine is an improvement of Hill's, which was in use when Woodworth invented his, in 1828. Hill used the rotary cutter, which he placed on the under side of the bench, with a section cut through it, the cutters extending through the bench to the upper side, so far as to take from the board, passing over the flat surface above, the depth of wood desired. Feed-rollers were employed to forward the board, and a steel spring (made of the section of a hand-saw) was used to keep the board steady. The spring pressed a smooth metal surface on the board, and operated as a pressure-roller does. But then this spring was not used for the purpose that Woodworth used his pressure-rollers, in this: that the face of the bench above the cutters prevented the board from being drawn into them. The cutters drew it down to the bench, so that this bench is the analogous device to Woodworth's pressure-rollers, and is also in combination with the rotary cutters; hence these two elements existed, thus combined, when Woodworth got his patent.

Hill's machine had a bar immediately over the cutters, and covering the cut through the bench, where the knives revolved. Between this bar and the bench, the feed-rollers forced the board; but as the rest-bar was stationary, and the cutter wheel also stationary, and the cutters extended to a fixed distance above the upper face of the bench, the consequence was, that the board came through the machine of an unequal thickness. To overcome this defect, Norcross made the rest-bar, (previously stationary,) the cap of a square frame, on the vertical side-pieces of which he fixed the journals of his cutter-wheel, the cutters and rest-bar being stationary relatively to each other, and always the same distance apart. This frame is supported in a

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stationary guide-frame fastened to the bench, and so made as to allow a free vertical movement up and down of the rest-bar and cutting-cylinder. As the board passes over the face of the bench, and under the rest-bar, the whole weight of the sliding-frame rests on the board; and as the cutters strike it at a gauged distance from the bar, and as they move up and down with the bar, it follows that when the board, in its rough state, is of an unequal thickness, and the side presented to the cutters is pressed down to the bench, the thicker parts of the board will force up the movable frame, and draw up the rest-bar and cutters above the bench equal to the increased thickness of the board, which will be dressed to the thickness of the space the cutters and rest are set apart. Opposite to the outer part of the rest F, that section of the bed over which the planed surface of the board passes is a bar, horizontal to the rest. The two bars form a throat-piece, which serves to hold the board steady as it passes through the machine.

In view of this state of facts, the rule is, that if a combination has, as here, three different known parts, and the result is proposed to be accomplished by the union of all the parts, arranged with reference to each other, the use of two of these parts only, combined with a third which is substantially different in the manner of its arrangement and connection with the others, is not the same combination, and no infringement.

The combination and arrangement, as appears from the testimony of experts, and by a comparison of the models and drawings presented to us, was the only novelty in the invention of Woodworth. Bentham, in April, 1793, described a rotary cutter and an adjustable bench, which, when adjusted, became fixed, so that the board would be of a determinate thickness when passed between them.

The Hill machine cut the plank from its planed to its unplanned surface, and had feed-rollers and a spring to keep it down to the bed; while the bed served to prevent the plank from being drawn into the cutters.

The Baltimore machine, as the one witness who describes it deposed, reduced the plank to a uniform thickness, by

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passing it between a fixed bed and a fixed cutter, and kept it down on the bed by a pressure-roller.

The French machine of Roguin, patented and in use as early as 1818, had the rotary cutter and bench; they were stationary relatively to each other, and must have cut the board of an even thickness had it been pressed so hard to the bed as to force out the warps; but this seems not to have been the case. The cut of the planes was with the advance of the board through the machine, and from the unplanned to the planed surface; and for this reason the lift of the cutters was very slight. The plank was kept steady by a rest-bar, as in Hill's machine.

This is all we deem necessary to describe, in regard to other machines, to the end of passing judgment on the question of infringement. As to the question of originality of the Woodworth machine, compared with the other earlier planing-machines produced in evidence, and explained by experts; and, secondly, as to the question whether the original machine, for which Woodworth obtained his patent in 1828, had or had not pressure-rollers in connection with other rollers, and which are now claimed as the main element of the machine repatented in 1845, we forbear from deciding, as we suppose these questions would be more appropriately left to a jury on issues, where the witnesses could be heard in open court. It is deemed proper to remark that the fact of procuring a patent for a new and useful machine in 1845, under the assumption of a reissue, which was not useful as patented in 1828, for want of feed and pressure rollers, now used as is alleged in defense, would present a question of fraud, committed on the public by the patentee, by giving his reissued patent of 1845 date as an original discovery, made in 1828, and thereby over-reaching similar inventions made between 1828 and 1845.

There is one feature in Norcross' machine, and covered by his patent, which is not claimed to be an infringement. It is this: As the board passes under the rest-bar F, it is weighted down on the edge of that section of the bed over which the plank first passes. The rest-bar is slightly concave, and bears heavily on the planed end of the plank;

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the further side of that section of the bed over which the board last passes being somewhat depressed, and made lower by bevelling than the opposite section. By this means the board is bent, and struck by the cutters on a concave surface; the grain of the wood being condensed by the bend in the boards, so as to grasp the knots more firmly, and prevent them from being thrown out by the cutter, and also to prevent the fibres from eating into the planed surface. Because of the board being bent, the Norcross machine cannot be used for tonguing and grooving boards, as the edges of the board must be straight to perform these operations.

From the distance the pressure-rollers in Woodworth's machine have to be separated so as to give the cylinder room to rotate, the board tends to curve upwards, and is cut on a convex surface, thus loosening the knots, and causing them to be thrown out, and causing the surface of the planed board to be eaten in where the wood is cross-grained or coarse, and also to be uneven, and full of small ridges.

We must, however, disregard this last improvement in Norcross' machine, and also discard the parts of Woodworth's machine which tongue and groove, and treat his invention as a single machine for planing boards on one side only; and, on this state of the facts, try the question of infringement. To infringe Norcross must use all the parts of Woodworth's combination. 1. The use of rollers to keep the board firmly to the bed, and prevent it from being drawn into the cutters and torn to pieces, and to press out the warps, is the principal claim to invention. Norcross uses no such pressure-rollers, nor can they be employed in his machine to such purpose.

But it is insisted that the section of the bed-plate in Norcross' machine, over which the unplaned board passes before it reaches the cutter, is equivalent to the pressure-roller of Woodworth; and that the throat piece is equivalent, in its operation, to his stationary roller. 2. That Norcross uses his rest F, as an equivalent to Woodworth's bed-plate; that the front section of the bed being used for

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the pressure-roller, and acting in combination with the rest F, representing Woodworth's bed-plate, and the cutter operating alike in both machines, it follows that Norcross in fact used Woodworth's combination, but disguised it by turning Woodworth's machine upside down.

The remarks of Judge Sprague (who decided this cause in the Circuit Court), made in answer to the foregoing argument, are so distinct and satisfactory to us, that we deem proper that they should be adopted in this opinion. They are as follows :

"The plaintiff's witnesses, when asked in what part of the defendant's machine they find the plaintiff's pressure-roller, are divided in opinion. Some of them say that it is the bed, because that prevents the board from being drawn into the axis of the cutter, considering that function as the characteristic of the plaintiff's roller. Others find it in what is called the rest, because that presses the board down upon the bed. But in the Hill machine, the roller performed the same office of pressing the board down, and the bed the same office of preventing it being drawn towards the axis. If either of these sets of witnesses be correct, the Hill machine contained the plaintiff's pressure-roller, and as it had also a bed-piece and rotary cutter, it would follow that it had the plaintiff's combination. Such a construction, therefore, cannot be maintained. The truth is, that after the Hill machine, it was only left to Woodworth to make some new arrangement of the three elements, that is, some new mode of combination. Woodworth's invention may be regarded as an improvement upon Hill's. If Norcross uses this improvement, then he infringes, whatever he may add to it, or with whatever new invention he connects it. If he does not use this improvement, he does not infringe, although he may, by other means, work out the same ultimate result."

"What, then, is the improvement which Woodworth made on the Hill machine? He took the rotating-cylinder, which was in a fixed position below the bed, and placed it in a fixed position above the bed. This is the only change in the arrangement of the three elements. But it trans-

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ferred to the pressure-roller a function which had before been performed by the bed. In Hill's machine, the pressure-roller only kept the board down upon the bed, the latter keeping it from being drawn into the axis of the cutter. In Woodworth's, the pressure-roller performs both these offices. The effect of this is to plane the board on the upper side instead of the lower, and the result of that is, that the board comes out of a uniform thickness, which was not accomplished by Hill. In his machine, the rotary-cylinder being placed below the bed, with the knife projecting above it, the edge of the knife was kept at a fixed distance above the upper surface of the bed, and cut from the lower side of the board, through its whole length and breadth, so much of it as was equal to that distance. Thus, if the edge of the knife was a quarter of an inch above the bed, and the board be pressed closely to it, it would take off a quarter of an inch of the under side of the board through its whole extent, and if it was of an unequal thickness before, it would remain of an unequal thickness.

By placing the cylinder in a fixed position above, and keeping a certain distance between the edge of the cutter and the bed, and all of the board above that distance being taken off by cutting on the upper side, it necessarily comes out of a uniform thickness."

"Now let us look at the Norcross machine. If it has any part which is equivalent to the pressure-roller, it is the rest. Let us, then, for the sake of clearness, consider that to be a pressure-roller. What, then, has been done by Norcross? He has left the arrangement of the three elements the same as it was in Hill's. The rotary-cylinder is below the bed; the pressure-roller still keeps the board down upon the bed, and the bed keeps it from being drawn into the axis of the cutter. His improvement is this: He has made the cutting cylinder movable vertically, which it was not before, and has connected it with his rest, that is, with the pressure-roller, so that when the latter is forced upwards by the increased thickness of the board, it draws the cutter upwards with it, which thereby is made to cut just as much more from the under side of the board as the-

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roller is pressed up by the increased thickness. By this contrivance, the edge of the cutter is kept in a fixed relation to the rest, or, in other words, the pressure-roller, the space between them being always the same; whereas in Hill's, and also in Woodworth's, the edge of the knife had a fixed relation to the bed, and not to the pressure-roller. The defendant, therefore, has made a new and independent invention, and does not use the arrangement or mode of combination of the plaintiff."

For the reasons above stated, we are of opinion that the machine of the respondents did not infringe the patent of the complainants, and therefore order that the decree of the Circuit Court dismissing the bill be affirmed.

Mr. Justice McLEAN, Mr. Justice WAYNE, and Mr. Justice NELSON dissented.

Mr. Justice McLEAN.

I dissent from the opinion of the court. The defendants rest their defense on three grounds—

1. A want of novelty in Woodworth's invention.
2. That in the new patent of Woodworth, issued on the surrender of the old one, to correct the specifications, a new invention is claimed, not contained in the first patent.
3. That the defendant's machine is substantially different from the plaintiff's.

The Woodworth patent has been a subject of investigation frequently before the Circuit Courts of the United States, and of this court; and although the originality of the invention has been, I believe, uniformly sustained, still the fact of novelty depends upon proof, and may be disputed by any one against whom suit is brought. The patent is *prima facie* evidence of right in the patentee. A defence which denies the novelty of the invention must be proved.

The original patent of Woodworth is dated the 27th of December, 1828. He describes his invention to be an "improvement in the method of planing, tonguing, grooving, and cutting into mouldings, of either plank, boards,

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or any other material, and for reducing the same to an equal width and thickness, and also for facing and dressing brick, and cutting mouldings, or facing metallic, mineral, or other substances." He then describes the machinery by which this result is produced. And he says, in the conclusion, that he does not claim the invention of circular saws, or cutter-wheels, knowing they have long been in use; but he claims as his invention the improvement and application of cutter or planing wheels to planing boards, &c., as above stated, &c.

There is no claim, in his written specifications, for pressure-rollers on both sides of the cutting-cylinder, which confine the board to its place, and necessarily reduced it to an equal thickness; but in the drawings, these rollers appear at the proper places, and are so arranged as to reduce the board to a uniform thickness.

The written specifications, including the drawings, constitute a part of the patent, and must be construed as the claim of the plaintiff. In *Ryan v. Goodwin*, 3 Sumner, 514, it is said, if the court can perceive on the whole instrument the exact nature and extent of the claim made by the inventor, it is bound to adopt that interpretation, and to give it full effect. The same is held in *Wyeth v. Stone*, 1 Story, 270, 286; and in *Ames v. Howard*, 1 Sumner, 482, 485, it is said: "The drawings are to be taken in connection with the words; and if by a comparison of the words and the drawings the one would explain the other sufficiently to enable a skillful mechanic to perform the work, the specification is sufficient." *Bloxham v. Elsee*, 1 Car. & Payne, 558 [1 Am. & Eng. 373], is to the same effect.

Formerly, patents were construed strictly as giving monopolies; but of late years, in England, inventions are treated differently, and a liberal view is taken in favor of the right. *Blanchard v. Sprague*, 3 Sumner, 535, 539. This has been the settled doctrine in this country; and it is founded upon the highest considerations of policy and justice. The opinion delivered by my brother Curtis this morning, as the organ of the court, cites the authorities.

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No patent, it is believed, which has ever been granted in this country, has been so much litigated as this one. This affords no unsatisfactory evidence of its value. Very shortly after Woodworth's machine was put in operation, a system of piracy was commenced; and although twenty-five years have elapsed, numerous suits are still pending, contesting the right. Mr. Justice Story was one of the first judges whose duties required him to scrutinize this patent in all its parts, and he sustained it in all. This was before the specifications were corrected. And this court also sustained it, in *Woodworth v. Wilson*, 4 Howard, 712 [4 Am. & Eng. 542], where it says: "The specifications accompanying the application for a patent are sufficiently full to enable a mechanic with ordinary skill to build a machine." And this is what the law requires.

In the corrected specifications, the patentee says: "Having thus fully described the parts, and combinations of parts, and operation of the machine for planing, tonguing, and grooving boards or plank, and shown various modes in which the same may be constructed and made to operate, without changing the principle or mode of operation of the machine, what is claimed therein as the invention of William Woodworth, deceased, is the employment of rotary planes, substantially as herein described, in combination with rollers, or any analogous device, to prevent the boards from being drawn up by the planes, when cutting upwards, or from the planed to the unplanned surface, as described; and, also, the combination of the rotating planes with the cutter-wheels for tonguing and grooving, for the purposes of planing, tonguing, and grooving boards, &c., at one operation, as described."

"And, finally, the combination of either the tonguing or grooving cutter-wheel for tonguing and grooving boards, &c., with the pressure-rollers, as described, the effect of the pressure in these operations being such as to keep the boards, &c., steady, and prevent the cutters from drawing the boards towards the center of the cutter-wheels, whilst it is moved through by machinery," &c.

L. Roguin, of France, in the years 1817 and 1818, in-

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vented a machine for planing, grooving wood, moulding, &c., it is alleged, substantially on the same principles as Woodworth's machine.

A considerable number of experts were examined, in the Circuit Court, on both sides, and their opinions, as usual in such cases, were directly in conflict. Such testimony, being written, cannot lead the court to a satisfactory result, by weighing the evidence, as might be done by a jury, where the witnesses are examined in open court. There seems to be no other mode of arriving at a correct conclusion, than to read what the experts have said, and make up an opinion on the specifications of the patents, and on an examination of the models.

The French machine was improved in 1818. The patentee says: "The parent idea of the first machine could not vary. This parent idea consisted in subjecting the wood to the action of a tool of a particular shape, and to impart to this tool a rotary movement; but the choice remained, either of making the tool stationary, and causing the wood to advance under it with a slow and progressive motion—one rotary, the other progressive. The first was adopted in the construction of the machine described in support of the petition for letters patent; the second has been adopted in the construction of the improved machine."

After describing the structure of the cylinder, he says: "It is borne by a cast-iron carriage, and to the back part of this carriage is attached an iron axletree, bearing two brass pinions, which gear into a rack, and tend to regulate the movement of the carriage. The bench moves itself vertically by means of screws which support it, and tend to raise it or lower it according to the thickness of the wood to be worked." "Four small graduated plates of metal, placed in the interior angles of the superstructure, act as a regulator to fix this bench in a perfectly horizontal position." "Two iron squares abut the bench at both ends." "Experience," he says, "has taught that the weight of the bench was not sufficient, singly, to prevent the vibration imparted to it by the machine when in operation, and there resulted from this vibration waves on the surface

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of the planed board." This was obviated by the weight of the carriage. "The carriage is of cast-iron, and weighs about two hundred and forty-one pounds. It is necessary that the carriage should be of sufficient weight, so as not to be raised by the strain of the tool."

"The back part of the bench carries a claw, against which the wood is rested and stopped, like a carpenter's bench. At the other extremity, the wood is stopped by movable dogs, which pass under a bar, through which passes pressure screws." And he further says: "We have seen, in the description of the first machine, that the piece called guide (because it serves effectually to guide the wood under the tool for grooving and moulding) was fixed on the superstructure of the bench. In the new machine, this piece is borne by the carriage."

From this description, it appears that the planing-cylinder is carried by an iron frame, and passes over the surface of the board, which is fastened on a bed by a claw at one end, and at the other by movable dogs. This bench, on which the board is placed, is moved vertically, so as to be adjusted by screws to the thickness of the wood to be worked.

The wood is fastened on this adjustable bed, and the iron frame which carries the cutting-cylinder is of sufficient weight to keep the cutters on the board, but this machinery cannot reduce the plank to the same thickness. When the bench rises or falls, the whole surface of the plank rises and falls, and the cutting-knives cannot so operate by pressure on so long a surface as to reduce the inequalities of the board. But this can be done by pressure-rollers, as in Woodworth's machine, on each side of the cutting-cylinder—one adjustable, so as to admit the unplaned plank; the other fixed, so as to admit the passage of the plank, when reduced to the required thickness. The French machine may present a smooth surface, but the inequalities of the board will not be removed. They will remain in the same proportion as before the planing operation.

It is argued, that the piece or bar which, in the first machine, was fastened to the bench, and which, in the

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improved one, was annexed to the carriage, operated as a pressure-roller. If this were admitted it would not remove the difficulty, as one pressure-roller or bar could answer no valuable purpose. There must be two rollers, one adjustable, as above stated, or two fixed rollers, or bar and an adjustable bed to reduce the plank to an equal thickness. But if L. Roguin be permitted himself to describe the function of this bar, it is "to guide the wood under the tool for grooving, tonguing, and moulding." Shall the language of the inventor be misapplied, and this bar be appropriated to a use which it would seem he never thought of, to render invalid Woodworth's patent?

Several of the witnesses on both sides gave their testimony from the description of L. Roguin's patent, published in a book called "Brevets d' Inventions;" but, as that book was not published until after Woodworth's invention, its description is evidence only so far as it agrees with the specification attached to the patent of L. Roguin. And it does appear, from the original specifications filed by him, a certified copy of which has been recently procured by M. Perpigna, that there are some material variances. We must therefore look to the authentic paper and drawings, as certified, for evidence in regard to the machine.

The organization of this machine does not seem to be on the same principle as Woodworth's, and the result is different.

The other French machine, alleged to be similar to that of Woodworth's, is De Manneville's. This machine was patented in France in 1825, and described in the printed work called "Brevets d' Inventions." The patent embraced two machines, having for [their] object the grooving, planing, and reducing to a uniform thickness, wood intended for inlaid work, as well as all sorts of boards, whatsoever may be their dimensions. The inventor calls them a groover and planer.

The description of this machine by the inventor is confused and scarcely intelligible. One of the defendants' witnesses describes it as having two planes, one of which is called rough, the other smooth, both of which are kept

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down to the face of the board by a tool-bearer, and are moved backward and forward by a crank motion. The rough plane is movable to and from the board, by being held to it by a spring; the smooth plane, or finisher, is immovable, principally, from the board, except to separate the shavings from it. The position of the board is edge-wise, resting on the horizontal rollers—friction-rollers; and it is carried through by a pair of fluted cylinders or rollers, vertical, and parallel to each other; which rollers press upon each side of the board, one of which, the back one, is made to slide in its boxes, held up by a spring, and thus made to yield to the inequalities of the thickness of the board; another pair of rollers, holding the same vertical position, called discharging cylinders, neither of which is yielding, nor are they fluted; and to adjust the different thicknesses, the inventor suggests rollers of different diameters, and on an adjustable bed.

Any one can at once see that this is not an organization of machinery similar to Woodworth's machine. It is not the same principle, nor is it in substance like it. This remark is made in regard to the combination claimed by Woodworth, and not to all the elements of which that combination is formed. In the Manneville machine there is no combination of pressure-rollers with rotary cutters, as in Woodworth's; the cutters have a reciprocating motion instead of a rotary one. Several of the elements in both machines are the same, but they are not so arranged as to act in the same manner or on the same principle.

Some of the witnesses for the defendant think, that from the two French patents the Woodworth machine might be constructed without invention; but these machines must be considered singly and not together. In the defense it is alleged, in reference to Woodworth's machine, that "the same thing substantially was patented in France in 1817 and 1818, by L. Roguin, and in 1825 by Manneville." The defense, in this respect, is not sustained, as neither of the patents is substantially the same as Woodworth's.

The next point for consideration is, whether in the amended specifications of Woodworth's patent, in 1845, a

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new invention was claimed not embraced in the original patent.

It must be admitted that the subject-matter of the new patent is the same. The patent was surrendered to correct defective specifications, which did not result from any fraudulent intent. This right was secured to the patentee by the thirteenth section of the Patent Act of 1836; and on an application to the Commissioner of Patents, he, finding there had been no fraud, a new patent was issued for the same invention, more accurately described, as the law authorized.

In the case of *Woodworth v. Stone*, 3 Story, 749, and *Allen v. Blunt*, Id., 742, it was held, that the action of the Commissioner in accepting a surrender of a patent and issuing a new one, concluded the parties unless fraud be shown. And in *Stimpson v. West Chester Railroad*, 4 Howard, 380 [4 Am. & Eng. 398], this court says: "In whatever manner the mistake or inadvertence may have occurred is immaterial. The action of the government in renewing the patent must be considered as closing this point, and as leaving open for inquiry before the court and jury the question of fraud only."

The corrected specifications of the new patent, on a surrender, would necessarily be different from those that were defective. And it is the duty of the Commissioner not to permit a new invention to be claimed under the pretense of correcting defective specifications.

Some things are omitted in the new patent which were claimed in the old one. But the principal objection on this ground seems to be that pressure-rollers were claimed in the new patent, and were not claimed in the old one. This is a mistake, as has already been shown. These rollers were represented in the drawings, and in that way were more accurately described than they could have been by a written specification. These drawings are a part of the patent. It does not appear that the corrected specifications embrace a new invention not included in the original patent.

The third and last point is whether the defendants' machine is an infringement of the plaintiffs'.

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In the opinion of the Circuit Court in this case, it is said: "The defect in the Hill machine was, that it did not reduce the board to a uniform thickness. This desideratum the plaintiff has obtained by an improvement for which he was entitled to a patent. The defendant has accomplished the same purpose without using the improvement of the plaintiff, but merely by a new invention of his own, and therefore does not infringe."

From these remarks it would seem that the Circuit Court considered Woodworth as entitled to a patent for "reducing boards to a uniform thickness," but that his patent does not cover it. In this the Circuit Court was mistaken, as I shall endeavor to show, in fact and in law.

It is not controverted that Woodworth's combination of machinery does reduce boards to an equal thickness. He did not, and could not, claim a patent for reducing a board to a uniform thickness; for an exclusive right could not be given for such a result. For centuries boards have been reduced to a uniform thickness by hand-planes, and perhaps by other means. What, under the Patent Law, could Woodworth claim? He had a right to claim, as he did claim, a combination of machinery which would produce such a result. Was it necessary, in the summing up of his claim, which is done to distinguish what he has invented from parts of his machine which he has not invented, that he should claim the combination of his machine for the purpose of reducing boards to a uniform thickness? This would have limited his invention to that purpose, when it was applicable, and was intended to be applied, to that and many other purposes.

By the sixth section of the Patent Law of 1836, an inventor is required to describe his invention in every important particular in his application for a patent, so as to enable those skilled in the art or science to which it appertains to make, construct, compound, and use the same; and if the invention be a machine, he is required to state "the several modes in which he has contemplated the application of the principle or character by which it may be distinguished from other inventions;" and "shall particularly specify and point

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out the part, improvement, or combination which he claims as his own invention and discovery." He is required to accompany the whole with a drawing; and if a machine, a model, &c.

Is it not clear that Woodworth has explained the principle, and the several modes in which he has contemplated the application of the principle or character of his machine by which, in the language of the act, it may be distinguished from other inventions? The plank is planed, tongued, and grooved by an organization of machinery unknown before. This is all, in the summing up, which the act requires.

It is objected that Woodworth does not include in his claim that of reducing a plank to a uniform thickness. The invention consists in the means through which this is done. A result or an effect is not the invention. This appears to have been the turning-point in the opinion of the Circuit Court.

But Woodworth has, in the specifications of his machinery, stated that the board is necessarily reduced to a uniform thickness. He says: "The edges of the plank, as its planed part passes the planing-cylinder, are brought into contact with the above-described tonguing and grooving wheels, which are so placed upon their shafts as that the tongue and groove shall be left at the proper distance from the face of the plank, the latter being sustained against the planing-cylinder by means of the carriage or bed-plate, or otherwise, so that it cannot deviate, but must be reduced to a proper thickness and correctly tongued and grooved." Here Woodworth describes the combined operation of planing, tonguing, and grooving; and by which the plank is reduced to a proper thickness, that is, the required thickness; "and correctly tongued and grooved," &c. This is the effect of his machine in planing boards, clearly described.

He says the board is kept against the planing-cutters by means of the carriage or bed-plate, or otherwise. The pressure-rollers are claimed in his specification written, and also in his drawings, which show how they are to be applied. He also says: "Fig. 7 represents the same

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machine with the axis of the planing-cylinder placed horizontally, and intended to operate on one plank only at the same time; A A is the frame; B B the heads of the planing-cylinder; C C the knives or cutters attached to said heads, to meet the different thicknesses of the plank. The bearings of the shaft of the cylinder may be made movable, by screws or other means, to adjust it to the work, or the carriage of the bed-plate may be made so as to raise the plank up to the planing-cylinder."

The patent of the defendants was issued February 12, 1850. It is alleged to be an improvement upon Hill's machine. That machine, from the description, consisted of a planing-cylinder, a platform bench, with an aperture in it through which the planing cutters operated, so as to cut away any required thickness from the surface of the plank subjected to its action; the relation of the cylinder to the bench was permanent; a spring plate bore upon the plank nearly opposite to the cylinder, and forced it towards the cylinder and bench; feeding-rollers carried the plank forward, the same as in Woodworth's machine.

By this operation a stratum of equal thickness was cut from the plank, leaving a smooth surface, but not removing the inequalities of the board. The combination of machinery was different in principle from Woodworth's, and consequently the result was different.

Norcross says his invention is an improvement of Hill's machine, and "renders it capable of reducing or planing a board to an eqnal thickness throughout its length." He says: "Hill's machine was capable of planing or reducing a board on one side, or removing from such side a stratum or layer of wood of an equal thickness," but this did not make the board of uniform thickness.

The amended machine contains rotary planes, which cut from the planed to the unplanned surface of the plank; an adjustable bar and rest is at a fixed distance from the cutting action of the planes; the rotating planes and this rest-bar were so connected together in a separate frame as to move vertically with the frame, and is borne downwards by their weight; two bars, one before and the other behind the

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rotating planes, and on the face of the plank cut by them, to cause its opposite face, in its progress through the machine, of whatever thickness and however warped, to pass in contact with the rest-bar, F. One of the said bars is termed a platform, B, and the distance between this and the rest-bar, F, is variable, and self-adjusting to the varying thickness of the plank before it is planed, and the other, called a horizontal bar or throat-piece, G, placed at the same distance from the rest-bar, F, as the line of the cutting action of the rotating planes, to act on the face of the plank which has been planed, and insure the contact of the opposite and unplaned face with the rest-bar, F.

Norcross says: "What I claim as my invention is the combination of the rotatory planing-cylinder, E, and the rest, F, with mechanism by which the two can be freely moved up or down, simultaneously and independently of the bed or platform, B B, or any analogous device, substantially in the manner and for the purpose of reducing a board to an equal thickness throughout its length, all as hereinbefore specified."

"I also claim the above-described improvement of making the under side of the rest concave, in combination with so extending the part B under the rest, F, and applying it to the concave part thereof, as to cause the board, as it passes across the rest, to be bent, and presented with a concave surface to the operation of the rotatory cutter planing-cylinder, substantially as specified."

This organization of machinery seems to be the same in principle as that of Woodworth's, and produces the same result. If the concave surface of the board on which the cutters operate be an improvement, or any other slight change has been made, which may be an improvement on Woodworth's machine, that would give the defendants no right to use it without a license.

The difference between the machines appears to be this: The rotating planes and the plate or bed of Woodworth's are stationary in the main frame, and the roller or analogous device on that face of the plank to be planed is movable toward and from the plate or bed, to suit the varying thick-

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ness of the plank; while in the Norcross machine two bars are substituted for the pressure-rollers, and instead of making the one which acts on the plank before it is planed movable, to suit the varying thickness of the plank, it is fixed permanently in the main frame; and the rotating planes and the plate or bed, termed by him the rest-bar, F, are connected together in a separate frame, and together move up and down, to adapt themselves to the inequalities in the thickness of the plank.

Norcross has made that part of his machinery movable, which in the Woodworth machine is fixed; and that which is movable in the Woodworth machine, he has made permanent. These changes, and the reversal of Woodworth's machine is the difference in their structure. A cast of the eye on the models will satisfy a machinist of the truth of this representation.

Whether the cutting-cylinder operates above or below the bench on which the plank is laid, can be of no importance; nor is the difference material whether a pressure-roller varies to suit the variable thickness of the plank, or the planing-cylinder, connected permanently with the bench, shall be elevated or depressed to accomplish the same object. These devices, though different in form, are the same in principle, and produce the same effect.

I think there is an infringement, and that the decree of the Circuit Court should be reversed.

ORDER. This cause came on to be heard on the transcript of the record from the Circuit Court of the United States for the District of Massachusetts, and was argued by counsel; on consideration whereof, it is now here ordered, adjudged, and decreed by this court, that the decree of the said Circuit Court in this cause be, and the same is hereby,

AFFIRMED WITH COSTS.

Notes and Citations.

Notes:

1. Act 1790, § 2; Act 1793, § 1; **Act 1836, § 6;** Act 1870,
§ 26; R. S., § 4888.
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2. Claims should be construed in view of the specification.

Turrill *v.* Railroad, 1 Wall. 491.
Mitchell *v.* Tilghman, 19 Wall. 287.
Fuller *v.* Yentzer, 94 U. S. 288.
Tilghman *v.* Proctor, 102 U. S. 707.
Railroad Co. *v.* Mellon, 104 U. S. 112.
Fay & Co. *v.* Cordesman, 109 U. S. 408.
Yale Lock Co. *v.* Sargent, 117 U. S. 873.
White *v.* Dunbar, 119 U. S. 47.
Snow *v.* Railway Co., 121 U. S. 617.

In view of the specification and drawings:

Cammeyer *v.* Newton, 94 U. S. 225.

In view of state of art:

Carlton *v.* Bokee, 17 Wall. 463.
Washing Machine Co. *v.* Tool Co., 20 Wall. 342.
James *v.* Campbell, 104 U. S. 356.
Bridge, &c., Co. *v.* Excelsior Co., 105 U. S. 618.
Tack Co. *v.* Two Rivers Co., 109 U. S. 117.
Grier *v.* Wilt, 120 U. S. 412.

Notes and Citations.

"Substantially as described" refers to specification:

Seymour v. Osborne, 11 Wall. 516.

Corn Planter Patent, 23 Wall. 181.

Lake Shore, &c., R. R. v. National Car-Brake Shoe Co.,
110 U. S. 229.

Brown v. Davis, 116 U. S. 237.

4. A combination is not infringed by the substitution of a new element.

Gould v. Rees, 15 Wall. 187.

Fuller v. Yentzer, 94 U. S. 299.

McMurray v. Mallory, 111 U. S. 97.

Signal Co. v. Hall Signal Co., 114 U. S. 87.

Sharp v. Riessner, 119 U. S. 631.

See note to Prouty v. Ruggles, 4 Am. & Eng. 359.

Patent in suit:

No. . Woodworth, W. December 27, 1828. Planing
Mill. Reissue No. 71. July 8, 1845.

(Infringing Machine No. 7087. Norcross, N. G. February
12, 1850. Planing Machine.)

OTHER SUITS ON SAME PATENT:

Brooks v. Bicknell, 1843. 3 McL. 250; 2 Robb. 118.

Brooks v. Jenkins, 1844. 3 McL. 432; Fish. Pat. Rep. 41.

Washburn v. Gould, 1844. 3 Story, 122; 2 Robb. 206.

Woodworth v. Sherman, 1844. 3 Story, 171; 2 Robb. 257.

Lippincott v. Kelly, 1844. 1 West. L. J. 513.

Wilson v. Rousseau, 1845. 1 Blatch. 3.

Woodworth v. Stone, 1845. 3 Story, 749; 2 Robb. 296.

Brooks v. Stolly, 1845. 3 McL. 523; 2 Robb. 281.

Notes and Citations.

- Brooks *v.* Bicknell, 1845. 4 McL. 70; Fish. Pat. Rep. 72.
Brooks *v.* Bicknell, 1845. 4 McL. 60; Fish. Pat. Rep. 65.
Simpson *v.* Wilson, 1846. 4 How. 709; 2 Robb. 469; 1 Whit. 424; 4 Am. & Eng. 533.
Smith *v.* Mercer, 1846. 4 West. L. J. 49; 5 Penn. L. J. 529.
Van Hook *v.* Pendleton, 1846. 1 Blatch. 187; Fish. Pat. Rep. 120.
Wilson *v.* Rousseau, 1846. 4 How. 646; 2 Robb. 373; 1 Whit. 357; 4 Am. & Eng. 436.
Woodworth *v.* Hall, 1846. 1 W. & M. 248; 2 Robb. 495.
Woodworth *v.* Hall, 1846. 1 W. & M. 389; 2 Robb. 517.
Woodworth *v.* Weed, 1846. 1 Blatch. 165; Fish. Pat. Rep. 108.
Woodworth *v.* Wilson, 1846. 4 How. 712; 2 Robb. 478; 1 Whit. 428; 4 Am. & Eng. 542.
Gibson *v.* Harris, 1846. 1 Blatch. 167; Fish. Pat. Rep. 115.
Gibson *v.* Betts, 1846. 1 Blatch. 168; Fish. Pat. Rep. 91.
Wilson *v.* Turner, 1846. 4 How. 712; 2 Robb. 467; 1 Whit. 427; 4 Am. & Eng. 539.
Wilson *v.* Stolly, 1847. 4 McL. 278; Fish. Pat. Rep. 146.
Woodworth *v.* Curtis, 1847. 2 W. & M. 524; 2 Robb. 603.
Wilson *v.* Stolly, 1847. 4 McL. 275; Fish. Pat. Rep. 137.
Woodworth *v.* Edwards, 1847. 3 W. & M. 120; 2 Robb. 610.
Van Hook *v.* Pendleton, 1848. 2 Blatch. 85; Fish. Pat. Rep. 205.
Gibson *v.* Barnard, 1848. 1 Blatch. 388; Fish. Pat. Rep. 238.
Wilson *v.* Barnum, 1849. 8 How. 258; 1 Whit. 510; Fish. Pat. Rep. 457; 5 Am. & Eng. 89.
Wilson *v.* Barnum, 1849. 2 Fish. 635.
Wilson *v.* Simpson, 1849. 9 How. 109; Fish. Pat. Rep. 463; 1 Whit. 515; 5 Am. & Eng. 97.
Wilson *v.* Stolly, 1849. 5 McL. 1; Fish. Pat. Rep. 261.
Olcott *v.* Hawkins, 1849. 2 Am. L. J. 317 (9 Penn. L. J.).
Motte *v.* Bennett, 1849. 2 Fish. 642.
Barnard *v.* Gibson, 1849. 7 How. 650; Fish. Pat. Rep. 243; 5 Am. & Eng. 74.
Wilson *v.* Sherman, 1850. 1 Blatch. 536; Fish. Pat. Rep. 361.
Woodworth *v.* Cook, 1850. 2 Blatch. 151; Fish. Pat. Rep. 423.
Gibson *v.* Van Dresar, 1850. 1 Blatch. 582; Fish. Pat. Rep. 369.
Gibson *v.* Gifford, 1850. 1 Blatch. 529; Fish. Pat. Rep. 366.
Gibson *v.* Cook, 1850. 2 Blatch. 144; Fish. Pat. Rep. 415.
Bloomer *v.* Stolley, 1850. 5 McL. 158; Fish. Pat. Rep. 376.
Brooks *v.* Norcross, 1851. 2 Fish. 661.

Notes and Citations.

- Bicknell v. Todd, 1851. 5 McL. 236; Fish. Pat. Rep. 452.
Ritter v. Serrell, 1852. 2 Blatch. 379.
Sloat v. Patton, 1852. 1 Fish. 154.
Bloomer v. McQuewan, 1852. 14 How. 539; 1 Whit. 780; 5 Am. & Eng. 434.
Livingston v. Woodworth, 1853. 15 How. 546; 1 Whit. 922 [p.].
Foss v. Herbert, 1856. 1 Biss. 121; 2 Fish. 31.
Pitts v. Edmonds, 1857. 1 Biss. 168; 2 Fish. 52.
Jenkins v. Greenwald, 1857. 1 Bond, 128; 2 Fish. 37.
Dean v. Mason, 1857. 20 How. 198; 1 Whit. 1048.
Brown v. Shannon, 1857. 20 How. 55; 1 Whit. 1044.
Bloomer v. Gilpin, 1859. 4 Fish. 50.
Bloomer v. Millinger, 1863. 1 Wall. 340; 2 Whit. 42.
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Cited:

IN SUPREME COURT OF UNITED STATES:

- Gould v. Rees, 1872. 15 Wall. 187; Bk. 21, L. ed. 39.
Gill v. Wells, 1874. 22 Wall. 1; Bk. 22, L. ed. 699.
Reedy v. Scott, 1875. 23 Wall. 352; Bk. 23, L. ed. 109.
Bates v. Coe, 1878. 98 U. S. 31; Bk. 25, L. ed. 68.
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IN CIRCUIT COURTS:

- Goodyear v. Providence Rubber Co., November, 1864. 2 Cliff. 851; 2 Fish. 499.
Whitely v. Swayne, February, 1865. 4 Fish. 117.
Hale v. Simpson, October, 1865. 2 Fish. 565.
Nicholson Pavement Co. v. Hatch, September, 1868. 4 Sawyer, 692; 3 Fish. 432.
Gottfried v. Philip Best Brewing Co., December, 1879. 5 Ban. & Ard. 4; 17 O. G. 675.

Dec., 1853.]

BROOKS *v.* FISKE.

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Notes and Citations.

Holly v. Vergennes Machine Co., October, 1880. 18 Blatch. 327;
4 Fed. Rep. 74; 18 O. G. 1177.
Hill v. Sawyer, June 1887. 31 Fed. Rep. 282.

IN DECISION OF COMMISSIONER OF PATENTS:

Sargent & Burge, 1876. 10 O. G. 285.

IN TEXT-BOOKS:

2 Abb. Pat. Law, 1886, pp. 201, 251.
Walker on Pats., 1888, pp. 126, 252, 258.

Syllabus.

ERASTUS CORNING AND JOHN F. WINSLOW,
PLAINTIFFS IN ERROR, v. PETER A. BURDEN.

15 How., 252-272. Dec., 1853.

[Bk. 14, L. ed. 683; 1 Whit. 867.]

Process. Art. Machine. Patentability. Function. Particular patent construed. Liberal construction of ambiguous claim. Experts. Patent prima facie evidence. Innocent infringer. Mitigation of damages.

1. "Process," "art" and "machine" distinguished and defined (p. 94).
2. It is for the discovery or invention of some practical method or means of producing a beneficial result or effect that a patent is granted, and not for the result or effect itself (p. 95).
3. It is when the term process is used to represent the means or method of producing a result, that it is patentable, and it will include all methods or means which are not effected by mechanism or mechanical combinations (p. 95).
4. "Function" of a machine defined; it is not patentable (p. 95).
5. Patent No. 1890, Burden H., Dec. 10, 1840, Rolling Puddle Balls, the claim in view of its ambiguity, construed, in order to be sustained, to be for a new machine or combination of mechanical devices, and not for a process (p. 96).
6. Where the claim was ambiguous and equivocal in terms, which might be construed to mean either a process or a machine, but the title of the patent and the specification were for a machine, the claim was construed most favorably for the patentee, "*ut res magis valat quam pereat*" and not to be for a function, effect or result which would endanger the patent (p. 97).
7. Experts may be examined as to the meaning of terms of art, but not as to the construction of written instruments. The refusal of the court to hear their opinion as to the construction of a patent held proper (p. 97).
8. Under the Acts of 1836 and 1839 the patent is *prima facie* evidence of the truth of the facts asserted in it (p. 98).
9. Where a defendant uses a patented machine, he has a presumption in his favor, arising from the grant of the patent, that it

Statement of the case.

- is new and not an infringement of the patent previously granted to the plaintiff (p. 99).
10. It shows that defendant has acted in good faith, is not a wanton infringer, and subject to the same stringent rule of damages which might be justly inflicted on a mere pirate (p. 99).
11. Where defendants infringers justified under a later patent, *held* that the court erred in refusing to permit them to read it to the jury (p. 100).

THIS case was brought up by writ of error from the Circuit Court of the United States for the Northern District of New York.

Peter A. Burden, as assignee of Henry Burden, brought his action against Corning and Winslow for a violation of a patent granted to Henry, as the original and first inventor and discoverer of a new and useful machine for rolling puddle balls, or other masses of iron, in the manufacture of iron.

What took place at the trial is set forth in the opinion of the court. Under the instructions of the Circuit Court, the jury found a verdict for the plaintiffs, with one hundred dollars damages; upon which the defendants brought the case up to this court by a writ of error.

HENRY BURDEN, CITY OF TROY, NEW YORK, LETTERS PATENT No. 1890, DATED DECEMBER 10, 1840.

The schedule referred to in these letters patent and making part of the same.

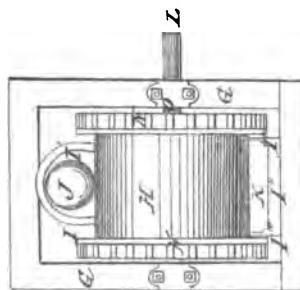
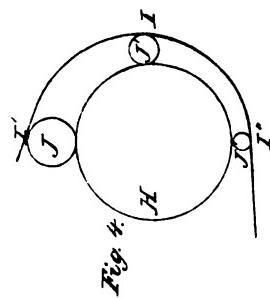
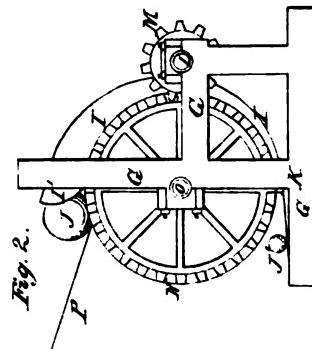
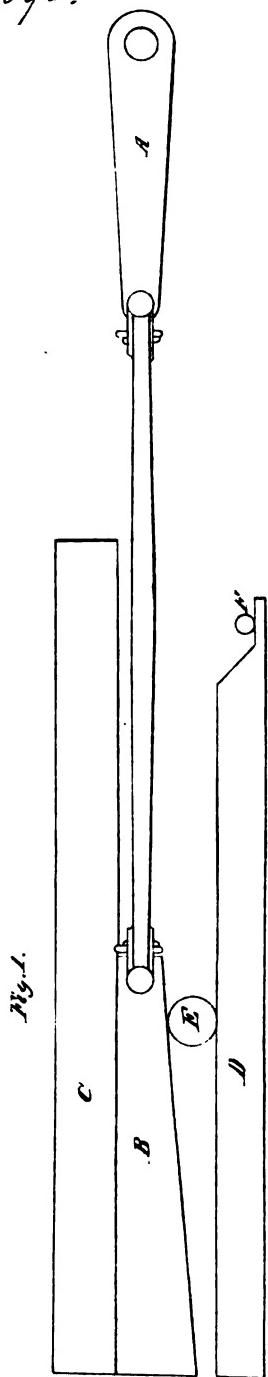
To all whom it may concern: Be it known that I, HENRY BURDEN, of the city of Troy, in the county of Rensselaer, and State of New York, have invented an improvement in the process of manufacturing iron, which improvement consists in the employment of a new and useful machine for the rolling of Puddler's Balls, or balls prepared in the Puddling Furnace, and of other similar masses of iron, by which rolling they are more perfectly and rapidly prepared for the process of being drawn out into bars by means of the rollers ordinarily employed for that purpose, or under the tilt-hammer. My rolling machine dispenses with the

H. Burden,

Rolling Puddlers Balls;

No 1890.

Patented Dec. 10, 1840.





Statement of the case.

shingling or other methods heretofore adopted of preparing the bloom for being drawn out into bars.

The Puddler's ball is conveyed into my machine immediately from the furnace, and it is therein rolled down and elongated between two plane or curved surfaces, and made to assume a cylindrical form; a progressive motion being given to one or both of these surfaces during the time the mass of metal is between them, so as to cause the ball to roll over and over, separating from it a large portion of the cinder, and other foreign matter, reducing it in diameter, and finally delivering it in a cylindrical form.

The machine as I now construct it, consists of a cast iron cylinder, which may be from four to six feet in diameter, and three feet, more or less, wide; said cylinder being in part surrounded by a trough-like stationary concave, sufficiently distant from it at one end to admit the Puddler's ball, and gradually approaching nearer and nearer to it, along its whole length, until it arrives at the point at which the bloom is delivered in a state ready for the subsequent operations of the manufacturer.

To exemplify the principle upon which my machine operates, I will, before describing it more particularly in the form in which I now use it, show it in that in which my first essays were made, and which I have represented in fig. 1, in the accompanying drawings. In this figure, A, represents a crank having a throw of four or five feet, and attached by a shackle bar to a wedge-formed piece of cast iron, B, of corresponding length, and of sufficient width for the formation of the bloom; the piece, B, is supposed to be sustained, and to slide against the stationary guide, or top piece, c, and above the bed piece, D. If, in the position represented, a Puddler's ball, E, be placed between B and D, it will, by the revolution of the crank, be rolled over and over, will be reduced in diameter, be brought into and delivered in a cylindrical form, as shown by the end view of it at E. Figs. 2, 3, and 4 represent my machine in the form in which I now construct it, and in each of the figures the same letters of reference are used to designate like parts.

Fig. 2 is a side view, fig. 3 a front view, and fig. 4 a

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diagram showing the relationship of the cylinder and concave to each other. G is the framework of the machine, which may be made of cast iron. H is a cylinder of cast iron, which is to revolve in said frame, and which may be from four to six feet more or less in diameter, and three feet more or less wide.

The surface of this cylinder may be even, or it may be furnished with protuberances on its periphery, for the purpose of giving a kneading motion to the particles of the mass which is rolled, should this be preferred. I is a curved segmental trough of cast iron, which partially surrounds the cylinder, and which is firmly attached to the frame G G. A ball of puddled iron, J, is represented as entering the mouth of the trough at I' I'; the form given to the trough or concave at that part being that of a semi-circle at its upper portion, and having parallel sides near to the cylinder. The curved trough becomes wider and shallower throughout the circuit intended to be given to the ball, until, at its termination or point of delivery K, its back I'' is parallel with the cylinder, whilst its sides or flanches, I''' I''', are so shaped as to act upon and upset the ends of the bloom, which is consequently delivered in a cylindrical form such as is represented at J''', fig. 2. In the diagram, fig. 4, the line H represents the outline of the cylinder, the line III that of the interior of the trough, in a section along its middle, showing how the ball J must necessarily and progressively be reduced in its diameter as seen at the middle, J', and until, at J'', it makes its escape in the form of a cylinder. L is the driving shaft of the machine, which carries two pinions, one of which is shown at M, fig. 2, meshing into the cog-wheel N, on one end of the cylinder, each end of the cylinder being similarly furnished with a cog-wheel, as shown in fig. 3; the second pinion, similar to M, is hidden by the other parts of the machine. O O is the shaft of the cylinder, H, supported upon proper bearings.

In my establishment the puddling furnace is situated several feet above my machine for rolling the balls, and they are, therefore, most conveniently fed to the machine down an inclined plane represented by the line P, fig. 2. But in

Statement of the case.

many, and probably in most, situations, it will be more convenient to feed them in below, and deliver them above, reversing the segmental trough for that purpose. The segment also may be made to surround nearly, or quite, three-fourths of the cylinder, only allowing sufficient space for the convenient entrance and delivery of the blooms. The cylinder, if preferred, be made to revolve horizontally, the only change required in this case would be the turning the machine down on one side, and the adapting the driving parts thereto.

It will be readily perceived, also, by the skillful machinist, that the principle upon which I proceed may be carried out under various modifications, of which I have given two examples, and these might be easily multiplied, but this I do not think necessary, as I believe that those which have been given must suffice to show, in the clearest manner, the nature of my invention, and to point out fully what I desire to have secured to me under letters patent of the United States.

Having thus fully made known the nature of my said improvements, and explained and exemplified the manner in which I construct the machinery for carrying the same into operation, what I claim as constituting my invention, and desire to secure by letters patent, is the preparing of the puddler's balls as they are delivered from the puddling furnace, or of other similar masses of iron, by causing them to pass between a revolving cylinder and a curved segmental trough adapted thereto, constructed and operating substantially in the manner of that herein described and represented in figs. 2 and 3, of the accompanying drawings; or by causing the said balls to pass between vibrating or reciprocating tables, surfaces, or plates of iron, in the manner exemplified in fig. 1 in the accompanying drawing, or between vibrating or reciprocating curved surfaces operating upon the same principle, and producing a like result by analogous means.

In testimony whereof I hereunto set my name this eighteenth day of August, in the year 1840.

H. BURDEN.

Witnesses:

THOMAS P. JONES,
GEORGE WEST.

Argument of counsel.

It was argued by *Mr. Seymour* and *Mr. Keller*, for the plaintiffs in error, and by *Mr. Fitzgerald* and *Mr. Stevens*, for the defendants in error.

Each one of the four counsel filed a separate brief. The points presented on the part of the plaintiffs in error are taken from the brief of *Mr. Seymour*, and those on the part of the defendant in error from the brief of *Mr. Stevens*.

Points and Authorities submitted on the part of the Plaintiffs in Error.

First Exception to the Charge.—The court erred in charging the jury that “the letters patent which have been given in evidence by the plaintiff are for a new process, mode, or method of converting puddlers’ balls into blooms by continuous pressure and rotation of the balls between converging surfaces, thereby dispensing with the hammer, alligator-jaws, and rollers, accompanied by manual labor, previously in use to accomplish the same purpose; and the said letters patent secure to the patentee the exclusive right to construct, use, and vend any machine adapted to accomplish the objects of his invention, as above specified, by the process, mode, or method above mentioned.”

I. The court erred in charging the jury that Burden’s patent was for a new process, mode, or method.

A process or mode may be patented. *Curtis*, pp. 65, 66, 67, 68, 69, 70, 71, 73, and cases there cited, from section 77 to 83.

1. Burden did not patent a process, but a machine.

What he designed to cover by his patent is to be gathered from the patent itself, the specification, and its summing up. *Webster on Subject-matter*, p. 18, and note Z; *Davoll v. Brown*, 1 *Wood. & Min.* 59; *Russell v. Crowley et al.*, 1 *Cromp. Mees. & Rosc.* 864 [2 *Am. & Eng.* 9]; *Moody v. Fiske*, 2 *Mason*, 112; *Rex v. Cutler*, 1 *Starkie*, 283 [1 *Am. & Eng.* 225]; *Le Roy v. Tatham*, 14 *How.* 156, 171 [5 *Am. & Eng.* 313]; *Wyeth v. Stone*, 1 *Story*, 285; *Gray v. James*, *Peters C. C. R.*, 394—400; *Mr. Justice NELSON’s opinion in Appendix A*, annexed.

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2. Burden's patent claims that he has invented a new and useful machine, &c., not a process.

3. The specification, which purports to be a part of the letters patent, states the invention to consist in a "machine," not in a process.

4. The summing up of the specification or the claim is substantially for a "machine."

And he specifies three modes of applying the principle of his invention; thus complying with the requisition of the sixth section of the act of 1836, in reference to all patents for machines, and for machines only.

The preparing of puddlers' balls is not claimed as an invention, nor could it be, for it is as old as the art of making iron by the process of puddling. See Encyclopædia Americana, vol. 7, art. Iron, p. 72. The preparing puddlers' balls by pressure is not claimed, for that, too, is old. *Id.* But the claim is for the invention of the new mechanism for preparing puddlers' balls.

II. An invention, such as Burden's is described to be in the patent and specification, is, upon the authority of elementary works and the decisions of our courts, a machine, and not a process.

The distinction between a patent for a machine and a patent for a process is well known.

1. A patent for a machine is defined by Curtis, section 93, as follows: "If the subject of the invention or discovery is not a mere function, but a function embodied in some particular mechanism, whose mode of operation and general structure are pointed out, and which is designed to accomplish a particular purpose, function, or effect, it will be a machine in the sense of the Patent Law."

If the specification describes "not a mere function, but a machine of a particular structure, whose modes of operation are pointed out to accomplish a particular purpose or end, the patent is for a machine, and not for a principle or function detached from machinery." *Blanchard v. Sprague*, 3 Sumn. 540.

A method or process may be the subject of a patent. See *Phillips*, pp. 93, 94; *Curtis*, secs. 80, 81.

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Among the cases cited (see Curtis, sec. 79) of patents for a method, or, as the writer expresses it, "for the practical application of a known thing to produce a particular effect," are—

Hartley's invention to protect buildings from fire, by the application of plates of metal. See, also (Hartley's Patent), Webster's Patent Cases, pp. 54, 55 (Arkwright's Patent, Ibid.), 56, and note, pp. 55 and 56.

Forsyth's patent for the application of detonating powder, which he did not invent, to the discharge of artillery, mines, &c.

In this case the patentee succeeded in an action against the party using a lock of different construction from any shown in the drawing annexed to his specification; and, as Curtis says, "thus established his right to the exclusive use and application of detonating powder as priming, whatever the construction of the lock by which it was discharged." (Forsyth's Patent), Webster's Patent Cases, pp. 95, 97, note [1 Am. & Eng. 325].

Hall's patent, for the application of the flame of gas to singe off the superfluous fibres of lace and other goods, is another of this class. Webster's Patent Cases, p. 99.

The plaintiff had a verdict, founded on his sole right to use gas-flame for the clearing of fibres from lace. Curtis, p. 67, note 1; (Hall v. Jarvis), Webster's Patent Cases, p. 100; (Clegg's Patent, Ibid.), 103; Neilson v. Harford, Id. 191 [3 Am. & Eng. 231], &c.; Neilson v. Thompson, Id. 275 [3 Am. & Eng. 136]; The Househill Co. v. Neilson, Id. 673; Boulton v. Bull, 2 H. Blackst. 492 [1 Am. & Eng. 59]; Clegg's Patent, Web. Pat. Cases, 103; Morse's Patents; McClurg v. Kingsland, 1 How. 202 [4 Am. & Eng. 382]; Russell v. Cowley, Web. Pat. Cases, 459 [2 Am. & Eng. 3].

2. The preparing a puddler's ball is reducing and compacting it by pressure into the form of a bloom. See Encyclopædia Americana, vol. 7, art. Iron, p. 72; Nicholson's Op. Mechanic, pp. 334-335; Ure's Dic. of Arts and Manufactures, p. 703.

If Burden's claim, then, is for the reducing and com-

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pacting the ball by pressure into the form of a bloom, it is a claim for a process long before known in the manufacture of iron, and would, therefore, be void, for want of novelty.

To avoid this difficulty, the statement of the claim goes on to say that he claims the preparing these balls by causing them to pass between curved or plane surfaces, in the manner described in his drawings and in the specification of the several parts of the machine.

If the words, "the particular method of the application," were correctly held, in *Wyeth v. Stone*, before cited, to mean the particular apparatus and machinery described in the specification, is not the claim for preparing puddler's balls, by causing them to pass through a certain machine, as clearly a claim for the invention of the machine?

Wyeth claimed not only the art or principle of cutting ice of a uniform size, but "the particular method of the application of the principle;" and this last part of the claim was held to be the only valid part of it, and to be a claim of the particular apparatus and machinery described in the specification to effect the purpose of cutting ice.

So *Burden's* patent, if it be sustained at all, must be held to be a patent for the particular apparatus and machinery described in the specification to effect the "preparing the puddlers' balls." See, also, the case of *Blanchard v. Sprague*, 3 Sumn. 535.

It was objected, on the trial in this last case, "that the plaintiff's specification was defective; that he claimed the functions of the machine, and not the machine itself."

Mr. Justice Story (at page 540) says: "Looking at the present specification, and construing all its terms together, I am clearly of opinion that it is not a patent claimed for a function, but it is claimed for the machine specially described in the specification; that it is not for a mere function, but for a function as embodied in a particular machine, whose mode of operation and general structure are pointed out.

If to claim a "method" or mode of operation in the abstract, explained in the description of certain machinery, be a claim for a machine, as was adjudged in *Blanchard v. Sprague*, is not the claim of preparing puddlers' balls by

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the operation of certain machinery, much more a claim of a machine? In other words, is the claim of a particular result before known, from the operation of a machine claimed to be new, anything else than a claim for the peculiar construction of the machine itself, by which that result is effected?

3. Again, the result claimed by Burden is to produce a bloom from a puddle ball by pressure, welding together the particles of iron, and expressing in part the impurities, and partly shaping the mass for the after operation of converting it into bars, also by pressure.

It cannot be pretended that Burden invented this, or any part of it. This was all done, before his invention, under the hammer and the alligator-jaws. But it may be said that he invented an improvement in this process. This cannot be; for he only compresses the mass to cement the particles, express the impurities, and give shape. All this was done before by the hammer and the jaws, and, in the opinion of many, better done than he does it.

4. Again, it may be said that he made an improvement in the operation by making it continuous. This brings the matter to a true test, and shows that it is the invention of a machine to render the operation continuous, which before had been intermittent.

5. It may be claimed that he has invented or introduced the element of self-action. This establishes the defendant's proposition, that Burden's patent is only for a machine; for the meaning of this is, as the term self-action must be predicated of material substances, that he has substituted an organization of machinery to perform automatically what was before performed partly by hand and partly by machinery. Machines for nail cutting, making hook-head spikes, carding and spinning, weaving, felting, are self-acting machines, which have been invented to carry on known processes; all have the element of self-action, and yet all of them have been recognized as machines, and not processes.

III. The plaintiff, in his declaration, counts upon his patent as a patent for a machine only, and not for a pro-

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cess. He ought to be permitted to recover only *secundum allegata et probata*.

IV. But suppose the patent be for a process and not for a machine; then we submit that the court erred in sustaining the patent as a patent for a new process of preparing puddlers' balls, by continuous pressure and rotation of the balls between converging surfaces.

1. For this process itself is a well-known and common process in the arts, and, therefore, could not be patented at the time of the alleged invention.

The operation to which the puddlers' ball is subjected—that is, the process—produces common results, necessarily arising from pressure on all soft and porous substances, to wit, condensation, expression of matter, and change of form.

2. All the experts testify that Burden's invention consists in carrying on the old process of reducing a puddler's ball to a bloom by pressure, created and continued by his machinery.

That the machinery by which such pressure may be applied is patentable, is obvious. But aside from the peculiar construction of Burden's machinery, there is nothing new in its application. It is merely the application of a known mode of operation in the arts to produce a known result—that is, mechanical pressure, to produce a bloom out of a puddler's ball. See Curtis, p. 78, sect. 88.

That this form of applying mechanical pressure is not new, was approved by, etc.

3. Notwithstanding the condition embodied in the second proposition contained in the charge of the court,—as follows: "The machines for milling buttons, milling coin, and rolling shot, which have been given in evidence by the defendants, do not show a want of novelty in the invention of the said patentee, as already described, if the processes used in them, the purposes for which they were used, and the objects accomplished by them were substantially different from those of the said letters patent,"—yet, taken in connection with the construction given by the court to the patent in the first proposition contained in the charge, the defendants were deprived of the defense to which they were

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entitled, to wit, that the reducing puddlers' balls to blooms, by their rotation and pressure between converging and continually-approximating surfaces, was but a double use of a process or machine long before used in milling buttons, milling coins, and rolling shot.

For the court had decided, in the first proposition of the charge, that Burden's patent was "for a new process of converting puddlers' balls into blooms, by continuous pressure and rotation of the ball between converging surfaces."

In other words, that the application by the plaintiff's machine to the puddler's ball, of the old method of reducing and compacting metals by the continuous pressure of converging surfaces, constituted such a novel process in the manufacture of iron that (its utility not being questioned) the plaintiff's patent was good, notwithstanding the previous use of the milling-machine on copper, silver, and gold, and of the shot-machine on lead, in compacting and reducing those metals by the rotation of the metals and the continuous pressure of converging surfaces.

4. Burden's patent is clearly a case of double use. See *Curtis on Patents*, section 85 to 89, and notes and cases therein cited; *Losh v. Hague*, Webster's patent cases, 207 [2 Am. & Eng. 501]; *Howe v. Abbott*, 2 Story, 190-193.

To this defense the defendants were clearly entitled. The processes of milling the coin, finishing the edges of the buttons, making the shot or balls, and making the blooms are strictly identical.

V. The court erred in charging the jury as they did in the latter clause of the first proposition contained in the charge, to wit: "And the said letters patent secure to the patentee the exclusive right to construct, use, and vend any machine adapted to accomplish the objects of his invention, as above specified, by the process, mode, or method above mentioned."

Also in laying down the third proposition in his charge, to wit: "That the machine used by the defendants is an infringement of the said letters patent, if it converts puddlers' balls into blooms by the continuous pressure and rotation of the balls between converging surfaces, although

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its mechanical construction and action may be different from that of the machines described in the said letters patent."

Also in excluding the testimony offered by the following question, to wit: "By changing the form of the rolling surfaces in Mr. Winslow's machine, can it be made to roll a sphere?"

Also the testimony offered as follows: "The counsel for the defendants then offered to prove by this witness that the machine used by the defendants differed, in point of mechanical construction and mechanical action, from the machines described in Burden's specification."

All these propositions were thus erroneously adjudged against the defendants, as a sequence or corollary following from the first main proposition which the court had laid down against the defendants, to wit, that the plaintiff's patent was for a process, and not for a machine. The court in substance held, that, although the mechanical construction and action of the defendant's machine might be different from that of the plaintiff's, it was still an infringement if it reduced the balls to blooms by continuous pressure and rotation.

This was an erroneous position; for one thing was certain: we had the right to reduce puddlers' balls to blooms by any machine having a different action from that of the plaintiff's. Curtis, section 96, n. 2; Whittemore *v.* Cutter, 1 Gallison, 478-491; Barrett *v.* Hall, 1 Mason, 470.

In the light of these authorities, proof of different mechanical construction and different action was competent and highly pertinent to establish "a peculiar structure," and the production of a new effect.

VI. The court erred in excluding the evidence offered to be given by the witness Hibbard, to wit: "That the practical manner of giving effect to the principle embodied in the machine used by the defendants was entirely different from the practical manner of giving effect to the principle embodied in Mr. Burden's machine; that the principle of the two machines, as well as the practical manner of carrying out those principles, was different; and that the machine used by the defendant produced by its action on the

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iron a different mechanical result, on a different mechanical principle, from that produced in Burden's machine."

The witness was an *expert*, and no objection was urged on that score, or to the form of the question. *Silsby v. Foote*, 14 How., 218, 225 [5 Am. & Eng. 411].

This offer embraced legitimate proof tending to establish a general proposition material to the issue, to wit:

That the defendant's machine was constructed on a different principle, or had a different mode of operation from the plaintiff's.

Proof that the principle of one machine was different from that of the other was tantamount to proof that their mode of operation was different; for two machines, different in principle, cannot well have the same mode of operation, although they may produce the same result.

But the defendant not only offered to prove that the machines were different, but also that they produced on the iron a different mechanical result. See *Curtis on Patents*, p. 264, section 222; also, p. 285; also p. 286, section 241.

In conclusion, the court, in this case, should have held that the plaintiff's patent was for a machine. And on the question of novelty, the court should have left it to the jury as a question of fact, to find upon the testimony, whether the plaintiff's machine was the same in its principle or *modus operandi* as the milling, button, or shot machine. And on the question of infringement, the court should have left it to the jury, upon the testimony, to find whether the defendant's machine was the same in its distinctive character or principle as the plaintiff's.

Brief on the part of Defendant in Error.

First. The whole question in this cause depends upon the correctness of the construction contended for by the counsel for the defendant in error, and which the judge gave to the patent on the trial. If this construction be correct, the other two instructions given by the learned judge to the jury are also correct, and follow as necessary corollaries. *Curtis on Patents*, sects. 146, 147, 148.

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Second. The construction of the patent given by the court on the trial, by the first instruction to the jury, was correct.

I. The *patent* (that is, the parchment) made out at the Patent Office, by the proper officer in that department, does not in any case, according to the Patent Law of this country, describe the thing patented. To ascertain the thing patented, the specification, which is filed before the patent is issued, is the test in all cases as to what the patent secures to the patentee; and to ascertain that, the whole specification must be consulted; and the modern decisions have declared that a liberal construction must be given to it in favor of the patentee. Patent Act of 1836, sect. 5; Curtis on Patents, sects. 122, 123, 126, 127; Ames *v.* Howard, 1 Sumn. 482, 485; Hogg *v.* Emerson, 6 How. 437, 482 [5 Am & Eng. 1]; Davoll *v.* Brown, 1 Wood. & Min. 53, 57.

It is undoubtedly true, if the description or title of the invention, as stated in the patent, is irreconcilably repugnant to the description of the invention contained in the specification, as if the description in the patent be a machine for making nails, and the invention described in the specification is of a machine for carding wool, the patent would be void, upon the ground that the government had not given to the patentee a legal exclusive title to his invention. But nothing can be deduced from this principle of law to sustain the position that the invention is only what it is stated to be in the title stated in the patent; but, on the contrary, the very reverse of that position is what renders the patent void in such cases.

In this case there is no such repugnancy. True, the patent states the invention to be of a new and useful machine for rolling puddle balls, &c., but this is not so repugnant to the description of the invention contained in the specification as would preclude the court from adjudging that the government intended to and did grant the patent for the invention described in the specification, to wit: for an improvement in the process, &c. Unless the title of the invention described in the patent is clearly repugnant

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to the description of the invention in the specification, the patent will be deemed to be a grant of the exclusive right to the invention described in the specification, but it cannot diminish the extent of the invention described and claimed in the specification.

In short, the description of the invention in the specification is the act of the inventor, for which, if it be new and useful, the government is bound to grant him a patent. The granting of the patent is the act of the government, and if the description in that grant be not clearly repugnant to that which the inventor claimed and was entitled to, it will be deemed to be a grant of the thing to which he was entitled.

II. By any just or legal construction of the specification forming a part of the patent in question, and giving the only description of the invention for which the patent issued, said patent is for a new process, mode, or method of converting puddlers' balls into blooms by continuous pressure and rotation of the ball between converging surfaces, thereby dispensing with the hammer, alligator-jaws, and rollers, accompanied with manual labor, previously in use to accomplish the same purpose, and is not confined to the particular machines described in the specifications and drawings.

The specification commences in these words: "To all to whom it may concern: Be it known, that I, Henry Burden, of the city of Troy, in the county of Rensselaer, and State of New York, have invented an improvement in the process of manufacturing iron." Now, let us here pause for an instant, to inquire, if the patentee really intended to represent his invention as one consisting in a new or improved machine, to be used in the manufacture of iron, why, with his thoughts upon the subject, did he not say so, instead of calling it an "improvement in the process of manufacturing iron?" I confess my utter inability to divine any reasonable answer to this question. The improbability of such a willful misnomer is greatly enhanced by the conceded and well-known fact that a new or improved process is patentable, no less than a new or improved machine.

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Process or method, which in the Patent Law are said to be synonymous, are among the few words in familiar use, machine being another of these words, expressive of the few proper subjects of a patent; so that to hold this to be a patent for a machine, is to impute to the patentee the absurdity not only of omitting to call his invention by its proper name, but of substituting at the outset another name of well-known signification in law, expressly appropriated to another and widely different subject of a patent.

But the specifications contain other expressions which are in strict accordance with the language already quoted, and require the same interpretation. After particularly and clearly describing the process in question, and the means by which it is accomplished, the patentee proceeds as follows: "It will be readily perceived, also, by the skillful machinist, that the principle upon which I proceed may be carried out under various modifications, of which I have given two examples; and these might be easily multiplied, but this is not necessary, as I believe that those which have been given must suffice to show, in the clearest manner, the nature of my invention, and point out fully what I desire to have secured to me under letters patent of the United States." Does this look like only claiming to be the inventor of a specific machine? On the contrary, the patentee refers to the descriptions he has given of the mechanical contrivances by which his process may be carried on, as illustrative only of the "principle" on which he "proceeds;" and, referring to the two machines thus described, he adds, "and these might be easily multiplied." Does this language import an intention to limit his claim to them? But an equally decisive test of the patentee's claim remains yet to be considered. His specification concludes with a summary. "In order to ascertain the true construction of the specification in this respect, we must look to the summing up of the invention, and the claim thereof asserted in the specification; for it is the duty of the patentee to sum up his invention in clear and determined terms; and his summing up is conclusive upon his right and title." *Wyeth v. Stone*, 1 Story, 273, 285.

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The patentee's summary is as follows: "Having thus fully made known the nature of my said improvement, and explained and exemplified the manner in which I construct the machinery for carrying the same into operation, what I claim as constituting my invention, and desire to secure by letters patent, is the preparing of the puddler's balls as they are delivered from the puddling furnace, or of other similar masses of iron, by causing them to pass between a revolving cylinder and a curved segmental trough adapted thereto, constructed and operating substantially in the manner of that herein described and represented in figures 2 and 3 of the accompanying drawings, or by causing the said balls to pass between vibratory or reciprocating curved surfaces, operating upon the same principle, and producing a like result by analogous means."

Now, by his "improvement," mentioned at the commencement of this summary, it is indisputable that the patentee means his invention; and this he describes as being carried into operation by means of machinery constructed for the purpose. With what propriety, then, can it be said that the invention claimed is of the machinery itself? "What I claim," he adds, "as constituting my invention, is the preparing of the puddlers' balls," etc. Is the process of preparing puddlers' balls a machine? If not, is it not a flat contradiction of the language of the patentee to say that he claims to be the inventor of a machine, and not of a process? And what is there in the other parts of the specification to neutralize this explicit and unequivocal language? It is said that the patentee describes and has furnished drawings representing two several machines used by him, the one in his first essays, and the other subsequently. This is true; and it is also true that the two are wholly different, not only in form, but in mechanical construction, having in fact nothing in common, except their mutual adaptation to a like process and effect.

Besides, the court will please to observe that the specification claims no particular form of apparatus for carrying his mode or method of converting puddler's balls into blooms into effect. The patent cannot, therefore, be con-

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strued as confining the invention to the two particular machines which he has described that would accomplish that mode, method, or process. Curtis on Patents, sects. 80, 81; Minter *v.* Wells, Webster's Patent Cases, 130 (2 Am. & Eng. 26).

The specification should be so construed as to make the claim co-extensive with the actual discovery, if the fair import of the language used will admit of it. Curtis on Patents, sect. 132.

III. The patent is not for a principle merely, but for a mode, method, or process, giving two practical means for accomplishing it.

The patentee shows, by his specification, that he had succeeded in embodying the principle, by inventing some mode of carrying it into effect, and thus converting it into a process. "You cannot," said Alderson, B., in Jupe *v.* Pratt, Webster's Patent Cases, 146 (2 Am. & Eng. 464), "you cannot take out a patent for a principle. You may take out a patent for a principle coupled with a mode of carrying the principle into effect. If you have done that, you are entitled to protect yourself from all other modes of carrying the same principle into effect, that being treated by the jury as a piracy of your original invention."

"A mere principle," says Mr. Curtis, "is an abstract discovery; but a principle so far embodied and connected with corporeal substances as to be in a condition to act and produce effects in any art, trade, mystery, or manual occupation, becomes the practical manner of doing a practical thing. It is no longer a principle, but a process." Curtis on Patents, sect. 72; see, also, sects. 77, 78, and notes, pp. 59, 66.

With the requirements of the law in this respect, the patentee has complied in a manner perfectly unexceptionable, and perfectly consistent with the construction of his patent insisted on by the plaintiff. There is not, in the specification, a single expression indicative of an intention to limit his claim as an inventor to one or both of the machines described by him; while, on the contrary, the language plainly infers a fixed purpose to guard against

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such an interpretation. Curtis on Patents, sec, 148, and note 1.

IV. If this construction of the patent is correct, it necessarily follows that the patent protects the patentee from all other modes of carrying the same mode, process or method into effect, which is in substance and effect the principle held by the judge in the last clause of his first instruction to the jury. Jupe *v.* Pratt, Webs. Pat. Cases, 146 [2 Am. and Eng. 464]; Curtis on Patents, sec. 148, and note 1.

Third. The rejection of the evidence offered on page 84 of the record constitutes no ground of error.

I. The decision, if wrong, was cured by the evidence of the same facts afterwards elicited from the witnesses.

II. If the construction of the patent contended for by plaintiff below, and held by the court, is correct, the testimony was properly excluded. Jupe *v.* Pratt, Webs. Pat. Cases, 146 [2 Am. and Eng. 464], *supra*; Curtis on Patents, sec. 148, and note 1.

Fourth. The decision excluding the evidence of Winslow's patents was clearly right.

If the machine used by defendant was an infringement of plaintiff's patent, the fact that Winslow had obtained a patent for it would be no defense; and if it was not an infringement of plaintiff's patent, it was not material in this suit whether it had or had not been patented.

Fifth. In the argument in the court below, on the motion for a new trial on this bill of exceptions, the counsel for the defendants objected that there was a variance between the declaration and the patent given in evidence, unless the court held the patent was for a particular machine or machines. That objection was, however, justly and legally disregarded by both members of the court in their decision of the motion.

The objection is technical; and it is entirely settled by the practice of the State of New York that such objection cannot avail the party, unless taken when the evidence is offered.

No such objection was taken on the trial of this cause,

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nor was there any decision of the court, or any exception on any such question, raised on the trial. Watson's Executors *v.* McLaren, 19 Wend., 563.

Many other authorities might be cited, but it is unnecessary. The member of this court from the State of New York knows this to be the rule, and both the judges of the court below disregarded the objection.

Besides, if the objection had been made at the trial that the patent given in evidence varied from that described in the declaration, the court would have directed the declaration to be amended, by substituting the word process in the place of machine. The defendants could not have been misled or prejudiced by such inaccuracy of description. 2d Revised Statutes of New York, 3d ed., p. 504, sec. 98, p. 520, sec. 7, subdivision 14, and sec. 8; 2d Revised Statutes of New York, 4th ed., p. 510, secs. 169, 170.

Sixth. No question as to the novelty of the invention for which this patent was issued is presented by the record in this cause, except that contained in the second instruction of the judge to the jury. That instruction was right in point of law, and the jury found the fact with the plaintiff below (defendant in error).

Mr. Justice GRIER delivered the opinion of the court.

Peter A. Burden, who is assignee of a patent granted to Henry Burden, brought this suit against the plaintiffs in error for infringement of his patent. The declaration avers that Henry Burden was "the first inventor of a new and useful machine for rolling puddle balls," for which a patent was granted to him in 1840, and that the defendants, Corning and Winslow, "made, used, etc., this said new and useful machine, in violation and infringement of the exclusive right so secured to plaintiffs."

The defendants below, under plea of the general issue, gave notice that they would prove, on the trial, that Henry Burden was "not the first and original inventor of the supposed new and useful machine for rolling puddle balls, etc.;" that the machine of the plaintiff and the principle of its operation was not new, and that the common and well-

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known machines called nobbling-rolls, which were in use long before the application of Burden for a patent, embraced the same invention and improvements used for substantially the same purpose; and after setting forth many other matters to be given in evidence affecting the novelty of plaintiff's machine, the notice denies that the machine used by the defendants was an infringement of that patented by plaintiff, and avers that the machine used by them was described in a patent issued to the defendant Winslow in December, 1847, "for rolling and compressing puddlers' balls," differing in principle and mode of operation from that described in the plaintiff's patent.

To support the issue in his behalf, the plaintiff gave in evidence a patent to Henry Burden, dated 10th of December, 1840, for "a new and useful machine for rolling puddlers' balls and other masses of iron, in the manufacture of iron," and followed it by testimony tending to show the novelty and utility of his machine, and that the machine used by the defendants was constructed on the same principles, and there rested his case.

The defendants then offered to read in evidence the patent of Winslow for his "new and useful improvement in rolling and compressing puddlers' balls." The plaintiff objected to this evidence as irrelevant, and the court sustained the objection and overruled the evidence. This ruling of the court forms the subject of defendant's first bill of exceptions.

The defendants then proceeded to introduce testimony tending to show want of originality in the plaintiff's machine; and, also, that the principle and mode of operation of the defendants' machine was different from that described in the plaintiff's patent; and finally called a witness named Hibbard. This witness gave a history of the various processes and machines used in the art of converting cast iron into blooms or malleable iron. He spoke of the processes of puddling, shingling, and rolling, and attempted to define the difference between a process and a machine. The introduction of this philological discussion seems at once to have changed the whole course of investigation, to the en-

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tire neglect of the allegations of the declaration and of the issues set forth in the pleadings, in support of which all the previous testimony had been submitted to the jury. The defendants' counsel then proposed the following question to the witness: "Do you consider the invention of Mr. Burden, as set forth in his specification, to be for a process or a machine?" This question was objected to, overruled by the court, and a bill of exceptions sealed.

The counsel for the defendants then offered to prove by this witness "that the practical manner of giving effect to the principle embodied in the machine used by the defendants, was entirely different from the practical manner of giving effect to the principle embodied in Mr. Burden's machine; that the principles of the two machines, as well as the practical manner of carrying out those principles, were different; and that the machine used by the defendants produced, by its action on the iron, a different mechanical result, on a different mechanical principle, from that produced in Mr. Burden's machine." To the introduction of this testimony the plaintiff's counsel objected, and it was overruled by the court, and, at the defendants' instance, a bill of exceptions sealed.

The defendants' counsel then proposed to prove "that the machine used by the defendants differed in point of mechanical structure and mechanical action from the machines described in the plaintiff's specification." This testimony was also overruled, and exceptions taken.

After some further examination of witnesses, the learned judge announced his intention of instructing the jury in the three following propositions upon which the defendants' counsel declined to give further testimony, and excepted to his instructions:

"1. The letters patent to Henry Burden, which have been given in evidence by the plaintiff, are for a new process, mode, or method of converting puddlers' balls into blooms by continuous pressure and rotation of the ball between converging surfaces, thereby dispensing with the hammer, alligator-jaws, and rollers, accompanied with manual labor, previously in use to accomplish the same

Opinion of the court.

purpose; and the said letters patent secure to the patentee the exclusive right to construct, use, and vend any machine adapted to accomplish the objects of his invention as above specified by the process, mode, or method above mentioned."

"2. The machines for milling buttons, milling coin, and rolling shot, which have been given in evidence by the defendants, do not show a want of novelty in the invention of the said patentee, as already described, if the processes used in them, the purposes for which they were used, and the objects accomplished by them were substantially different from those of the said letters patent."

"3. That the machine used by the defendants is an infringement of the said letters patent, if it converts puddlers' balls into blooms by the continuous pressure and rotation of the balls between converging surfaces, although its mechanical construction and action may be different from those of the machines described in said letters patent."

As the first instruction of the court contains the most important point in the case, and a decision of it will dispose of most of the others, we shall consider it first in order.

Is the plaintiff's patent for a process or a machine?

A process, *eo nomine*, is not made the subject of a patent in our act of Congress. It is included under the general term "useful art." An art may require one or more processes or machines in order to produce a certain result or manufacture. The term machine includes every mechanical device or combination of mechanical powers and devices to perform some function and produce a certain effect or result. But where the result or effect is produced by chemical action, by the operation or application of some element or power of nature, or of one substance to another, such modes, methods, or operations are called processes. A new process is usually the result of discovery; a machine, of invention. The arts of tanning, dyeing, making water-proof cloth, vulcanizing India-rubber, smelting ores, and numerous others, are usually carried on by processes, as distinguished from machines. One may discover a new and useful improvement in the process of tanning, dyeing, etc.,

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irrespective of any particular form of machinery or mechanical device; and another may invent a labor-saving machine, by which this operation or process may be performed, and each may be entitled to his patent. As, for instance, A has discovered that by exposing India-rubber to a certain degree of heat, in mixture or connection with certain metallic salts, he can produce a valuable product or manufacture. He is entitled to a patent for his discovery, as a process or improvement in the art, irrespective of any machine or mechanical device. B, on the contrary, may invent a new furnace, or stove, or steam apparatus by which this process may be carried on with much saving of labor and expense of fuel, and he will be entitled to a patent for his machine, as an improvement in the art. Yet A could not have a patent for a machine, or B for a process; but each would have a patent for the means or method of producing a certain result or effect, and not for the result or effect produced. It is for the discovery or invention of some practicable method or means of producing a beneficial result or effect that a patent is granted, and not for the result or effect itself. It is when the term process is used to represent the means or method of producing a result, that it is patentable, and it will include all methods or means which are not effected by mechanism or mechanical combinations.

But the term process is often used in a more vague sense, in which it cannot be the subject of a patent. Thus we say, that a board is undergoing the process of being planed, grain of being ground, iron of being hammered or rolled. Here the term is used subjectively or passively, as applied to the material operated on, and not to the method or mode of producing that operation, which is by mechanical means, or the use of a machine, as distinguished from a process.

In this use of the term it represents the function of a machine, or the effect produced by it on the material subjected to the action of the machine. But it is well settled that a man cannot have a patent for the function or abstract effect of a machine, but only for the machine which produces it.

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It is by not distinguishing between the primary and secondary sense of the term "process" that the learned judge below appears to have fallen into an error. It is clear that Burden does not pretend to have discovered any new process by which cast iron is converted into malleable iron; but a new machine or combination of mechanical devices, by which the slag or impurities of the cast iron may be expelled or pressed out of the metal when reduced to the shape of puddlers' balls. The machines used before to effect this compression were tilt-hammers and alligator-jaws, acting by percussion and pressure, and by nobbling-rolls with eccentric grooves, which compressed the metal by use of the inclined plane, in the shape of a cyclovolute or snail-cam. In subjecting the metal to this operation, by the action of these machines, more time and manual labor is required than when the same function is performed by the machine of Burden. It saved labor, and thus produced the result in a cheaper, if not a better, manner, and was therefore the proper subject of a patent.

In either case the iron may be said, in the secondary sense of the term, to undergo a process, in order to change its qualities, by pressing out its impurities; but the agent which effects the pressure is a machine or combination of mechanical devices.

The patent of Burden alleges no discovery of a new process, but only that he has invented a machine, and therefore correctly states the nature of his invention.

The Patent Law requires that "every patent shall contain a short description or title of the invention or discovery, indicating its nature and design," &c. The patent in question recites, that "Whereas Henry Burden, of Troy, New York, has alleged that he has invented a new and useful machine for rolling puddle balls, or other masses of iron, in the manufacture of iron, which he states has not been known or used before his application; has made oath that he is a citizen of the United States; that he does verily believe that he is the original and first inventor or discoverer of the said machine," &c.

The specification declares that his improvement consists

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in "the employment of a new and useful machine for rolling of puddlers' balls"; again, he calls it "my rolling-machine," and describes his "machine as consisting of a cast-iron cylinder," &c. In fine, his specification sets forth the "particulars" of his invention, in exact accordance with its title in the patent, and in clear, distinct, unequivocal, and proper phraseology.

It is true that the patentee, after describing his machine, has set forth his claim in rather ambiguous and equivocal terms, which might be construed to mean either a process or machine. In such case, the construction should be that which is most favorable to the patentee, "*ut res magis valeat quam pereat.*" His patent having a title which claims a machine, and his specification describing a machine, to construe his claim as for the function, effect or result of his machine, would certainly endanger, if not destroy, its validity. His claim cannot change or nullify his previous specification with safety to his patent. He cannot describe a machine which will perform a certain function, and then claim the function itself, and all other machines that may be invented to perform the same function.

We are of opinion, therefore, that the learned judge of the court below erred in the construction of the patent, and in his first proposition or instruction to the jury; and as the second and third instructions are based on the first, they must fall with it. Taking the bills of exception to rejection of evidence in the inverse order, it is clear that the last two rulings, being founded on the erroneous construction of the patent, are, of course, erroneous. The testimony offered was directly relevant to the issues trying, and should have been received.

The refusal of the court to hear the opinion of experts, as to the construction of the patent, was proper. Experts may be examined as to the meaning of terms of art, on the principle of "*cuique in sua arte credendum,*" but not as to the construction of written instruments.

It remains only to notice the first bill of exceptions, which was to the rejection of the defendants' patent.

This is a question on which there may be some differ-

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ence of opinion. In some circuits it has been the practice, when the defendant has a patent for his invention, to read it to the jury without objection. In others it is not received, on the ground that it is irrelevant to the issue, which is a contest between the machine of the defendant and the patent of the plaintiff, and that a posterior patent could not justify an infringement of a prior one for the same invention.

By the Patent Act of 1793, any person desirous of obtaining a patent for an alleged invention made application to the Secretary of State, and received his patent on payment of the fees, and on a certificate of the Attorney-General that his application was "conformable to the act." No examination was made by persons qualified to judge whether the alleged invention was new or useful, or had been patented before. That rested wholly on the oath of the applicant. The Patent Act of 1790 had made a patent *prima facie* evidence; but this act was repealed by that of 1793, and this provision was not re-enacted in it. Hence a patent was not received in courts of justice as even *prima facie* evidence that the invention patented was new or useful; and the plaintiff was bound to prove these facts, in order to make out his case. But the act of 4th of July, 1836, introduced a new system and an entire change in the mode of granting patents. It provided for a new officer, styled a Commissioner of Patents, to "superintend, execute, and perform all acts and things touching and respecting the granting and issuing of patents," &c. The Commissioner was authorized to appoint a chief clerk and three examining clerks, machinist, and other officers.

On the filing of an application the Commissioner is required to make, or cause to be made, an examination of the alleged invention, in order to ascertain whether the same had been invented or discovered by any other person in this country prior to the application, or whether it had been patented in this or any foreign country, or had been on public use or sale, with the applicant's consent, prior to his application; and if the Commissioner shall find that the invention is new and useful, or important, he is authorized

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to grant a patent for the same. In case the decision of the Commissioner and his examiner is against the applicant, and he shall persist in his claim, he may have an appeal to a board of examiners, to consist of three persons appointed for that purpose by the Secretary of State, who, after a hearing, may reverse the decision of the Commissioner, in whole or in part. By the act of 1839, the Chief Justice of the District of Columbia was substituted to the board of examiners.

It is evident that a patent thus issued, after an inquisition or examination made by skillful and sworn public officers, appointed for the purpose of protecting the public against false claims or useless inventions, is entitled to much more respect, as evidence of novelty and utility, than those formerly issued without any such investigation. Consequently, such a patent may be, and generally is, received as *prima facie* evidence of the truth of the facts asserted in it. And in cases where the evidence is nicely balanced, it may have weight with a jury in making up their decision as to the plaintiff's right; and if so, it is not easy to perceive why the defendant who uses a patented machine should not have the benefit of a like presumption in his favor, arising from a like investigation of the originality of his invention and the judgment of the public officers that his machine is new, and not an infringement of the patent previously granted to the plaintiff. It shows, at least, that the defendant has acted in good faith, and is not a wanton infringer of the plaintiff's rights, and ought not therefore to be subjected to the same stringent and harsh rule of damages which might be justly inflicted on a mere pirate. It is true, the mere question of originality or infringement generally turns on the testimony of the witnesses produced on the trial; but if the plaintiff's patent in a doubtful case may have some weight in turning the scale in his favor, it is but just that the defendant should have the same benefit from his: *valeat quantum valeat*. The parties should contend on an equal field, and be allowed to use the same weapons.

We are of opinion, therefore, that the court erred in

Notes and Citations.

refusing to permit the defendant's patent to be read to the jury.

The judgment of the Circuit Court is, therefore, reversed, and a *venire de novo* awarded.

ORDER. This cause came on to be heard on the transcript of the record from the Circuit Court of the United States for the Northern District of New York, and was argued by counsel; on consideration whereof, it is now here ordered and adjudged by this court, that the judgment of the said Circuit Court in this cause be, and the same is hereby, reversed with costs; and that this cause be, and the same is hereby, remanded to the said Circuit Court, with directions to award a *venire facias de novo*.

Notes:**1. A process is an art.**

Cochrane *v.* Deener, 94 U. S. 780.

Tilghman *v.* Proctor, 102 U. S. 707.

New Process Fermentation Co. *v.* Maus., 122 U. S. 413.

2. Result, patentability.

Carver *v.* Hyde, 16 Pet. 513 [4 Am. & Eng. 367].

Le Roy *v.* Tatham, 14 How. 156 [5 Am. & Eng. 313].

Case *v.* Brown, 2 Wall. 320.

Fuller *v.* Yentzer, 94 U. S. 288.

3. Process, patentability.

O'Reilly *v.* Morse, 15 How. 62 [5 Am. & Eng. 483].

Rubber Co. *v.* Goodyear, 9 Wall. 788.

Mowry *v.* Whitney, 14 Wall. 434.

Notes and Citations.

- Mitchell *v.* Tilghman, 19 Wall. 287.
Wood Paper Patent, 23 Wall. 566.
Cochrane *v.* Deener, 94 U. S. 780.
Downton *v.* Yeager Milling Co., 108 U. S. 466.
New Process Fermentation Co. *v.* Maus, 122 U. S. 413.
Lawther *v.* Hamilton, 124 U. S. 1.
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When not.

- Brown *v.* Piper, 91 U. S. 37.
Western Electric Co. *v.* Ansonia Brass, &c. Co., 114 U. S. 447.
Miller *v.* Foree, 116 U. S. 22.
Dreyfus *v.* Searle, 124 U. S. 60.
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Reissue of machine to cover process.

- James *v.* Campbell, 104 U. S. 356.
Heald *v.* Rice, 104 U. S. 787.
Wing *v.* Anthony, 106 U. S. 142.
Eachus *v.* Broomall, 115 U. S. 429.
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Mechanical combination claims cannot be construed to be for process.

- Le Roy *v.* Tatham, 14 How. 156 [5 Am. & Eng. 313].
Railroad Co. *v.* Dubois, 12 Wall. 47.
Grier *v.* Wilt, 120 U. S. 412.
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Notes and Citations.

What is infringement of a process?

Le Roy v. Tatham, 14 How. 156 [5 Am. & Eng. 313].

Goodyear D. V. Co. v. Davis, 102 U. S. 222.

Liability of infringer of process.

Mowry v. Whitney, 14 Wall. 434.

See also Powder Co. v. Powder Works, 98 U. S. 126.

5. Patent construed to be for a machine and not for a process.

Le Roy v. Tatham, 14 How. 156 [5 Am. & Eng. 313].

6. Obscure claim construed to be for a process.

Merrill v. Yeomans, 94 U. S. 568.

Equivocal claim invalid.

Burr v. Duryee, 1 Wall. 531.

The claim should be construed most favorably for the patentee.

Winans v. Denmead, 15 How. 380 [p. post].

Lake Shore, &c. Railway Co. v. Nat. Car Brake Co., 110 U. S. 229.

Result claims construed to intend "means by which."

Mitchell v. Tilghman, 19 Wall. 287.

Fuller v. Yentzer, 94 U. S. 288.

7. Experts, to what they may testify.

Railroad Co. v. Stimpson, 14 Pet. 448 [4 Am. & Eng. 324].

Winans v. Railroad, 21 How. 88.

Tucker v. Spalding, 18 Wall. 453.

Miller v. Foree, 116 U. S. 22.

Notes and Citations.

8. Patent is *prima facie* evidence of inventorship.

Railroad Co. v. Stimpson, 14 Pet. 448 [4 Am. & Eng. 324].

Agawam Co. v. Jordan, 7 Wall. 533.

Blanchard v. Putnam, 8 Wall. 420.

Seymour v. Osborne, 11 Wall. 516.

Mitchell v. Tilghman, 19 Wall. 287.

Smith v. Goodyear D. V. Co., 93 U. S. 486.

Roemer v. Simon, 95 U. S. 214.

Bates v. Coe, 98 U. S. 31.

Of regularity and sufficiency of proofs on which grant is based.

Railroad Co. v. Stimpson, 14 Pet. 448 [4 Am. & Eng. 324].

Of date of invention.

Bates v. Coe, 98 U. S. 31.

Of novelty.

Mitchell v. Tilghman, 19 Wall. 287.

Cantrell v. Wallick, 117 U. S. 689.

10. Defendants operating under a patent not wanton infringers.

Livingston v. Woodworth, 15 How. 546 [p. *post*].

Mowry v. Whitney, 14 Wall. 620.

Notes and Citations.

Patent in suit:

No. 1890. Burden, H., Dec. 10, 1840. Rolling Puddle Balls.

Cited:**IN SUPREME COURT OF UNITED STATES:**

Winans v. Denmead, 1853. 15 How. 330; Bk. 14, L. ed. 717 [p. 107 *post*].
Blanchard v. Putnam, 1869. 8 Wall. 420; Bk. 19, L. ed. 433.
Rubber Co. v. Goodyear, 1869. 9 Wall. 788; Bk. 19, L. ed. 566.
Tilghman v. Proctor, 1881. 102 U. S. 707; Bk. 26, L. ed. 279.
Fermentation Co. v. Maus, 1887, 122 U. S. 413, Bk. 30, L. ed. 1193.

IN CIRCUIT COURTS:

American Pin Co. v. Oakville Co., Sept., 1854. 3 Blatch. 190.
Day v. Stellman, July, 1859. 1 Fish. 487.
Singer v. Walmsley, February, 1860. 1 Fish. 558.
Burden v. Corning, October, 1864. 2 Fish. 477.
Hoffheims v. Brandt, July, 1867. 3 Fish. 218.
Piper v. Brown, May, 1870. 1 Holmes 20; 4 Fish. 175.
Arkell v. Hurd Paper Bag Co., June, 1870. 7 Blatch. 475.
Bridge v. Brown, April, 1871, 1 Holmes 53.
Goodyear Dental Vulcanite Co. v. Gardiner, June, 1871. 3 Cliff. 408; 4 Fish. 224.
MacKay v. Jackman, April, 1882. 20 Blatch. 466; 22 O. G. 85.
12 Fed. Rep. 615.
Boyd v. Cherry, January, 1883. 4 McC. 70.
American Bell Tel. Co. v. Dolbear, January, 1883. 15 Fed. Rep. 448. 23 O. G. 535.
New Process Fermentation Co. v. Koch, May, 1884. 21 Fed. Rep. 580. 29 O. G. 539.

Notes and Citations.

New Process Fermentation Co. *v.* Maus, June, 1884, 20 Fed. Rep. 725.

Excelsior Needle Co. *v.* Union Needle Co., February, 1885. 32 Fed. Rep. 221, 224.

Gage *v.* Kellogg, March, 1885. 23 Fed. Rep. 891; 32 O. G. 381.
Phillips *v.* Kochert, May, 1887. 31 Fed. Rep. 39.

IN DECISIONS OF COMMISSIONER OF PATENTS:

G. L. Harrison, August, 1876. 10 O. G. 373.

Little *v.* Lillie, Pillard & Sargent, September, 1876. 10 O. G. 543.

Starr & Peyton *v.* Farmer, March, 1883. 23 O. G. 2825.

Ex parte Blythe, July, 1884. 30 O. G. 1321.

IN STATE COURTS:

Nash *v.* Lull, September, 1869. 102 Mass. 60.

IN TEXT-BOOKS:

2 Abb. Pat. Law, 1886, pp. 26, 44, 230, 450.

Merwin on Pat. Invt., 1883, pp. 8, 78, 601.

Walker on Pats., 1883, pp. 4, 125, 134, 369.

Curtis on Pats., 4th ed., § 14.

Syllabus.

ROSS WINANS, PLAINTIFF IN ERROR, *v.* EDWARD, ADAM, AND TALBOT DENMEAD.

15 How., 830-848. Dec., 1853.

[Bk. 14, L. ed. 717; 1 Whit. 887.]

Questions of law and fact. Particular patent construed. Form. Liberal construction of claim. "As described." Infringement.

1. What is the thing patented is a question of law for the court ; has it been constructed, used, or sold by the defendants is a question of fact to be submitted to the jury (p. 127).
2. Patent No. 5175 granted Winans, R., June 26, 1847. Coal Car construed to be for a patentable change of form introducing a new mode of operation, and held that while patentee described and claimed a car-body "in the form of a frustum of a cone," it also included (in view of words "substantially as described") such variations of form as substantially embodied his mode of operation and thereby attained the same result (p. 128).
3. Mere change of form is not patentable invention ; but to change the form of an existing machine, and by means of such change to introduce a new mode of operation and thus attain a new and useful result, is the subject of a patent ; and it is the new mode of operation which gives it the character of an invention (p. 130).
4. A claim is not to be given a limited construction if it can fairly be construed otherwise (p. 131).
5. When a patentee describes a machine, and then claims it as described, he claims not only the precise forms he has described, but all other forms which embody his invention ; and it is an infringement to copy the principle or mode of operation described (p. 132).
6. Where form and substance are inseparable it is enough to look to the form only to determine the question of infringement, but, where separable, the substance must be looked for (p. 134).
7. The law interprets the claim to extend to the thing patented, however its form or proportions may be varied, without the addition of these words, unless an intention to disclaim some of those forms is manifested (p. 134).

Statement of the case.

[Citations in the opinion of the Court:]

- Haworth v. Hardcastle, Webs. Pat. Cas. 484 [2 Am. & Eng. 19], p. 131.
- Grant v. Raymond, 6 Pet. 218 [4 Am. & Eng. 245], p. 132.
- Ames v. Howard, 1 Sumn. 482, p. 132.
- Blanchard v. Sprague, 3 Sumn. 535, p. 132.
- Davoll v. Brown, 1 Wood. & Minot 53, p. 132.
- Parker v. Haworth, 4 McLean 373, p. 132.
- Le Roy v. Tatham, 14 How. 181 [5 Am. & Eng. 313], p. 132.
- Nelson v. Harford, Web. Pat. Cas. 341, p. 132.
- Russell v. Cowley, Web. Pat. Cas. 470 [2 Am. & Eng. 9], p. 132.
- Corning v. Burden, 15 How. 252 [p. 69 *ante*], p. 132.
- Davis v. Palmer, 2 Brock 309, p. 133.

[In dissenting opinion:]

- Hotchkiss v. Greenwood, 11 How. 249 [5 Am. & Eng. 240], p. 136.
- Losh v. Hague, Web. Pat. Cas. 207 [2 Am. & Eng. 501], p. 136.
- Winans v. Providence R. R. Co., 2 Story 412, p. 136.
- Howe v. Abbott, 2 Story 190, p. 136.
- Steiner v. Heald, 2 Car. & Kir. 1022, p. 136.
- Dobbs v. Penn, 3 Exch. R., p. 136.
- Davis v. Palmer, 2 Brock, 298, p. 136.
- Curtis on Patents, §§ 4, 26, 27, 86, 87, 88, p. 138.
- Aiken v. Bemis, 3 Wood. & M. 349, p. 138.

THIS case was brought up by writ of error from the Circuit Court of the United States for the District of Maryland.

It was an action brought by Ross Winans for the infringement of a patent-right. The jury, under the instruction of the district judge, the late Judge Glenn, then sitting alone, found a verdict for the defendants; and the plaintiff brought the case to this court by a writ of error.

The nature of the case is set forth in the explanatory statement prefixed to the argument of the counsel for the plaintiff in error.

LETTERS PATENT No. 5175, DATED JUNE 26, 1847.

The schedule referred to in these letters patent and making part of the same.

To all whom it may concern: Be it known that I, Ross WINANS, of the city and county of Baltimore, and State of Maryland, have invented new and useful improvements in Railroad Cars, and that the following is a full, clear, and exact description of the principle or character which dis-

Sheet 1-3 Sheets 5.

R. WINANS.

Coal Car.

N^o 5,175.

Patented Jun. 26, 1847.

Fig. 1.

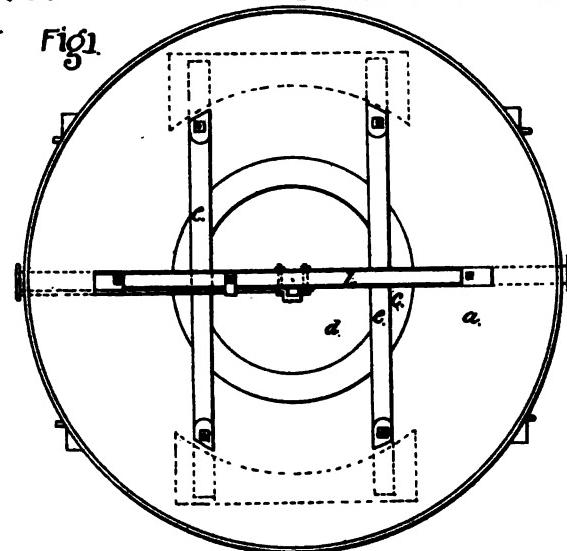
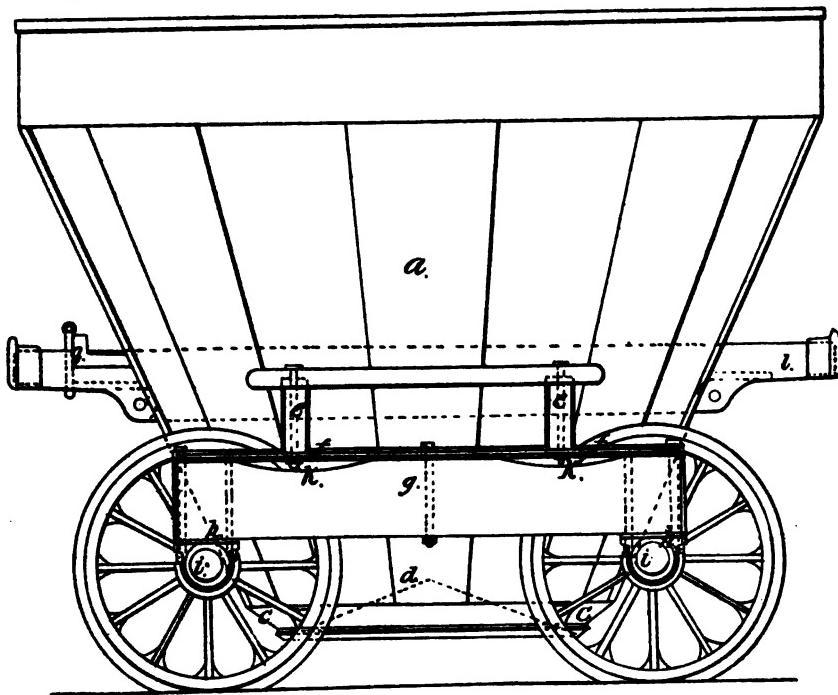


Fig. 2.





R. WINNIS. Sheet 2-3 Sheets.
Coal Car.

N^o 5,175.

Patented Jun. 26, 1847.

FIG. 3.

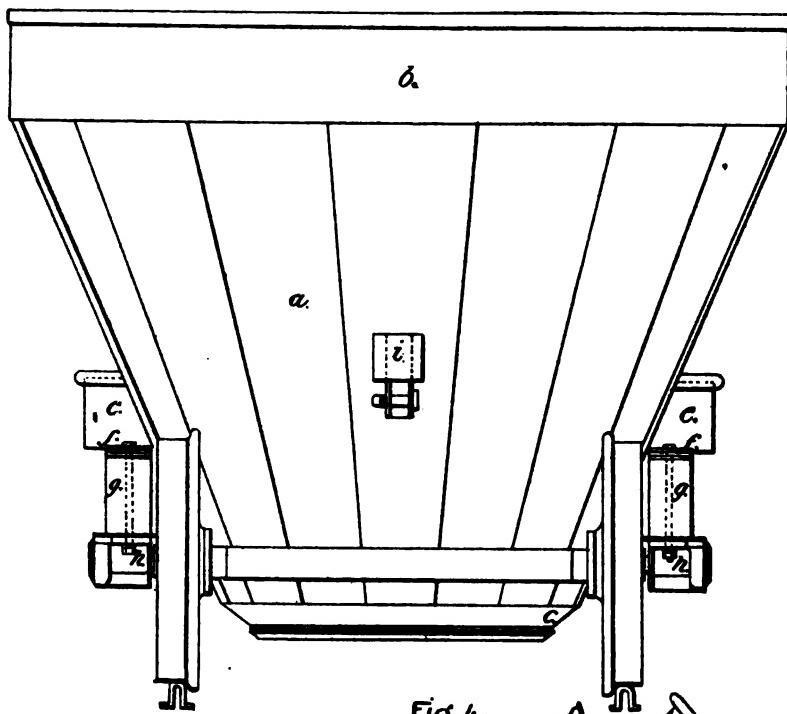
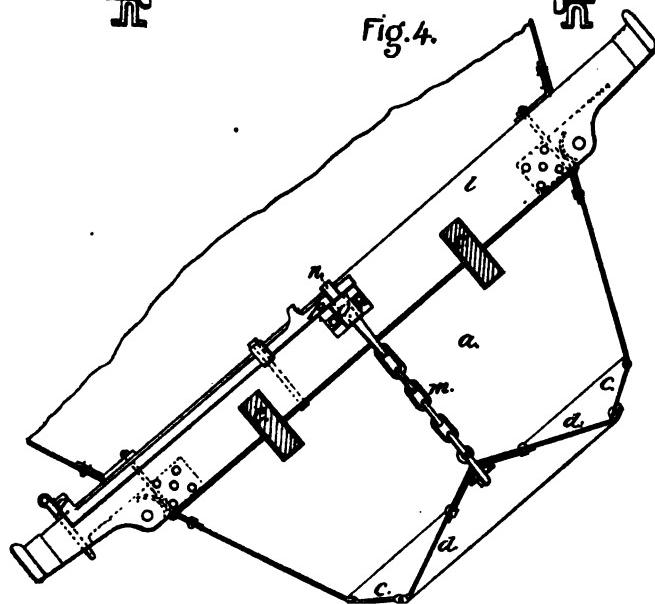
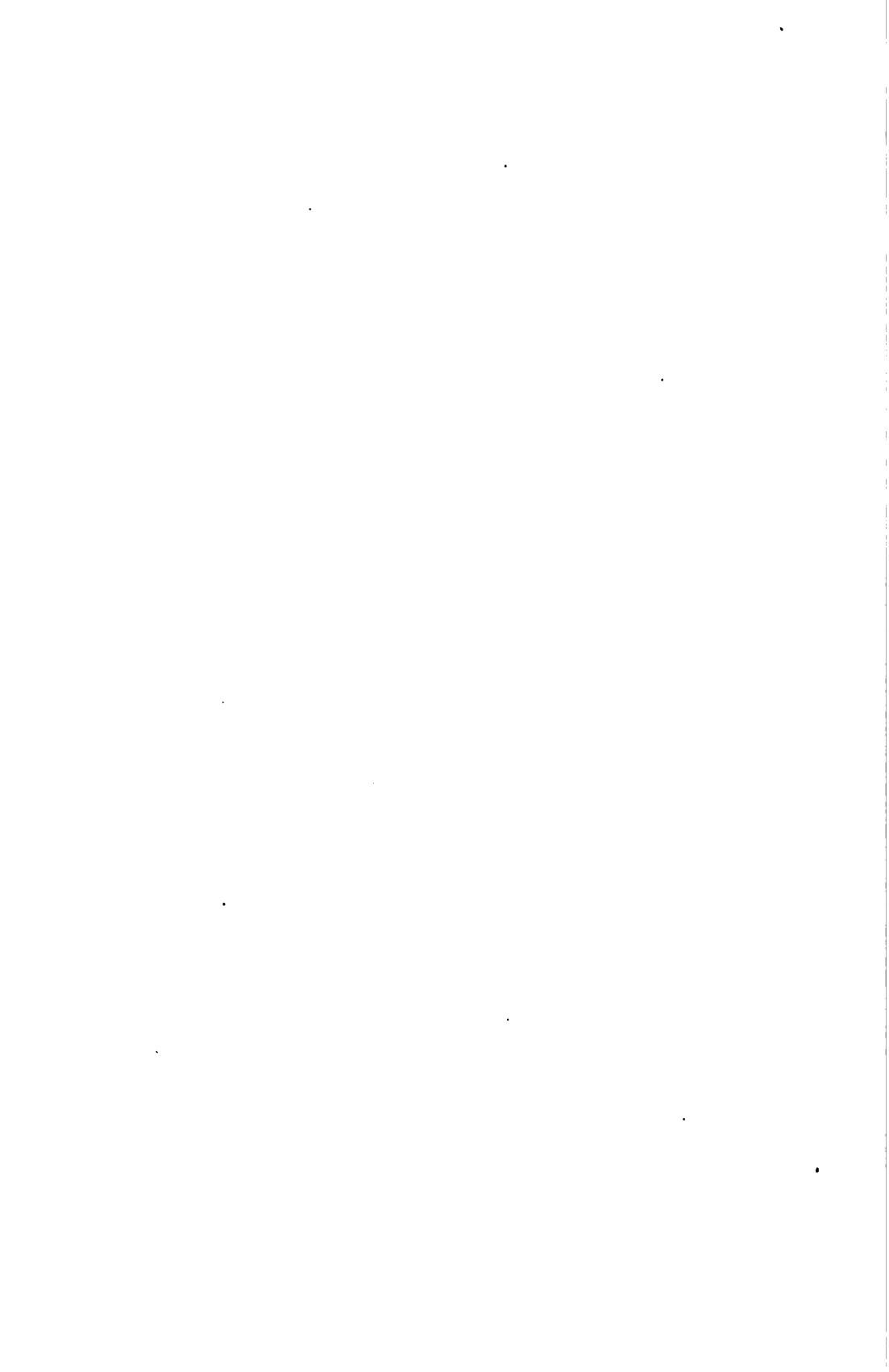


Fig. 4.





Sheet 3-3 Sheets.

R. WILLIAMS.

Coal Car.

N^o 5,175.

Patented July 26, 1847.

Fig. 6.

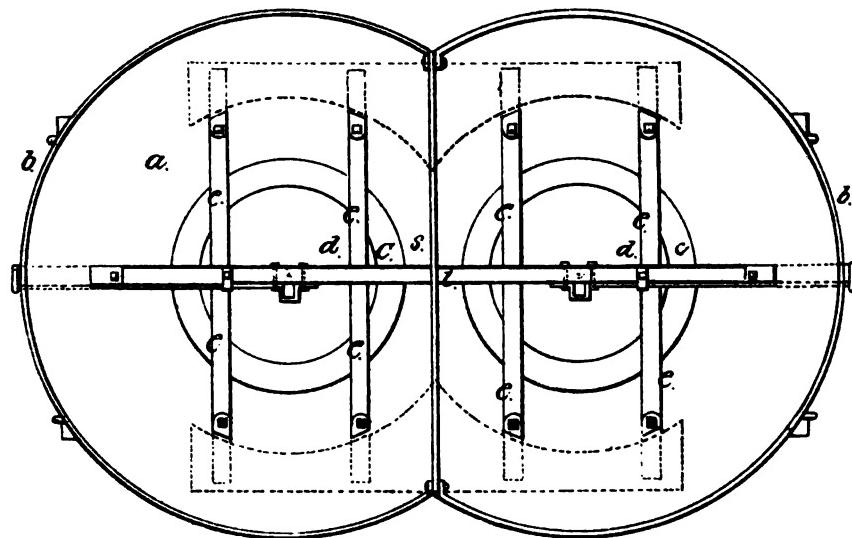
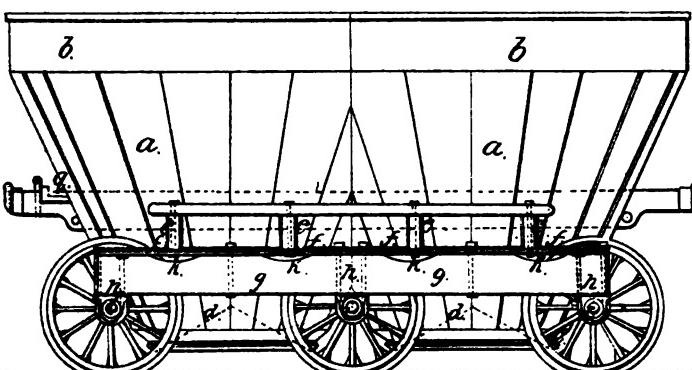
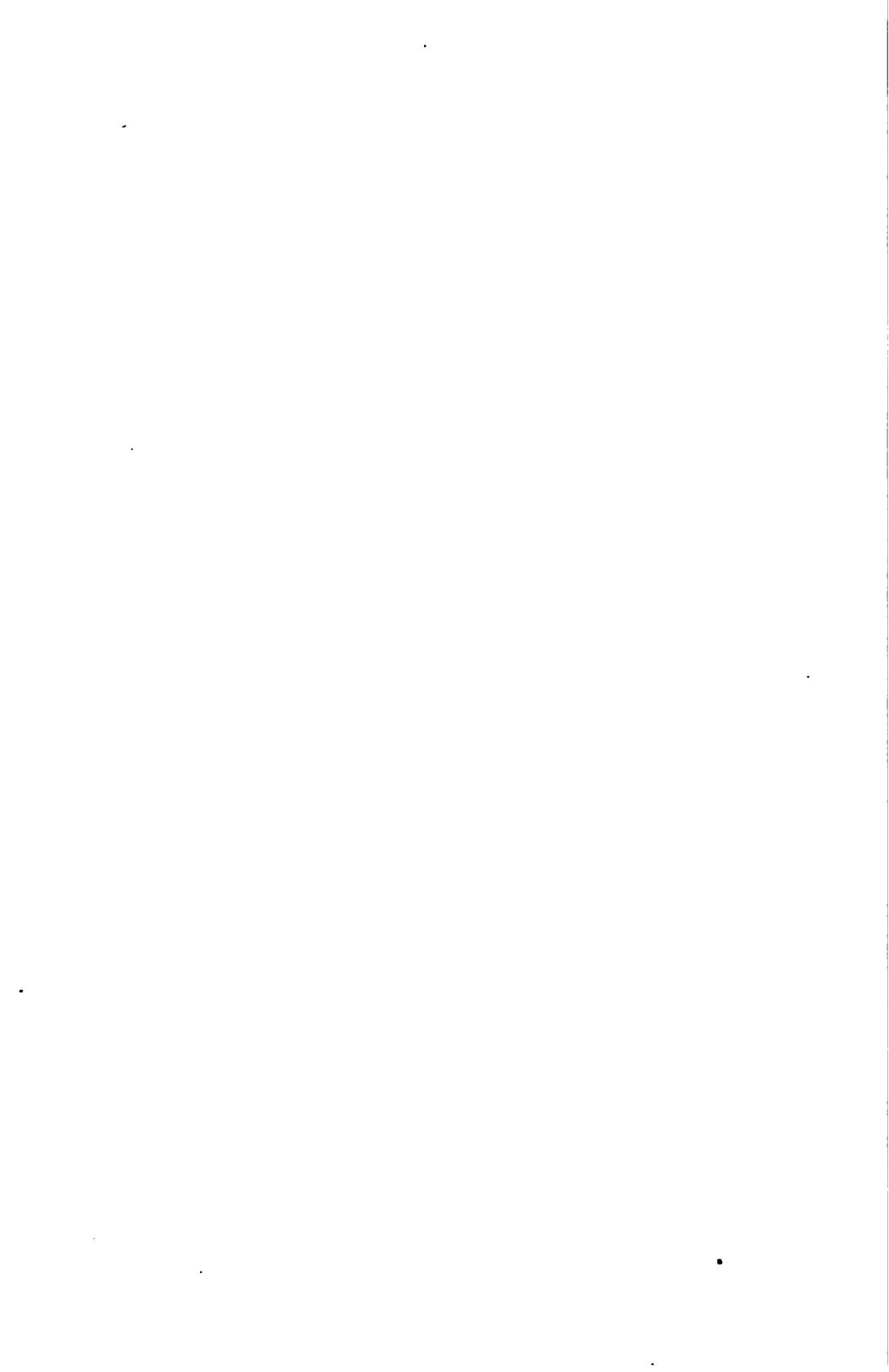


Fig. 5.





Statement of the case.

tinguishes it from all other things before known, and of the manner of making, constructing, and using the same, reference being had to the accompanying drawings making part of this specification, in which fig. 1 is a plan of a car on my improved plan; fig. 2 a side elevation thereof; fig. 3 an end elevation of the same; and fig. 4 a section of the body removed from the truck. The same letters indicate like parts in all the figures.

The transportation of coal and all other heavy articles in lumps has been attended with great injury to the cars, requiring the bodies to be constructed with great strength to resist the outward pressure on the sides as well as the vertical pressure on the bottom, due, not only to the weight of the mass, but the mobility of the lumps among each other, tending to "pack," as it is technically termed. Experience has shown that cars on the old mode of construction cannot be made to carry a load greater than its own weight, but by my improvement I am enabled to make cars of greater durability than those heretofore made, which will transport double their own weight of coal, &c.

The principle of my invention, by which I am enabled to attain this important end, consists in making the body, or a portion thereof, conical, by which the area of the bottom is reduced, and the load exerts an equal strain on all parts, and which does not tend to change the form, but to exert an equal strain in the direction of the circle. At the same time this form presents the important advantage by the reduced size of the lower part thereof to extend down within the truck and between the axles, thereby lowering the centre of gravity of the load.

In the accompanying drawings *a* represents the body of the car made of sheet iron in the form of a frustum of a hollow cone, with the upper part *b* cylindrical. To the lower edge of this is secured a flanch *c*, which forms part of the bottom, and against which the movable bottom *d* closes, as will be described hereafter.

The body of the car is connected with the truck by means of two cross-bars *e e* that pass horizontally through the conical part of it, with their ends resting on bar-springs

Statement of the case.

ff on the top of the side pieces *g g* of the truck, these being provided with boxes *h h* of any desired construction, in which run the journals of the wheel axles *i i*, the lower end of the conical part of the body passing down between the side pieces and the axles of the trucks.

The springs *f f* are plates of steel secured at the ends and middle to the upper surface of the side pieces of the truck, and the bars *e e* that pass through the body of the car are secured to the springs at points midway between their attachment to the side pieces of the truck, the upper surface of these being cut out as at *k k* to give the requisite play to the springs.

The draught-bar, *l*, which forms the connection between the different cars of a train, passes through the conical part of the body above the bars *e e*, and is firmly secured to them so as to relieve the body of the strain due to the draught. To this bar is also secured the movable bottom of the car, which is provided with a chain, *m*, to the end of which is secured a latch-piece, *n*, that passes through a staple, *o*, attached to the draught-bar, and is there secured by a bolt, *p*, that slides on the bar, the head or handle of the bolt being extended outside of the body, as at *q*, so that when the car is to be emptied of its contents the bolt, *p*, is drawn, which liberates the latch-bolt, and permits the movable bottom to fall by the weight of the coal, &c., resting on it.

When desired, the principle of my invention can be modified to make the car double, as represented in the plan, fig. 6, and elevation, fig. 5, plate 2. In the modification the circles of the two bodies intersect each other, and the union is formed between the two by the chord-plate *s*. In this construction there is space enough left between the two cones at the lower end for the middle pair of wheels, such cars being made with six wheels instead of the four used in the first example. It will be obvious that car bodies constructed on the principle of my invention may be connected with and supported on the truck without the bars passing through the body, by having the supports bolted, or otherwise secured to the outside, or to hoops embracing

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the whole circumference; but by these modifications a greater strain will be given to the body than by the arrangement above described.

What I claim as my invention, and desire to secure by letters patent, is making the body of a car for the transportation of coal, &c., in the form of a frustum of a cone, substantially as herein described, whereby the force exerted by the weight of the load presses equally in all directions, and does not tend to change the form thereof, so that every part resists its equal proportion, and by which also the lower part is so reduced as to pass down within the truck-frame and between the axles, to lower the center of gravity of the load without diminishing the capacity of the car, as described.

I also claim extending the body of the car below the connecting pieces of the truck-frame and the line of draught, by passing the connecting bars of the truck-frame and the draught-bar through the body of the car, substantially as described.

ROSS WINANS.

Witnesses:

GEORGE W. WHISTLER, JR.,

JOHN B. EASTER.

It was argued by *Mr. Latrobe*, for the plaintiff in error, and by *Mr. Campbell*, for the defendant in error.

Statement and Points of Plaintiff in Error.

On the 26th of June, 1847, Ross Winans, the plaintiff in error, obtained letters patent of the United States for a new and useful improvement in cars for transportation of coal, &c.

The occasion for the invention thus patented, and the principle of it, are well set forth in the specification, thus:

"The transportation of coal, and all other heavy articles in lumps, has been attended with great injury to the cars, requiring the bodies to be constructed with great strength, to resist the outward pressure on the sides, as well as the vertical pressure on the bottom, due not only to the weight

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of the mass, but the mobility of the lumps amongst each other tending to ‘pack,’ as it is technically termed. Experience has shown that cars on the old mode of construction cannot be made to carry a load greater than their own weight; but by my improvement I am enabled to make cars of greater durability than those heretofore made, which will transport double their weight of coal.

“The principle of my invention, by which I am enabled to obtain this important end, consists in making the body, or a portion thereof, conical, by which the area of the bottom is reduced, and the load exerts an equal strain on all parts, and which does not tend to change the form, but to exert an equal strain in the direction of the circle; at the same time this form presents the important advantage, by the reduced size of the lower part thereof, to extend down within the truck and between the axles, thereby lowering the centre of gravity of the load.”

The specification then gives a detailed description of the mode of constructing the cars in question, and proceeds thus:

“What I claim as my invention, and desire to secure by letters patent, is making the body of a car for the transportation of coal, etc., in the form of a frustum of a cone, substantially as herein described, whereby the force exerted by the weight of the load presses equally in all directions, and does not tend to change the form thereof, so that every part resists its equal proportion, and by which also the lower part is so reduced as to pass down within the truck frame and between the axles, to lower the center of gravity of the load without diminishing the capacity of the car, as described.”

And the specification concludes with a claim for a portion of the construction not important in this connection.

From the testimony it appears that cars constructed by the plaintiff, in accordance with the specification, while they weighed but 5,750 pounds each, carried 18,550 pounds of coal, making the weight of the load, in proportion to the weight of the car, as 3.3 to 1; that the thickness of the sheet iron used in the construction of the bodies was but

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three-thirty-seconds of an inch, and that the dimensions of the band around the top were one-fourth of an inch by two inches; and it is further shown, in illustration of the importance of the invention, that the plaintiff had constructed a model car, which, weighing but two and one-half tons, carried, nevertheless, nine and one-half tons of coal "in perfect safety and satisfactorily, from Cumberland to Baltimore." The proportion of the weight of the car, in this instance, to the weight of coal carried in it, was as one to four, nearly. It appears further, from the testimony generally, that the cars referred to were used in the transportation of coal from the mines near Cumberland to Baltimore.

It then appears that the defendants, "in view for a call for cars from the mining roads near Cumberland," in 1849-'50, required their draftsman, Cochrane, to get up a car that would suit their purposes; that he went to the Reading road, and, "finding nothing there, returned to Baltimore and went to the plaintiff's shops, where he saw a car nearly finished, which he examined and measured;" that it first occurred to him to make a square car, but that, as this would interfere with the wheels, he made an octagonal one.

Another witness proves that the iron used in the car thus built by the defendants was of the same thickness as that used by the plaintiff, to wit, three-thirty-seconds of an inch, while the band around the top was of the same thickness, to wit, one-fourth of an inch, and one and one-half inches in width.

It thus appears that a patent was granted in 1847 to Ross Winans for a car for carrying coal, whose merits may be summed up thus: that it carried more coal, in proportion to its own weight, than any car previously in use, and that the load, instead of distorting it, preserved it in shape, acting as a framing.

These eminent advantages, which increased the available power of the locomotive engine, looking to revenue on coal as a freight, from fifty to one hundred per cent., were to be attributed to the peculiar shape of the car body, consisting of a frustum of a cone, which permitted the use of iron as thin as has been described, lessening in proportion

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the weight of the car, or the weight the transportation of which by the locomotive gave no return in revenue; and it appears that, in view of obtaining the best results from his invention, the plaintiff, in 1849-1850, at the instance of the witness Pratt, perfected a model car for certain mining roads near Cumberland; that this model car was examined and measured by the defendants' draftsman, to aid him in getting up coal-cars for other mining companies, in 1849 and 1850; and subsequently cars of the same weight of material in the bodies, which differed from the plaintiff's in this only, that while the latter was cylindrical and conical, the others were octagonal and pyramidal, were built by the defendants, to the number of twenty-four.

Believing that the cars thus built by the defendants were built in palpable violation of his patent, the plaintiff brought the present suit.

It will be seen, by examining the record, that the main question before the jury was whether the cars so built by the defendants were substantially the same in principle and mode of operation with the car described and claimed by the plaintiff in his specification, and experts were examined on both sides on this point.

On the part of the defendants, it was contended that the cars of the defendants were octagonal in shape, while the plaintiff's were cylindrical.

On the part of the plaintiff, it was insisted that this was immaterial, provided the octagonal car obtained the same useful results, through the operation of the same principles in its construction; and it was suggested that, if the original construction of the body in right lines saved the infringement, an hundred-sided polygon would be without the patent; and also that, in point of fact, even the conical car was oftener a polygon than a true curve, owing to the character of the material from which it was built; and that if, by accident, it came from the shops a true theoretical cone, a day or two's use made a polygon of it; and that the immediate tendency of the load of coal, when put into an octagon car, was to bulge out its size and convert it into a conical one; all of which was urged for the purpose of

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showing that the question was necessarily a question as to whether the change of form was colorable or substantial,—a question of fact which it belonged to the jury to determine.

It is not necessary, in this statement, and in view of the questions arising on this appeal, to go into evidence in regard to the merely colorable difference of construction in detail. All the witnesses on both sides proved that the advantages which Winans proposed to obtain were substantially obtained in the defendants' cars, the plaintiff's witnesses swearing to the fact directly, and the defendants' witnesses admitting it on cross-examination; and the only testimony quoted now is that of the defendants' own and leading witness:

"That the advantage of a reduced bottom of the car was obtained, whether the car was conical or octagonal; that the strengthening of the bottom, due to the adoption of the conical form, was the same when the octagonal form was adopted or the circular; that the circular form was the best to resist the pressure, as, for instance, in a steam-boiler, and an octagonal one better than the square form; that the octagonal car was not better than the conical car; that for practical purposes one was as good as the other; that a polygon of many sides would be equivalent to a circle; that the octagon car, practically, was as good as the conical one; and that, substantially, witness saw no difference between the two."

The testimony must, indeed, be all one way, where the plaintiff is willing to rest his case on the defendants' own showing.

In the view of the plaintiff below, there were two questions: the first for the court, being the construction of the patent; the second for the jury, being the substantial or only colorable difference between the cars in principle and mode of operation.

The plaintiff prayed the Circuit Court (his honor, the late Judge GLENN, sitting alone) accordingly.

In framing the prayer for the court's construction of the specification, the language of the specification was adopted

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in describing the object of the invention ; and the court were asked to say to the jury, " that what they had to look at was not simply whether, in form and circumstances, which may be more or less immaterial, that which had been done by the defendants varied from the specification of the plaintiff's patent, but to see whether, in substance and effect, the defendants, having the same object in view as that set forth in the plaintiff's specification, had, since the date thereof, constructed cars which, substantially, on the same principle and on the same mode of operation, accomplished the same result." And to give more certainty to the prayer, the plaintiff added the instruction as prayed for by him, " that to entitle the plaintiff to a verdict, it was not necessary that the body of the defendants' cars should be conical, in the exact definition of the term, provided the jury should believe that the form adopted by the defendants accomplished the same result, substantially, with that in view of the plaintiff, and upon substantially the same principle and in the same mode of operation."

The language of the first part of the prayer here quoted was taken *verbatim*, nearly, from the charge of Sir N. C. TINDALL to the jury in the case of Walton *v.* Potter & Horsfall, Webster's Patent Cases, 587.

This was a case where the plaintiff's patent was for the substitution of sheets of India-rubber for leather for the insertion of the teeth, in the manufacture of cards for carding wool ; and the infringement lay in the use of cloth saturated with a solution of India-rubber for the same purpose ; and the court, after determining the construction of the specification, gave substantially the same instruction that the plaintiff prayed for here. It is in this case that C. J. TINDALL says : " That if a man has, by dint of his own genius and discovery, after a patent has been obtained, been able to give the public, without reference to the former one, or borrowing from the former one, a new and superior mode of arriving at the same end, there can be no objection to his taking out a patent for that purpose. But he has no right whatever to take, if I may so say, a leaf out of his neighbor's book," &c.

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It would be hard, indeed, to find a case where the court's decision, applied to the facts in this cause, more completely negatived the right set up by the defendants to build the cars which they did build; for here the taking of the leaf out of the book is not left to inference, but day and date are given for the act.

To the same point is the case of *Huddart v. Grimshaw*, also cited in the court below. Webster's Patent Cases, 95 [1 Am. & Eng. 128].

Here a patent had been obtained for making rope, a part of the process being the passage of the strands, while being twisted, through a tube; and it appeared that they had formerly passed through a hole in a plate. If the tube and the plate were the same substantially, the difference being colorably only, then the patent was void, otherwise it was good; and the question was left to the jury, who found for the plaintiff.

To the same point is the case of *Russell v. Cowley & Dixon*, Webster's Patent Cases, 463 [2 Am. & Eng. 9].

This was the case of a patent for welding iron tubes, by drawing them, at a welding heat, through a conical hole. The infringement was the passing them between rollers; and the question of colorable or substantial difference was referred to the jury.

So in the case of *Morgan v. Seaward*, Webster's Patent Cases, 170 [2 Am. & Eng. 262], which was upon *Gallaway's* patent for paddle-wheels of steam vessels, and where the question of infringement having arisen, the court, Alderson, B., told the jury "that the question would be simply whether the defendant's machine was only colorably different; that is, whether it differed merely in the substitution of mechanical equivalents for the contrivances which were resorted to by the patentee." And after referring to points of construction, the court continues: "Therefore the two machines were alike in principle. One man was the first inventor of the principle, and the other has adopted it; and though he may have carried it into effect by substituting one mechanical equivalent for another, still you (the jury) are to look to the substance, and not the mere

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form; and if it is in substance an infringement, you ought to find so."

So, too, in the case of *Crossley v. Beverly*, growing out of Clegg's patent for a gas meter, and referred to by Alderson, B., in the case of *Jupe v. Pratt et al.*, Webster's Patent Cases, 144 [2 Am. & Eng. 464], as follows: "There never was a more instructive case than that. I remember very well the argument put by the lord chief baron, who led on that case, and succeeded. There never were two things to the eye more different than the plaintiff's invention and what the defendant had done in contravention of his patent-right. The plaintiff's invention was different in form, different in construction; it agreed with it only in one thing, and that was by moving in the water. A certain point was made to open either before or after, so as to shut up another, and the gas was made to pass through this opening; passing through it, it was made to revolve it. The scientific men, all of them, said: 'The moment a practical scientific man has got that principle in his head, he can multiply, without end, the forms in which that principle can be made to operate.'

As in the case under discussion, the moment a practical scientific man is furnished with the idea of giving to the car a shape which will, by dispensing with the framing ordinarily used, enable him to make it lighter, in proportion to its load, than it has ever been made before, he can multiply, without end, the forms in which this principle can be made to operate. He can make the car a polygon of an hundred sides, of twenty sides, or of eight sides. He can vary the angle of the cone or pyramid, through which the coal is discharged, *ad infinitum*. He can make the opening at the bottom larger or smaller, to please his fancy. He can avail himself or not of the advantage of lowering the car in position, so as to lower the centre of gravity. Still, the question must always be, whether, whatever the shape he adopts, he is not availing himself of the principle first suggested by the patentee,—a question which, in a court of law, is at all times a question not for the court, but for the jury, after the former shall have given to the

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specification that construction which is to govern the latter in determining whether the infringement complained of falls, substantially, in principle and mode of operation, within the plaintiff's patent.

The authorities here cited, and which were relied on in the court below, are held to sustain the prayer of the plaintiff: that, having pronounced upon the construction of the specification, the question of infringement should be left to the jury.

The court below thought differently, however, and, rejecting the prayers of both plaintiff and defendants, instructed the jury: "That while the patent is good for what is described therein, a conical body, in whole or in part, supported in any of the modes indicated for a mode of sustaining a conical body on a carriage or truck, and drawing the same, and for those principles which are due alone to conical vehicles, and not to rectilinear bodies, and it being admitted that the defendants' car was entirely rectilinear, that there was no infringement of the plaintiff's patent." See Record, pp. 16, 17.

Upon this instruction nothing was left for the jury but to render a verdict for the defendant. The court had not only settled the construction, but the infringement also.

The present appeal is from this decision of the late district judge.

The points of the plaintiff in error are—

1. That the court below erred in the construction which it gave to the specification, should it be held that this construction limited the plaintiff to the strictly conical form.

And upon this point the authority relied on is the patent itself.

2. That the court below erred, even supposing that its construction of the specification was correct, in excluding the inquiry whether the cars of the defendants were not substantially the same in principle and mode of operation with those of the plaintiff, admitting that these last were rectilinear in their sections, and not curvilinear.

And upon this point the authorities relied on are Walton *v.* Potter, Webster's Patent Cases, 587 [3 Am. & Eng. 162];

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Huddart *v.* Grimshaw, Id. 95 [1 Am. & Eng. 128]; Jupe *v.* Pratt, citing Crossley *v.* Beverly, Id., 144 [2 Am. & Eng. 464]; Morgan *v.* Seaward, Id., 170 [2 Am. & Eng. 262]; Russell *v.* Cowley, Id., 463 [2 Am. & Eng. 9]; Phillips on Patents, 125-27.

Infringement. Curtis on Patents, 263-268, citing Wyeth *v.* Stone, 1 Story, 273; Odiorne *v.* Winkley, 2 Gall. 51; Gray *v.* James, Peters C. C. R. 394; Bovill *v.* Moore, Dav. Pat. Cases, 361 [1 Am. & Eng. 231].

3. That the court below erred in taking the question of fact from the jury.

Upon which point the authorities already cited are relied on.

Defendant's Points.

The defendant in error submits that the court below was right in refusing the prayer on the other side, and giving the instruction which it did.

1. As to the rejected prayer of the plaintiff.

This prayer asserted the essence of the invention to consist in the conical form adopted by the patentee, and rightly so asserted, but the conclusion thence drawn was a *non sequitur*. It was that any other form was a violation. Had the patent claimed the application of a principle operating through the form of a cone, and more or less through other forms, and claimed the principle or mode of operation through whatever shape permitted it, there would have been some ground for the deduction. But the claim is confined to a single form, and only through and by that form to the principles which it embodies; and if, out of many forms embodying more or less perfectly the same mode of operation, the plaintiff in error has made his choice of the best, he is confined to that choice and the rejection which it involves of all other forms less felicitous. It may be admitted, without hesitation, that the substitution of mechanical or chemical equivalents, as they are called, will not affect the rights of a patentee; but the cases in which this principle holds are where the *modus operandi* embraces more than a single way to reach the desired end. Where the invention consists of a principle

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embodied in a single form, the form is the principle and the principle the form, and there can be no violation of the principle without the use of the form. *Davis v. Palmer*, 2 Brock. 309.

2. As to the court's instruction.

The construction of the patent was exclusively for the judge. He construed it correctly as embracing only a curvilinear form. It necessarily followed, that, as the infringements relied on consisted only in the construction of rectilinear forms, there was no evidence to go to the jury of any violation of the patent, and it was proper in him so to instruct them. *Greenleaf v. Birth*, 9 Peters, 292.

Mr. Justice CURTIS delivered the opinion of the court.

This is a writ of error to the Circuit Court of the United States for the District of Maryland. The plaintiff in error brought his action in that court for an infringement of the exclusive right to make, use, and sell "an improvement in cars for the transportation of coal," &c., granted to him by letters patent, bearing date on the 26th day of June, 1847; and the judgment of that court being for the defendants, he has brought the record here by this writ of error.

It appears by the bill of exceptions that the letters patent declared on were duly issued, and that their validity was not questioned; but the defendants denied that they had infringed upon the exclusive right of the plaintiff.

On such a trial two questions arise. The first is, what is the thing patented? The second, has that thing been constructed, used, or sold by the defendants?

The first is a question of law, to be determined by the court, construing the letters patent, and the description of the invention and specification of claim annexed to them. The second is a question of fact, to be submitted to a jury.

In this case, it is alleged the court construed the specification of claim erroneously, and thereby withdrew from the jury questions which it was their province to decide. This renders it necessary to examine the letters patent and the schedule annexed to them, to see whether their construction by the Circuit Court was correct.

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In this, as in most patent cases founded on alleged improvements in machines, in order to determine what is the thing patented, it is necessary to inquire—

1. What is the structure or device described by the patentee as embodying his invention?

2. What mode of operation is introduced and employed by this structure or device?

3. What result is attained, by means of this mode of operation?

4. Does the specification or claim cover the described mode of operation by which the result is attained?

Without going into unnecessary details, or referring to drawings, it may be stated that the structure described by this patent is the body of a burden railroad-car, made of sheet iron, the upper part being cylindrical, and the lower part in the form of a frustum of a cone, the under edge of which has a flange secured upon it, to which flange a movable bottom is attached. This bottom is made movable, in order to discharge the load through the aperture left by removing it.

To understand the mode of operation introduced and employed by means of this form of the car body, it is only necessary to state, what appears on the face of the specification, and was testified to by experts at the trial as correct, that, by reason of the circular form of the car body, the pressure of the load outwards was equal in every direction, and thus the load supported itself, in a great degree; that by making the lower part conical, this principle of action operated throughout the car, with the exception of the small space to which the movable bottom was attached; that, being conical, the lower part of the car could be carried down below the truck, between the wheels, thus lowering the centre of gravity of the load; that the pressure outwards upon all parts of the circle being equal, the tensile strength of the iron was used to a much greater degree than in a car of a square form; and finally, that this form of the lower part of the car facilitated the complete discharge of the load through the aperture, when the bottom was removed.

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It thus appears, that, by means of this change of form, the patentee has introduced a mode of operation not before employed in burden cars; that is to say, nearly equal pressure in all directions by the entire load, save that small part which rests on the movable bottom; the effects of which are, that the load, in a great degree, supports itself, and the tensile strength of the iron is used, while at the same time, by reason of the same form, the centre of gravity of the load is depressed, and its discharge facilitated.

The practical result attained by this mode of operation is correctly described by the patentee; for the uncontradicted evidence at the trial showed that he had not exaggerated the practical advantage of his invention. The specification states:

"The transportation of coal, and all other heavy articles in lumps, has been attended with great injury to the cars, requiring the bodies to be constructed with great strength, to resist the outward pressure on the sides, as well as the vertical pressure on the bottom, due not only to the weight of the mass, but the mobility of the lumps among each other tending to 'pack,' as it is technically termed. Experience has shown that cars on the old mode of construction cannot be made to carry a load greater than their own weight; but by my improvement I am enabled to make cars of greater durability than those heretofore made, which will transport double their own weight of coal," &c.

Having thus ascertained what is the structure described, the mode of operation it embodies, and the practical result attained, the next inquiry is, does the specification of claim cover this mode of operation, by which this result is effected?

It was upon this question the case turned at the trial in the Circuit Court.

The testimony showed that the defendants had made cars similar to the plaintiff's, except that the form was octagonal instead of circular. There was evidence tending to prove that, considered in reference to the practical uses of such a car, the octagonal car was substantially the same as the circular. Amongst other witnesses upon this point

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was James Millholland, who was called by the defendants. He testified :

"That the advantage of a reduced bottom of the car was obtained, whether the car was conical or octagonal ; that the strengthening of the bottom, due to the adoption of a conical form, was the same when the octagonal form was adopted or the circular ; that the circular form was the best to resist the pressure, as, for instance, in a steam-boiler, and an octagonal one better than the square form ; that the octagonal car was not better than the conical car ; that for practical purposes one was as good as another ; that a polygon of many sides would be equivalent to a circle ; that the octagon car, practically, was as good as the conical one ; and that, substantially, the witness saw no difference between the two."

The district judge who presided at the trial ruled—

"That while the patent is good for what [is] described therein, a conical body, in whole or in part, supported in any of the modes indicated for a mode of sustaining a conical body on a carriage or truck, and drawing the same, and to those principles which were due alone to conical vehicles, and not to rectilinear bodies, and it being admitted that the defendants' car was entirely rectilinear, that there was no infringement of the plaintiff's patent."

The substance of this ruling was, that the claim was limited to the particular geometrical form mentioned in the specification ; and as the defendants had not made cars in that particular form, there could be no infringement, even if the cars made by the defendants attained the same result, by employing what was in fact the same mode of operation, as that described by the patentee. We think this ruling was erroneous.

Under our law a patent cannot be granted merely for a change of form. The act of February 21, 1793, sec. 2, so declared in express terms ; and though this declaratory law was not re-enacted in the Patent Act of 1836, it is a principle which necessarily makes part of every system of law granting patents for new inventions. Merely to change the form of a machine is the work of a constructor, not of an

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inventor. Such a change cannot be deemed an invention. Nor does the plaintiff's patent rest upon such a change. To change the form of an existing machine, and by means of such a change to introduce and employ other mechanical principles or natural powers, or, as it is termed, a new mode of operation, and thus attain a new and useful result, is the subject of a patent. Such is the basis on which the plaintiff's patent rests.

Its substance is a new mode of operation, by means of which a new result is obtained.

It is this new mode of operation which gives it the character of an invention, and entitles the inventor to a patent; and this new mode of operation is, in view of the Patent Law, the thing entitled to protection. The patentee may, and should, so frame his specification of claim as to cover this new mode of operation which he has invented; and the only question in this case is whether he has done so, or whether he has restricted his claim to one particular geometrical form.

There being evidence in the case tending to show that other forms do in fact embody the plaintiff's mode of operation, and by means of it produce the same new and useful result, the question is whether the patentee has limited his claim to one out of the several forms which thus embody his invention.

Now, while it is undoubtedly true that the patentee may so restrict his claim as to cover less than what he invented, or may limit it to one particular form of machine, excluding all other forms, though they also embody his invention, yet such an interpretation should not be put upon his claim if it can fairly be construed otherwise; and this for two reasons:

1st. Because the reasonable presumption is, that, having a just right to cover and protect his whole invention, he intended to do so. *Haworth v. Hardcastle*, Web. Patent Cases, 484 [2 Am. & Eng. 19].

2d. Because specifications are to be construed liberally, in accordance with the design of the Constitution and the Patent Laws of the United States, to promote the progress

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of the useful arts, and allow inventors to retain to their own use, not anything which is matter of common right, but what they themselves have created. *Grant v. Raymond*, 6 Peters, 218 [4 Am. & Eng. 245]; *Ames v. Howard*, 1 Sumner, 482, 485; *Blanchard v. Sprague*, 3 Id., 535, 539; *Davoll v. Brown*, 1 Wood. & Min., 53, 57; *Parker v. Haworth*, 4 McLean, 372; *Le Roy v. Tatham*, 14 How., 181 [5 Am. & Eng. 313], and opinion of Parke Baron, there quoted; *Nelson v. Harford*, Web. Patent Cases, 341 [3 Am. & Eng. 231]; *Russell v. Cowley*, Id., 470 [2 Am. & Eng. 9]; *Corning v. Burden* (decided at the present term), 15 How. 252 [p. 69 *ante*].

The claim of the plaintiff is in the following words:

"What I claim as my invention, and desire to secure by letters patent, is making the body of a car for the transportation of coal, &c., in the form of a frustum of a cone, substantially as herein described, whereby the force exerted by the weight of the load presses equally in all directions, and does not tend to change the form thereof, so that every part resists its equal proportion, and by which, also, the lower part is so reduced as to pass down within the truck-frame and between the axles, to lower the center of gravity of the load, without diminishing the capacity of the car, as described.

"I also claim extending the body of the car below the connecting pieces of the truck-frame and the line of draught, by passing the connecting-bars of the truck-frame and the draught-bar through the body of the car, substantially as described."

It is generally true, when a patentee describes a machine, and then claims it as described, that he is understood to intend to claim, and does by law actually cover, not only the precise forms he has described, but all other forms which embody his invention; it being a familiar rule, that to copy the principle or mode of operation described is an infringement, although such copy should be totally unlike the original in form or proportions.

Why should not this rule be applied to this case?

It is not sufficient to distinguish this case to say that

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here the invention consists in a change of form, and the patentee has claimed one form only.

Patentable improvements in machinery are almost always made by changing some one or more forms of one or more parts, and thereby introducing some mechanical principle or mode of action not previously existing in the machine, and so securing a new or improved result. And in the numerous cases in which it has been held that to copy the patentee's mode of operation was an infringement, the infringer had got forms and proportions not described, and not in terms claimed. If it were not so, no question of infringement could arise. If the machine complained of were a copy, in form, of the machine described in the specification, of course it would be at once seen to be an infringement. It could be nothing else. It is only ingenious diversities of form and proportion, presenting the appearance of something unlike the thing patented, which give rise to questions; and the property of inventors would be valueless, if it were enough for the defendant to say, your improvement consisted in a change of form; you describe and claim but one form; I have not taken that, and so have not infringed.

The answer is, my improvement did not consist in a change of form, but in the new employment of principles or powers, in a new mode of operation, embodied in a form by means of which a new or better result is produced; it was this which constituted my invention; this you have copied, changing only the form. And that answer is justly applicable to this patent.

Undoubtedly there may be cases in which the letters patent do include only the particular form described and claimed. *Davis v. Palmer*, 2 Brock. 309, seems to have been one of those cases. But they are in entire accordance with what is above stated.

The reason why such a patent covers only one geometrical form, is not that the patentee has described and claimed that form only; it is because that form only is capable of embodying his invention; and, consequently, if the form is not copied, the invention is not used.

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Where form and substance are inseparable, it is enough to look at the form only. Where they are separable; where the whole substance of the invention may be copied in a different form, it is the duty of courts and juries to look through the form for the substance of the invention—for that which entitled the inventor to his patent, and which the patent was designed to secure. Where that is found, there is an infringement; and it is not a defense, that it is embodied in a form not described and in terms claimed by the patentee.

Patentees sometimes add to their claims an express declaration, to the effect that the claim extends to the thing patented, however its form or proportions may be varied. But this is unnecessary. The law so interprets the claim without the addition of these words. The exclusive right to the thing patented is not secured, if the public are at liberty to make substantial copies of it, varying its form or proportions. And, therefore, the patentee, having described his invention, and shown its principles, and claimed it in that form which most perfectly embodies it, is, in contemplation of law, deemed to claim every form in which his invention may be copied, unless he manifests an intention to disclaim some of those forms.

Indeed, it is difficult to perceive how any other rule could be applied practicably to cases like this. How is a question of infringement of this patent to be tried? It may safely be assumed, that neither the patentee nor any other constructor has made, or will make, a car exactly circular. In practice, deviations from a true circle will always occur. How near to a circle, then, must a car be in order to infringe? May it be slightly elliptical, or otherwise depart from a true circle? And if so, how far?

In our judgment, the only answer that can be given to these questions, is that it must be so near to a true circle as substantially to embody the patentee's mode of operation, and thereby attain the same kind of result as was reached by his invention. It is not necessary that the defendants' cars should employ the plaintiff's invention to as good advantage as he employed it, or that the result should be

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precisely the same in degree. It must be the same in kind, and effected by the employment of his mode of operation in substance. Whether, in point of fact, the defendants' cars did copy the plaintiff's invention, in the sense above explained, is a question for the jury, and the court below erred in not leaving that question to them upon the evidence in the case, which tended to prove the affirmative.

The judgment of the court below must be reversed.

Mr. Chief Justice TANEY, Mr. Justice CATRON, Mr. Justice DANIEL, and Mr. Justice CAMPBELL dissented.

Mr. Justice CAMPBELL.

I dissent from the opinion of the court in this case.

The plaintiff claims to have designed and constructed a car for the transportation of coal on railroads, which shall carry the heaviest load, in proportion to its own weight.

His design consists in the adoption of the "conical form" "for the body of the car," "whereby the weight of the load presses equally in all directions;" does not "tend to change the form of the car;" permits it "to extend down within the truck," lowering "the centre of gravity of the load," and by its reduced size at the bottom adding to its strength and durability. He claims as his invention, and it is the whole of the change which he has made in the manufacture of cars, "the making of the body of the car in the form of the frustum of a cone."

It is agreed that a circle contains a greater area than any figure of the same perimeter; that the conical form is best suited to resist pressure from within, and that the reduced size at the bottom of the car is favorable to its strength. The introduction of the cars of the plaintiff upon the railroad, for the transportation of coal, was attended by a great increase of the loads in proportion to the weight of the car. The merits of the design are frankly conceded. Nevertheless, it is notorious that there does exist a very great variety of vessels in common domestic use "of a conical form," or "of the form of the frustum of a cone," for the reception and transportation of articles of prime necessity and con-

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stant demand, such as water, coal, food, clothing, &c. It is also true that the properties of the circle, and of circular forms alluded to in the patent of the plaintiff, are understood and appreciated, and have been applied in every department of mechanic art. One cannot doubt that a requisition from the transportation companies for cars of a diminished weight and an increased capacity, upon the machinists and engineers connected with the business, would have been answered promptly by a suggestion of a change in the form of the car. The merit of the plaintiff seems to consist in the perfection of his design, and his clear statement of the scientific principle it contains.

There arises in my mind a strong, if not insuperable objection to the admission of the claim in the patent for "the conical form," or "the form of the frustum of a cone," as an invention; or that any machinist or engineer can appropriate by patent a form whose properties are universally understood, and which is in very common use in consequence of those properties for purposes strictly analogous. The authority of adjudged cases seems to me strongly opposed to the claim. *Hotchkiss v. Greenwood*, 11 How., 249 [5 Am. & Eng. 240]; *Losh v. Hague*, Web. Pat. Cases, 207 [2 Am. & Eng., 501]; *Winans v. Providence Railroad Company*, 2 Story, 412; [*Howe v. Abbott*], 2 Id., 190; [*Steiner v. Heald*], 2 Car. & Kir., 1022; [*Dobbs v. Penn.*], 3 Exch. R.; 3 W. H. & Gord., 427.

Conceding, however, that the invention was patentable, and this seems to have been conceded by the Circuit Court, the inquiry is, what is the extent of the claim? The plaintiff professes to have made an improvement in the form of a vehicle which has been a long time in use, and exists in a variety of forms. He professes to have discovered the precise form most fitted for the objects in view. He describes this form as the matter of his invention, and the principle he develops applies to no other form. For this he claims his patent. We are authorized to conclude that his precise and definite specification and claim were designed to ascertain exactly the limits of his invention. *Davis v. Palmer*, 2 Brock, 298.

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The car of the defendants is of an octagonal form, with an octagonal pyramidal base. There was no contradiction in the evidence given at the trial in reference to its description, nor as to the substantial effects of its use and operation. In the size, thickness of the metal employed in its construction, weight and substantial and profitable results, the one car does not materially vary from the other. The difference consists in the form, and in that it is visible and palpable.

The Circuit Court acting upon these facts, of which there was no dispute, instructed the jury that an infringement of the plaintiff's patent had not taken place. I do not find the question before the court a compound question of law and fact. The facts were all ascertained, and upon no construction of those facts was the plaintiff, in my opinion, entitled to a judgment.

In theory the plaintiff's car is superior to all others. His car displays the qualities which his specification distinguishes. The equal pressure of the load in all directions; the tendency to preserve the form, notwithstanding the pressure of the load; the absence of the cross strain; the lowering of the centre of the gravity of the load, are advantages which it possesses in a superior degree to that of the defendants'. Yet the experts say that there is no appreciable difference in the substantial results afforded by the two.

The cause for this must be looked for in a source extrinsic to the mere form of the vehicles. Nor is it difficult to detect the cause for this identity in the results in such a source.

The coarse, heavy, cumbrous operations of coal transportation do not admit of the manufacture of cars upon nice mathematical formulas, nor can the loads be adjusted with much reference to exactness. There is a liability to violent percussions and extraordinary strains, which must be provided for by an excess in the weight and thickness of the material used. Then, unless the difference in the weight of the load is great, there will be no correspondent difference in the receipts of the transportation companies.

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The patentee, not exaggerating the theoretical superiority of the form of his car, overlooked those facts which reduced its practical value to the level of cars of a form widely variant from his own. The object of this suit is to repair that defect of observation. It is that this court shall extend, by construction, the scope and operation of his patent to embrace every form which, in practice, will yield a result substantially equal or approximate to his own.

In the instruction asked for by the plaintiff, "form and circumstances" are treated as more or less immaterial; but the verdict is claimed, if the defendants have constructed cars "which, substantially on the same principle and in the same mode of operation, accomplish the same result."

The principle stated in the patent applies only to circular forms.

The modes of operation in coal transportation have experienced no change from the skill of the plaintiff, except by the change from the rectilineal figure to the circular.

The defendant adheres to the rectilineal form. The result accomplished by the use of the two cars is the same—a more economical transportation of coal. This result it is that the plaintiff desires to appropriate; but this cannot be permitted. *Curtis on Patents*, secs. 4, 26, 27, 86, 87, 88; 2 Story, 408, 411.

In the case of *Aiken v. Bemis*, 3 Wood & M. 349, the learned judge said: "When a patentee chooses to cover with his patent the material of which a part of his machine is composed, he entirely endangers his right to prosecute when a different and inferior material is employed, and one which he himself, after repeated experiment, had rejected."

The plaintiff confines his claim to the use of the conical form, and excludes from his specification any allusion to any other. He must have done so advisedly. He might have been unwilling to expose the validity of his patent by the assertion of a right to any other. Can he abandon the ground of his patent, and ask now for the exclusive use of all cars which, by experiment, shall be found to yield the advantages which he anticipated for conical cars only?

The claim of to-day is that an octagonal car is an in-

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fringement of this patent. Will this be the limit to that claim? Who can tell the bounds within which the mechanical industry of the country may freely exert itself? What restraints does this patent impose in this branch of mechanical art?

To escape the incessant and intense competition which exists in every department of industry, it is not strange that persons should seek the cover of the Patent Act for any happy effort of contrivance or construction, nor that patentees should be very frequently employed to obstruct invention and to deter from legitimate operations of skill and ingenuity. This danger was foreseen, and provided for in the Patent Act. The patentee is obliged by law to describe his invention in such full, clear, and exact terms that, from the description, the invention may be constructed and used. Its principle and modes of operation must be explained; and the invention shall particularly "specify and point" out what he claims as his invention. Fullness, clearness, exactness, preciseness, and particularity in the description of the invention, its principle, and of the matter claimed to be invented, will alone fulfill the demands of Congress or the wants of the country. Nothing in the administration of this law will be more mischievous, more productive of oppressive and costly litigation, of exorbitant and unjust pretensions and vexatious demands, more injurious to labor, than a relaxation of these wise and salutary requisitions of the act of Congress. In my judgment, the principles of legal interpretation, as well as the public interest, require that this language of this statute shall have its full significance and import.

In this case the language of the patent is full, clear, and exact. The claim is particular and specific.

Neither the specification nor the claim, in my opinion embraces the workmanship of the defendants. I therefore respectfully dissent from the judgment of the court, which implies the contrary.

ORDER. This cause came on to be heard on the transcript of the record from the Circuit Court of the United

Notes and Citations.

States for the District of Maryland, and was argued by counsel; on consideration whereof, it is now here ordered and adjudged by this court, that the judgment of the said Circuit Court in this cause be, and the same is hereby, reversed with costs; and that this cause be, and the same is hereby, remanded to the said Circuit Court, with directions to award a *venire facias de novo*.

Notes:

1. Identity of infringing machine a question of fact for the jury.
Evans v. Eaton, 7 Wheat. 356 [4 Am. & Eng. 105].
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2. Form the essence of the particular invention.

Carver v. Hyde, 16 Pet. 513 [4 Am. & Eng. 367].
Washing Mch. Co. v. Tool Co., 20 Wall. 342.
Bridge Co. v. Phœnix Iron Co., 95 U. S. 274.
Werner v. King, 96 U. S. 218.
Clark v. Beecher Mfg. Co., 115 U. S. 79.

3. Mere change of form does not constitute patentable invention.

O'Reilly v. Morse, 15 How. 62 [5 Am. & Eng. 483].
Smith v. Nichols, 21 Wall. 112.
Eddy v. Dennis, 95 U. S. 560.

And is no defense to infringement.

Morey v. Lockwood, 8 Wall. 230.

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4. Claims, liberal construction.

Lake Shore and Mich. Rway Co. v. Nat. Car Brake Co.,
110 U. S. 229.
Yale Lock Mfg. Co. v. Sargent, 117 U. S. 586.

5. "Substantially as described." Effect on construction of claim.

Seymour v. Osborne, 11 Wall. 516.
Klein v. Russell, 19 Wall. 433.
Garratt v. Seibert, Bk. 21, L. ed. 956.
Hailes v. Van Wormer, 20 Wall. 353.
Corn Planter Patent, 23 Wall. 181.
Lake Shore and Mich. Rway Co. v. Nat. Car Brake Co.,
110, U. S. 229.
Brown v. Davis, 116 U. S. 287.
Matthews v. Iron-Clad Mfg. Co., 124 U. S. 347.
See also Seymour v. McCormick, 19 How. 96 (p.—post).

Patent in suit:

No. 5,175. Winans, R. June 26, 1847. Coal Car.

Cited:

IN SUPREME COURT OF UNITED STATES :

Sewall v. Jones, 1875. 91 U. S. 171; Bk. 23, L. ed. 275.
Eddy v. Dennis, 1877. 95 U. S. 560; Bk. 24, L. ed. 363.
Werner v. King, 1877. 96 U. S. 218; Bk. 24, L. ed. 613.

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IN CIRCUIT COURTS:

- Johnson *v.* Onion. 3 Hughes, 290.
American Pin Co. *v.* Oakville Co., Sept., 1854. 3 Blatch. 190.
Sargent *v.* Larned, May, 1855. 2 Curt. 340.
Whipple *v.* Middlesex Co., October, 1859. 4 Fish. 41.
Singer *v.* Walmsley, February, 1860. 1 Fish. 558.
Whitney *v.* Mowry, March, 1867. 2 Bond, 45; 3 Fish, 157.
Johnson *v.* McCullough, April, 1870; 4 Fish, 170.
Parham *v.* Am. Buttonhole, Overseaming, and Sewing Machine Co., April, 1871; 4 Fish, 168; 1 Leg. Gaz. Rep. 145.
Murphy *v.* Eastham, February, 1872; 1 Holmes, 113; 5 Fish, 306.
Milligan & Higgins Glue Co. *v.* Upton, May, 1874; 4 Cliff, 238; 1 Ban. & Ard. 497.
Pearl *v.* Ocean Mills, January, 1877; 2 Ban. & Ard. 469; 11 O. G. 2.
Union Paper Bag Machine Co. *v.* Pultz & Walkley Co. August, 1878; 15 Blatch. 160; 3 Ban. & Ard. 403; 15 O. G. 423.
Sawyer *v.* Miller, May, 1882; 4 Woods, 472; 12 Fed. Rep. 725.
Grier *v.* Castle, August, 1883; 17 Fed. Rep. 523; 24 O. G. 1176.
La Rue *v.* Western Electric Co., July, 1886; 28 Fed. Rep. 85.

IN DECISIONS OF COMMISSIONERS OF PATENTS:

- J. C. McLaren & C. B. Coventry, August, 1876. 10 O. G. 335.

IN STATE COURTS:

- Jackson *v.* Allen, March, 1876. 120 Mass. 64.
Burke *v.* Partridge, June, 1878. 58 N. H. Rep. 349; 10 Reporter 310.

IN TEXT BOOKS:

- 2 Abb. Pat. Law, 1886, pp., 40, 221, 225, 242, 245.
Merwin on Pats. Invt., 1883, p. 586.
Walker on Pats., 1883, pp., 30, 132, 133, 250.
Curtis on Pats., 4th ed. §§ 308, 310.

Dec., 1853.]

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Syllabus.

**ERASTUS CORNING, JOHN F. WINSLOW, AND
JAMES HORNER, APPELLANTS, *v.* THE TROY
IRON AND NAIL FACTORY.****15 How. 451-467. Dec., 1858.**

[Bk. 14, L. ed. 768; 1 Whit. 906.]

Appeal. Decree. Cross-bill. Second Appeal.

1. Where the respondent in a chancery suit in the Circuit Court appealed from that part of a favorable decree dismissing the bill upon one of two grounds of defense, in which the judge expressed the opinion that the other ground had not been established, *held* that he could not appeal from it as part of the decree (p. 162).
2. The law gives the party aggrieved an appeal from a final decree of an inferior court, but it does not give the party who is not aggrieved an appeal from a decree in his favor, because the judge has given no reasons, or insufficient ones, for a judgment admitted by the appellant to be correct (p. 162).
3. When a complainant has a decree in his favor, but not to the extent prayed for in the bill, and the respondent appeals, if the complainant desires a more favorable decree, he must enter a cross-bill (p. 163).
4. A second appeal lies only when the court below, in carrying out the mandate of this court, is alleged to have committed an error (p. 164).
5. The court below having not yet acted upon the mandate of this court, and entered a final decree in pursuance thereof, there is no final decree from which only an appeal can be taken (p. 164).

[Citations in the opinion of the Court:]

Troy Iron & Nail Factory v. Corning, 14 How. 194 [5 Am. & Eng. 375], p. 163.*Martin v. Hunter*, 1 Wheat. 355, p. 163.*Sibbald v. United States*, 12 Pet. 488, p. 163.*Himely v. Rose*, 5 Cranch. 313, p. 164.

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Canter *v.* Ocean Ins. Co., 1 Pet. 511, p. 164.
The Santa Maria, 10 Wheat. 431, p. 164.
Rice *v.* Wheatly, 9 Dana 272, p. 164.
The Palmyra, 10 Wheat. 502, p. 164.
Chace *v.* Vasquey, 11 Wheat. 429, p. 164.

THIS was an appeal from the Circuit Court of the United States for the Northern District of New York, sitting as a court of equity.

It was a branch of the case of the Troy Iron and Nail Factory *v.* Corning, *et al.*, reported in 14 Howard, 193 [5 Am. & Eng. 375]. The decree of the Circuit Court now appealed from is given at page 194 [5 Am. & Eng. 375]. The bill was originally filed by the Troy Iron and Nail Factory *v.* Corning *et al.*, and the Circuit Court dismissed the bill; but this court reversed that decree. By reference to 14 Howard, 194 [5 Am. & Eng. 375], it will be seen that the Circuit Court, in its decree, used the following language, viz.: "And it appearing to the said court that the said Henry Burden was the first and original inventor of the improvement on the spike-machine in the bill of complaint mentioned, and for which a patent was issued," &c.

Corning *et al.* being defendants in that suit, and succeeding in having the bill dismissed, did not appeal from the decree; but when the appeal was decided against them by this court, as reported in 14 Howard, they entered an appeal from that part of the decree which was as follows:

"And that so much or such parts of said decree as declares, orders, adjudges, and decrees as follows,—to wit: 'And it appearing to the said court that the said Henry Burden was the first and original inventor of the improvement on the spike machine in the bill of complaint mentioned, and for which a patent was issued to the said Henry Burden, bearing date the 2d of September, 1840, as in said bill of complaint set forth, and that said complainants have full and perfect title to the said patent for said improvements, by assignment from the said Henry Burden, as is stated and set forth in the said bill of complaint,'—may be reversed, and that the appellants may be restored to all things which they have lost by reason thereof."

Statement of the case.

This was the appeal now pending, which *Mr. Stevens* moved to dismiss, filing the following motion:

Supreme Court of the United States.

THE TROY IRON AND NAIL FACTORY, appellees,
v.
ERASTUS CORNING, JOHN F. WINSLOW, AND
JAMES HORNER, appellants. } In Equity.

State of New York, Northern District, city and county of Albany, ss.:

Samuel Stevens, of Albany, being duly sworn, says that he is of counsel and solicitor for the Troy Iron and Nail Factory, appellees in this court, and one of the solicitors and counsel in the Circuit Court of the United States for the Northern District of New York for the complainant.

That upon the hearing of the said cause in the Circuit Court of the United States for the Northern District of New York, upon pleadings and proofs, a decree therein was pronounced by the said court, which was duly entered by the clerk of the said court on the fourth (4th) day of September, 1850, which is in the words and figures following:

At a special term of the Circuit Court of the United States for the Northern District of New York, in equity, held at the city of Utica, in said district, on the fourth day of September, one thousand eight hundred and fifty—

Present: Hon. Samuel Nelson, Justice.

THE TROY IRON AND NAIL FACTORY
v.
ERASTUS CORNING, J. F. WINSLOW, AND JAMES HORNER. } In Equity.

This cause having been heretofore brought to a hearing upon the pleadings and proofs, and counsel for the respective parties having been heard, and due deliberation thereupon had, and it appearing to the said court that the said Henry Burden was the first and original inventor of the improvement on the spike-machine in the bill of complaint mentioned, and for which a patent was issued to the said Henry Burden, bearing date the 2d of September, 1840, as in said bill of complaint set forth, and that the said complainants have a full and perfect title to the said patents for

Statement of the case.

said improvements, by assignment from the said Henry Burden, as is stated and set forth in the said bill of complaint:

But it also further appearing to the court, on the pleadings and proofs, that the instrument in writing bearing date the 14th of October, 1845, stated and set forth in the said bill of complaint, and also in the answer of the said defendants thereto, entered into upon a settlement and compromise of certain conflicting claims between the said parties, and, among others, of mutual conflicting claims to the improvements in the spike-machine in said bill mentioned, and when said instrument was executed by the said Henry Burden of the one part and the said defendants of the other, the said Henry Burden at the time being the patentee and legal owner of the said improvements, and fully authorized to settle and adjust the said conflicting claims, did, in legal effect and by just construction, impart, and authorize, and convey a right to the defendants to use the said improvements in the manufacture of the hook-headed spike, without limitation as to the number of machines so by them to be used, or as to the place or district in which to be used:

Therefore it is ordered, adjudged, and decreed that the said bill of complaint be, and the same is hereby, dismissed, with costs to be taxed, and that the defendants have execution therefor.

That on the twenty-second day of October, 1850, the said complainant appealed from the said decree to this court, which appeal was duly allowed by Mr. Justice Nelson, one of the justices of said court; and that afterwards, to wit, in the December Term of this court, 1852, the said cause, upon the said appeal, and upon the record returned to this court by the said clerk of the said Circuit Court of the United States for said Northern District, came on to be heard, and was argued; whereupon this court pronounced a decree in the words and figures following, to wit:

United States of America, ss:

The President of the United States of America to the Honorable the Judges of the Circuit Court of the United

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States for the Northern District of New York, Greeting: Whereas, lately, in the Circuit Court of the United States for the Northern District of New York, before you, or some of you, in a cause between the Troy Iron and Nail Factory, complainants, and Erastus Corning, John F. Winslow, and James Horner, defendants, in chancery, the decree of the said Circuit Court was in the following words, to wit:

Therefore it is ordered, adjudged, and decreed that the said bill of complaint be, and the same is hereby, dismissed, with costs to be taxed, and that the defendants have execution therefor, as by the inspection of the transcript of the record of the said Circuit Court, which was brought into the Supreme Court of the United States by virtue of an appeal, agreeably to an act of Congress in such case made and provided, fully and at large appear.

And whereas, in the present term of December, in the year of our Lord one thousand eight hundred and fifty-two, the said cause came on to be heard before the said Supreme Court, on the said transcript of the record, and was argued by counsel; on consideration whereof, it is now here, ordered, adjudged, and decreed by this court that the decree of the said Circuit Court in the cause be, and the same is hereby, reversed with costs, and that the said complainants recover against the said defendants three hundred and sixty dollars and forty-two cents, for their costs herein expended, and have execution therefor.

And it is further ordered that this cause be, and the same is hereby, remanded to the said Circuit Court, with instructions to enjoin the defendants perpetually from using the improved machinery with the bending lever for making hook and brad headed spike, patented to Henry Burden the 2d of September, 1840, and assigned to the complainants, as set forth in complainants' bill, and to enter a decree in favor of the complainants for the use and profits thereof, upon an account to be stated by a master, under the direction of the said Circuit Court, as is prayed for by the complainants, and for such further proceedings to be had therein, in conformity to the opinion of this court, as to law and justice may appertain. January 18 .

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You therefore are hereby commanded that such execution and further proceedings be had in said cause, in conformity to the opinion and decree of this court, as according to right and justice and the laws of the United States ought to be had, the said appeal notwithstanding.

Witness, the Hon. ROGER B. TANEY, Chief Justice of said Supreme Court, the first Monday of December, in the year of our Lord one thousand eight hundred and fifty-two.

[L. S.]

And deponent further says, that afterwards, and on the 28th day of June, 1853, the said decree of this court was, by the said Circuit Court for said Northern District New York, made the decree of said Circuit Court, which last-mentioned decree is in the words and figures following, to wit:

At a term of the Circuit Court of the United States for the Northern District of New York, held at the court-house in the village of Canandaigua, on the 28th day of June, 1853—

Present: Hons. Samuel Nelson and Nathan K. Hall, Judges.

THE TROY IRON AND NAIL FACTORY }
v. } In Equity.
ERASTUS CORNING, JAMES HORNER, AND J. F. WINSLOW. }

The above named, the Troy Iron and Nail Factory, the complainants, in the above-entitled suit, having duly appealed to the Supreme Court of the United States from that part of the decree made in this suit which dismissed the bill of complaint herein with cost to be taxed, and the said Supreme Court of the United States having duly heard the said appeal at the December Term, 1852, upon the transcript of the record, and having reversed the said decree of the Circuit Court of the United States for the Northern District of New York, with costs, and having ordered, adjudged, and decreed that the said complainants recover against the said defendants three hundred and sixty dollars

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and forty-two cents for their cost in said Supreme Court, and that they have execution therefor: the said Supreme Court having remanded the said cause to the said Circuit Court, with instructions to enjoin the defendants perpetually from using the improved machinery with the bending lever for making hook or brad headed spikes, patented to Henry Burden the 2d of September, 1840, and assigned or transferred to the complainants, as set forth in complainants' bill, and to enter a decree in favor of the complainants for the use and profits thereof, upon an account to be stated by a master under the direction of the said Circuit Court, as is prayed for by the said complainants in their bill of complaint, and for such further proceedings to be had thereon, in conformity to the opinion and decree of the said Supreme Court, as to law and justice may appertain, which order, decree, and instructions appear to this court by the mandate of the said Supreme Court:

Now, therefore, on filing the said mandate, and in pursuance thereof, and after hearing *Mr. Stevens*, for the said complainants, and *Messrs. Seymour and Seward*, for the defendants, it is ordered, adjudged, and decreed, and this court, by virtue of the power and authority therein vested, and in obedience to the said mandate, doth order, adjudge, and decree, that the instrument in writing, bearing date the 14th day of October, 1845, stated and set forth in the pleadings in this cause, executed by the said Henry Burden and the said defendants, did not, in legal effect or otherwise, or by just construction, license, impart, authorize, or convey a right to the said defendants to use the said improvements in the manufacture of the hook-headed spikes by the machinery mentioned in the said bill of complaint, or any rights secured to the said Henry Burden by the said letters patent, and assigned or transferred to the said complainants as aforesaid.

And it is further adjudged and decreed, that the said defendants have infringed and violated the said patent so granted to the said Henry Burden as aforesaid, by making and vending the said hook-headed spikes by the said ma-

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chinery patented to the said Burden on 2d of September as aforesaid.

And it is further adjudged and decreed, that the said defendants do account to the said complainants for the damages, or use and profits, in consequence of the said infringements by the said defendants.

And it is further adjudged and decreed, that an account of the damages, or use and profits, be taken and stated by Marcus T. Reynolds, Esq., counsellor at law, as master of this court *pro hac vice*, and that the defendants attend before the said master, from time to time, under the direction of the said master, and that the said complainants may examine the said defendants, under oath, as to the several matters pending on the said reference, and that the said defendants produce before the said master, upon oath, all such deeds, books, papers, and writings as the said master shall direct, in their custody or under their control, relating to said matters which shall be pending before said master.

And it is further ordered and decreed, that a perpetual injunction issue out of and under the seal of this court against the said defendants, commanding them, their attorneys, agents, and workmen, to desist and refrain from making, using, or vending any machine containing the new and useful improvement for which letters patent were granted to the said Henry Burden on the 2d day of September, 1840, and from in any manner infringing or violating any of the rights or privileges granted or secured by said patent.

And it is further ordered, that the said complainants recover of the said defendants the damages, or use and profits, which shall be reported by the said master, and that upon the confirmation of his report or decree, be entered against the defendants therefor, and also for the costs of the complainants in this suit in this court, and that the said complainants have execution therefor and for the costs in the said Supreme Court.

And it is further ordered and decreed, that such other proceedings be had herein, in conformity to the opinion of the said Supreme Court, as to law and justice may appear-

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tain; and that the parties and master may apply, upon due notice to this court, upon the foot of this decree, for such other and further orders, instructions, and directions as may be necessary.

(A copy.)

A. A. BOYCE, *Clerk.*

And deponent further says, that on the 5th day of October, 1853, the solicitor for the defendants served upon Henry Burden, the president of the said complainants, a petition of appeal and a citation thereon, in the words and figures following:

To the Supreme Court of the United States of America:

The petition of Erastus Corning, John F. Winslow, and James Horner respectfully represents that a decree was lately made in the Circuit Court of the United States for the Northern District of New York, in equity, bearing date the 4th day of September, 1850, in a certain cause pending in said court, wherein the Troy Iron and Nail Factory were complainants and your petitioners were defendants, certain parts of which decree, as hereinafter specified, are, as your petitioners are advised, erroneous, and ought to be reversed.

And your petitioners further show, that the matters in dispute in said cause, exclusive of costs, exceed the sum of two thousand dollars.

Whereupon your petitioners pray that the said decree, together with the pleadings, depositions, and all other proceedings in said cause, may be sent to the said Supreme Court of the United States, and filed therein on the first Monday of December next, and that so much or such parts of said decree as declares, orders, adjudges, and decrees as follows—to wit: “And it appearing to the said court that the said Henry Burden was the first and original inventor of the improvement on the spike-machine in the bill of complaint mentioned, and for which a patent was issued to the said Henry Burden, bearing date the 2d September, 1840, as in said bill of complaint set forth, and that the said complainants have a full and perfect title to the said

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patent for said improvements, by assignment from the said Henry Burden, as is stated and set forth in the said bill of complaint"—may be reversed, and that the appellants may be restored to all things which they have lost by reason thereof.

DANIEL L. SEYMOUR,
Solicitor for the Appellants.

Dated Troy, September 8, 1853.

By the Hon. SAMUEL NELSON, one of the judges of the Circuit Court of the United States for the Northern District of New York.

Whereas, Erastus Corning, John F. Winslow, and James Horner lately filed in the Circuit Court of the United States for the Northern District of New York a petition of appeal directed to the Supreme Court of the United States of America, stating that a decree was lately made in the Circuit Court of the United States for the Northern District of New York, in equity, bearing date the 4th day of September, 1850, in a certain cause therein pending, wherein the Troy Iron and Nail Factory were complainants, and Erastus Corning, John F. Winslow, and James Horner were defendants, certain parts of which said decree are alleged to be erroneous and ought to be reversed; and further stating that the matters in dispute in said cause, exclusive of costs, exceeded in value the sum of two thousand dollars:

And whereas the said Erastus Corning, John F. Winslow, and James Horner, by their said petition, prayed that the said decree, together with the pleadings, depositions, and all other proceedings in said cause, may be sent to the said Supreme Court of the United States and filed therein on the first Monday of December next, and that the said parts of said decree may be reversed and the said appellants restored to all things which they have lost by reason thereof:

You are therefore hereby cited to appear before the said Supreme Court of the United States, at the city of Washington, on the first Monday of December next, to do and

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receive what may appertain to justice to be done in the premises.

Given under my hand, in the Circuit Court of the United States for the Northern District of New York, the 23d day of September, 1853.

S. NELSON.

And deponent further says, that he has been informed and believes that the record and proceedings in said appeal have been duly filed with the clerk of this court.

SAMUEL STEVENS.

Sworn before me this 16th day of November, 1853.

LEONARD KIP,

*Master and Examiner in the Circuit Court
of the Northern District of New York.*

Supreme Court of the United States.

THE TROY IRON AND NAIL FACTORY }
v.
ERASTUS CORNING ET AL. } In Equity.

SIR: Be pleased to take notice that upon the pleadings, papers, and proceedings in this cause in the Circuit Court of the United States for the Northern District of New York, and upon the record and proceedings returned to this court by the clerk of said Circuit Court on the appeal by the complainant to this court, and upon the affidavit hereto annexed, and copy of which is herewith served upon you, this honorable court will be moved, at the next term thereof, to be held at the Capitol, at the city of Washington, District of Columbia, on the first Monday of December next, at the opening of the court on that day, or as soon thereafter as counsel can be heard, for a rule or order dismissing the appeal of the defendants to this court, or for such other and further rule or order as may be agreeable to equity.

Albany, November 9, 1853. SAMUEL STEVENS.

Solicitor for Complainants.

To D. L. SEYMOUR, *Defendants' Attorney.*

Argument of counsel.

Upon this motion to dismiss the appeal, the cause was taken up.

It was argued by *Mr. Stevens* and *Mr. Johnson*, for the motion, and by *Mr. Seymour* and *Mr. Seward* against it.

Mr. Stevens, in support of the motion to dismiss, made the following points:

The only ordering part of the decree—the only judgment pronounced by the court below—was a decree dismissing the complainants' bill, with costs. From that decree the complainants duly appealed to this court, which decree was reversed and a decree ordered according to the prayer of the bill, which was duly entered in the Circuit Court before the defendants made the present appeal.

Preceding the ordering part of the decree, certain recitals were made by the Circuit Court, showing the reasons or grounds upon which that court pronounced the ordering part of the decree.

It is from the recitals preceding the decree in this cause, and not from the decree, that this appeal has been made.

The complainants, the respondents to this appeal, now move to quash or dismiss it, upon the following grounds:

First. This court has appellate jurisdiction only upon appeals from final judgments or decrees of the Circuit Court. 1 United States Statutes at Large, p. 84, sec. 22.

The ordering part of a decree is the only final decree or judgment of the court.

The preliminary recitals preceding the ordering part of the decree are no part of the decree or judgment of the court.

Such recitals are simply the reasons or grounds of the decree.

Those reasons or grounds of the decree cannot be appealed from. A party might as well claim to appeal from the opinion of the court, as from the synopsis of the opinion, which constitutes the recitals upon which the ordering part of the decree is based.

The only decree in this case was a decree dismissing the

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complainants' bill, with costs. Seaton's Forms of Decrees, pp. 8, 9.

From the whole of that decree the complainant appealed, the whole of which decree was reversed by this court at its last term, and the Circuit Court was ordered by the mandate of this court to enter a decree in said cause, according to the prayer of complainants' bill, and such decree was entered by the said Circuit Court, at the June Term thereof, 1853, in compliance with said mandate of this court.

The defendants cannot have that decree of this court reviewed or altered by an attempt to appeal from the reasons upon which the Circuit Court pronounced its decree.

Second. But if the recitals preceding the ordering part of the decree of the Circuit Court could be appealed from, the defendants should have brought a cross-appeal, which would be heard by this court with, and at the same time of, the original appeal, and one decree only would be pronounced by the appellate court. 1 Barbour's Ch. Prac. 397; Uguart's Prac. in House of Lords on Appeals and Writs of Error, 37-40; Palmer's Prac. in House of Lords on Appeals and Writs of Error, p. 33; Hawley *v.* James, 16 Wend. 85-274; Mapes *v.* Coffin, 5 Paige, 296.

A party cannot have a decree of the Circuit Court reviewed by this court two, three, or more times, by appealing from different parts of the decree at different times. Every ground which he might have urged on the hearing of the first appeal will be deemed to have been made by him, or, if not made, to have been abandoned. The Santa Maria, 10 Wheat. 443-444; Ex-parte Sibbald, 12 Peters, 488.

This attempt at an appeal by the defendants from the reasons of the decree is analogous to an application to this court for a rehearing upon the original appeal, which is never granted after the cause has been remitted to the Circuit Court. McArthur *v.* Browder, 4 Wheat. 488.

Third. The decree of the Circuit Court entered in this cause on the 4th of September, 1850, was reversed by this court at its December Term, 1852, and the proceedings were remitted to the Circuit Court, and that Court, at its

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June Term, 1853, entered a new decree, in pursuance of, and in compliance with, the mandate of this court. Therefore, on the 5th of October, 1853, the date of defendants' present appeal, there was no such decree of the Circuit Court as that entered by said court of the 4th of September, 1850, from parts of which the defendants claim to appeal.

Fourth. The only decree existing in the Circuit Court in this cause since its June Term, 1853, is an interlocutory and not a final decree, and cannot be appealed from. *Kane v. Whittick*, 8 Wend. 219; [*Brown v. Swann*], 9 Peters, 1; [*Young v. Smith*], 15 Id. 287.

Appeals from the Circuit Court to this court can only be from final decrees or judgments. 1 United States Statutes at Large, p. 84, sec. 22.

Mr. Seymour and *Mr. Seward* opposed the motion to dismiss the appeal, upon the following grounds:

I. The decree of the Circuit Court, made on the 4th of September, 1850, disposed of the whole cause on the merits, and was, therefore, a final decree, and an appeal may be taken from it. See Act of Congress March 3, 1803. By this act an appeal to the Supreme Court is given "from all final judgments or decrees rendered, or to be rendered, in any Circuit Court." See, also, Act 24th of February, 1789; *The San Pedro*, 2 Wheat. 132; see Act of 1819, 3 United States Statutes at Large, p. 481, chap. 19; see Patent Act of 1836, sec. 17, 5 United States Statutes at Large, p. 124; Laws United States Courts, 117-119. This last act enlarges the right of appeal in patent cases. It gives the court a discretion to allow the appeal in cases other than those already provided for by law. The appeals authorized by this law are only allowed from a final decree in United States courts. *Patterson v. Gaines et al.*, 6 How. 585.

A decree dismissing a bill is a final decree. 2 Daniell's Chancery Pleading and Practice, Perkins' ed., pp. 1199, 1200; *McCollum v. Eager*, 2 How. 64.

The decree, therefore, of the Circuit Court in this cause may be appealed from under the acts of Congress aforesaid.

II. This decree consists of three parts: the introductory

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part; the part declaring the rights of the parties, as this does of the complainant; and another part, ordering or directing a thing or things to be done. See 2 Daniell's Chancery Pleading and Practice, Perkins' ed., pp. 1210-1214, as to the forms of decrees. The rules of this court do not allow of recital. See Rule 85; so, too, Statute 3 and 4 William IV, cited in 2 Daniell's Practice, 1212; Seaton's Decrees, 159. It declares the right of complainants to the patent-right, and the right of the defendants to use the patented machinery under the agreement of October 14, 1845.

This decree proceeds and adjudges and determines two important matters of defense which had been distinctly set up in the pleadings, and upon which much testimony had been given, to wit:

First. "That the said Henry Burden was the first and original inventor of the improvement on the spike-machine in the bill of complaint mentioned, and for which a patent was issued to the said Henry Burden, bearing date the 2d day of September, 1840, as is in said bill of complaint set forth."

Second. "That the said complainants have a full and perfect title to the said patents for said improvements, by assignment from the said Henry Burden, as is stated and set forth in the said bill of complaint."

These portions of the decree are final decisions on the merits of the case, giving to the complainants the full and complete title to the machinery; a vital point, which, if decided for the defendants, decides the whole case for them, no matter what may be the decision as to the agreement of October 14, 1845.

An appeal will lie from the decision of the court upon either or both of these contested points. 3 Daniell's Chancery practice, 1606.

III. Even if the adjudication contained in the decree of the originality of the invention in question, and of the complainants' title to the patent, need not have been inserted in the decree, yet they were inserted by the Circuit Court, upon the special motion of the complainants, and

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against the opposition of the defendants, who should, therefore, not be prejudiced by it. See affidavits read on this motion by the defendants.

IV. The appeal by the complainants brought up only the questions decided to their prejudice. *Buckingham v. McLean*, 13 How. 150, 151.

The equity practice of the Supreme Court of the United States is regulated by the laws of the United States, the rules of the court, and, in the absence of any provision in them applicable to a given case, by the practice of the English High Court of Chancery. Rule 90, Supreme Court. *The State of Rhode Island v. The State of Massachusetts*, 14 Peters 210; *Bein v. Heath*, 12 How. 168; *Dorsey v. Packwood*, Id. 126.

By the practice, both of the American and English courts of chancery, this is a proper case for a cross-appeal to be brought by defendants. 1 *Turner and Venable's Chancery Practice*, 733, ed. 1835; 2 *Smith's Chancery Practice*, p. 31, ed. 1837; 3 *Daniell's Chancery Practice*, 1606, 1685, 1688; *Blackburn v. Jepson*, 2 Vesey & B. 359; *Hawley v. James*, 16 Wend. 61-85; *Mapes v. Coffin*, 5 Paige 296; *Clowes v. Dickinson*, 8 Cow. 330.

V. The present is the proper time to bring it.

1. The decree of the Circuit Court being final, the laws of March 3, 1803, and of 1819 and 1836, give an unrestricted and unqualified right of appeal to either party for five years.

2. Because an appeal now taken from the latter decree would bring up for review only the proceedings subsequent to the mandate. *The Santa Maria*, 10 Wheat. 31; *Ex parte Sibbald*, 12 Peters 488.

There is no rule of the Supreme Court adopting the rules of the House of Lords.

VI. The decision of this court, on the appeal of the complainants, affects only the part of the decree complained of by them, to wit, the construction of the agreement of October 14, 1845; and while the declaratory parts of the decree of the Circuit Court in favor of the complainants remain unreversed, the right to sustain their bill for a per-

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petual injunction, and to recover damages, followed as a consequence from the construction given by this court to the agreement of October 14, 1845.

VII. The defendants are entitled to an appeal at some time within five years from the decision of the Circuit Court against them, on the validity of the patent in question. Now, if the complainants' position is true, that nothing is appealed from but the order directing the bill to be dismissed, these defendants have not now, and never have had, an opportunity to appeal at all, because that decree was in their favor, and a party cannot appeal from a decree in his own favor.

It is a mere subtlety to say, that because the decree deciding the validity of the patent and the title of the complainants in their favor ordered no relief, but, on the contrary, for a different reason, directed their bill to be dismissed, that therefore the decision of the validity of the patent and the title of the complainants is mere recital, and not a substantial part of the decree, and proper subject of an appeal. The test is this: Are the validity of the patent and the title of the complainants now open to dispute by the defendants in the Circuit Court? Certainly they are not. But, according to the complainants, those points are not open to appeal; so that a decision on a vital point against the defendants is not the subject of appeal at all.

Again, if what the complainants allege is correct, that there is no decree now remaining in the court below but the decree which is entered on the mandate, and also, that on appeal from that decree so entered on the mandate the party aggrieved can review only the proceedings subsequent to that decree, then it results that the defendants can have no appeal at all from a decree in which the material issue upon the invention is found against them by the court below.

Again, in answer to this, it is said that, on the appeal brought by the complainants upon the issue as to a license found against them, the defendants were at liberty to fall back and contest the issue of the invention found against them; but in reply, we say, that by the rules of courts of equity, as well as by statute, it is optional to the defendants

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whether they will so fall back and contest the issue found against them on the hearing of the appeal of the complainants, or whether they will bring their own distinct appeal.

VIII. The respondents' motion should be denied.

Mr. Justice GRIER delivered the opinion of the court.

The Troy Iron and Nail Factory filed their bill in the court below, claiming to be assignees of a patent granted to Henry Burden for a "new and useful improvement in the machinery for manufacturing wrought nails or spikes." The bill charges that the appellants, Corning & Co., have infringed their patent, and prays for an injunction and an account of profits, &c. The answer of the respondents below took defense on two grounds: first, that Burden was not the first and original inventor of the machine patented; and secondly, that the respondents used their machine under a license from the patentee. The court below sustained the defense on the latter ground, and entered the following decree: "Therefore it is ordered, adjudged, and decreed that the said bill of complaint is hereby dismissed, with costs to be taxed, and that the defendant have execution therefor."

The case is now before us on a motion to dismiss the appeal. Looking at the case as exhibited to us by the record, it appears to be an appeal by respondents from a decree dismissing the complainants' bill with costs.

It often happens that a court may decree in favor of a complainant, but not to the extent prayed for in his bill, and he may have just cause of appeal on that account. But the prayer of the respondent's answer is that "he be hence dismissed, with his reasonable costs and charges, on this behalf most wrongfully sustained." And having such a decree on the present case, he cannot have a more favorable one.

It is true that the petition for the appeal in this case prays only "that so much of such parts of said decree as declares, orders, adjudges, and decrees as follows, to wit, 'and it appearing to the said court that the said Henry Burden was the first inventor of the improvement, &c.,'

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may be reversed, and that the appellants may be restored to all things which they have lost by reason thereof."

But the matter complained of forms no part of the decree of the court below.

It shows only that the judge, in reciting the inducement or reasons for entering a decree in favor of the respondents below, was of opinion that they were entitled to such decree, because they had succeeded in establishing one only of the two defenses alleged in their answer. It is the opinion of the court on a question of fact involved in the case, but not affecting the decree. If the decree be correct, the party in whose favor it is given has no right to complain; yet his appeal prays that it "may be reversed, and the appellants restored to all things which they have lost by reason thereof," and the record shows they have lost nothing.

If the decree be reversed, according to the prayer of the appellants, the court must necessarily enter a decree for the complainants below. This would probably not meet the views of the appellants. They have put themselves in the anomalous position either of asking for the affirmance of the decree from which they have appealed, or of requesting this court to reverse a decree in their favor, and send back the record to the court below, with directions to enter the very same decree, but to assign other reasons for it. The court were not bound to give any reasons for their decree. The law gives the party aggrieved an appeal from a final decree of an inferior court; but it does not give the party who is not aggrieved an appeal from a decree in his favor because the judge has given no reasons, or recited insufficient ones, for a judgment admitted by the appellant to be correct.

There is a part of the history of this case which does not appear on the record, but being known to the court, and assumed by counsel on both sides to make part of the case, it will be necessary to notice the case under that aspect.

The decree in favor of the appellants, which is now appealed from, has already been before this court on an appeal by the complainant below. The parties were then fully heard, the decree of the Circuit Court reversed, and the case

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remanded for further proceedings. It is reported in 14 How. 194 [5 Am. & Eng. 375]. It appears, therefore, that there is no such decree as that which is now complained of. The decree of the Circuit Court has been entirely annulled, reversed, and set aside by this court. Before that was done, the appellants had a full hearing on every point of defense set up in their answer. The court below had decided that the defendant had a good defense under his plea of license, but not under the plea that Burden was not the first inventor of the patented machine. This court has decided that the appellants' defense was insufficient on both pleas. The language of the court is, 14 How. 208 [5 Am. & Eng. 375], "That the defendants have failed to prove that Burden was not such first inventor; and, in our opinion, the evidence given by them on that point rather serves to establish the originality of the invention than to impair it. The appellants stand upon the patent as the first which was granted for the bending lever; and they may well do so, until other evidence than that in this record shall be given to disprove its originality."

It is plain, therefore, that under the guise of an appeal from the decree of the Circuit Court, this is an appeal in fact from the decision of this court; for there is no other decree existing in the case except the decree of this court. There must be an end of litigation some time. To allow a second appeal to a court of last resort, on the same questions which were open to dispute on the first, would lead to endless litigation. It is said by this court, in *Martin v. Hunter*, 1 Wheaton, 355, "a final judgment of the court is conclusive upon the rights which it decides, and no statute has provided any process by which this court can revise its judgment." See, also, *Sibbald v. United States*, 12 Pet. 488. It follows, therefore, that when a complainant has a decree in his favor, but not to the extent prayed for in his bill, and the respondent appeals, if the complainant desires a more favorable decree, he must enter a cross-appeal, that when the decree comes before the appellate court he may be heard. For when the decree is either affirmed or reversed by the appellate court, it be-

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comes the decree of that court, and cannot be the subject of another appeal. But in this case, where the decree of the court below dismissed the bill, no appeal by the respondent was necessary. He had a full opportunity to urge every defense set up in his answer. The printed arguments show that the defense, for want of originality in the patent, was relied upon as a ground for affirming the decree of the court below, and, as we have already shown, was distinctly passed upon and overruled by this court.

A second appeal lies only when the court below, in carrying out the mandate of this court, is alleged to have committed an error. But on an appeal from the mandate it is well settled that nothing is before the court but the proceedings subsequent to the mandate. Whatever was formerly before the court, and was disposed of by its decree, is considered as finally disposed of. See *Himely v. Rose*, 5 Cranch, 313; *Canter v. The Ocean Insurance Company*, 1 Peters, 511; *The Santa Maria*, 10 Wheat. 431; *Rice v. Wheately*, 9 Dana, 272.

Moreover, as it is admitted that the court below have not yet acted upon the mandate of this court, and entered a final decree in pursuance thereof, there is no final decree from which only an appeal can be taken. See *The Palmyra*, 10 Wheat. 502; *Chace v. Vasquez*, 11 Id. 429.

There are, therefore, three conclusive reasons for dismissing the present appeal: 1. The appellants have already been heard in this court on a former appeal. 2. There is no such decree as that from which the appeal purports to be taken. 3. There is no final decree in the case from which an appeal can be taken.

The appeal is therefore dismissed.

ORDER. This cause came on to be heard on the transcript of the record from the Circuit Court of the United States for the Northern District of New York, and was argued by counsel; on consideration whereof, it is now here ordered, adjudged, and decreed by this court that this cause be, and the same is hereby,

DISMISSED WITH COSTS.

Notes and Citations.

Patent in suit:

No. 1757. Burden, H. September 2, 1840. Spike Making Machine.

OTHER SUITS ON SAME PATENT:

Troy Iron and Nail Factory v. Corning. 1852. 14 How. 193; 1 Whit. 691 [5 Am. & Eng. 375].

Cited:

IN SUPREME COURT OF UNITED STATES:

Roberts v. Cooper, 1858. 20 How. 467; Bk. 15, L. ed. 969.
Tyler v. Magwire, 1873. 17 Wall. 258; Bk. 21, L. ed. 576.
Supervisors v. Kennicott, 1877. 94 U. S. 499; Bk. 24, L. ed. 260.

IN TEXT-BOOKS:

Walker on Pats., 1883, p. 447.

Syllabus.

WILLIAM LIVINGSTON AND EBENEZER N. CALEF, APPELLANTS, *v.* WILLIAM W. WOODWORTH, ADMINISTRATOR OF WILLIAM WOODWORTH, DECEASED, JAMES G. WILSON, ARTEMUS L. BROOKS, AND IGNATIUS TYLER, APPELLEES.

15 How. 546-559. December, 1853.

[Bk. 14, L. ed. 809; 1 Whit. 922.]

Waiver of objections. Misjoinder of plaintiffs. Decree by consent. Defendants operating under a patent. Mitigation of damages.

1. Where on a bill for an injunction to restrain a defendant for the use of a patented machine, the objection of misjoinder of the plaintiffs, the assignor and his assignee within a limited locality was first raised after the hearing and final decree, *held* that the objection came too late; *held*, further, that the objection had been waived by defendants having expressly consented to a decree upon the record (p. 180).
2. A decree by consent "that the complainants are entitled to the perpetual injunction and the account prayed for by the bill," does not bind the defendants not to object to the report of the master on an accounting for profits, and not to appeal from the order confirming it (p. 182).
3. Where punitive damages had been granted by a master in chancery on an account of profits for the use of an infringing machine and a decree awarded thereon, *held* that they were not warranted by the well-established rules of equity, and the decree was reversed (p. 183).
4. Where defendants were operating under a patent, *held* that they were not wanton infringers, neither subject to punitive damages, but were liable only to the extent of their actual gains and profits (p. 184).

Argument of counsel.

[Citations in the opinion of the court:]

Story's Eq. Plead. ch. 4, § 231, p. 180.

Raffity *v.* King, Law Journal vol. 6, p. 93, p. 181.

Morley *v.* Lord Hawke, 2 Young & Jervis 520, p. 181.

Small *v.* Atwood, 2 Young & Jervis 520, p. 181.

Aylwin *v.* Bray, 2 Young & Jervis 518, p. 181.

THIS was an appeal from the Circuit Court of the United States for the District of Massachusetts.

All the facts of the case are stated in the opinion of the court, to which the reader is referred.

It was argued by *Mr. Schley*, for the appellants, and by *George T. Curtis*, for the appellees.

Mr. Schley made the following points:

1. The account ought not to have been taken from the date of the patent. The title of the complainant Tyler was not complete until the 1st of July, 1848, nor the title of Brooks until the 10th of May, 1848. At the furthest, the account ought not to have been taken from a period prior to the latter day.

2. The account ought not to have been continued beyond the time of the filing of the bill. There are cases, undoubtedly, in which the account is continued to the date of the report; but this is not such a case.

3. It was clearly erroneous to allow interest from the day of filing the bill on the whole amount, as part of the amount accrued after that date.

4. Upon the case as it stood in court, actual "gains and profits," and nothing more, ought to have been charged against the defendants. If damages beyond actual gains and profits were asked, the complainants should have sought another forum. *Curtis on Patents*, sec. 348; *Hindmarch on Patents*, 361-365; *Crossley v. The Derby Gas-Light Company*, 3 Mylne & Craig, 428, 433 [2 Am. & Eng. 513]; *Bacon v. Spotswood*, 1 Beav. 387 [3 Am. & Eng. 28]; *Colborn v. Simms*, 2 Hare 560; 2 *Eden on Injunctions*, 251; *Phillips on Patents*, 457; *Webster on Patents*, 119, 168, 238; *Lee v. Alston*, 1 Ves. Jr. 82.

Argument of counsel.

5. The allowance of one dollar per thousand was not warranted by the evidence in the cause, even if in other respects the decree was right. The allowance was excessive, upon the merits, as disclosed in evidence.

The points made by *Mr. Curtis*, for the appellees, were the following:

I. The first point that will be submitted, on behalf of the appellees, will be, that this being a bill for an injunction and an account, and a decree having been entered by consent of parties, (Record, p. 68,) that the complainants were entitled to the injunction and account prayed for in the bill; an appeal does not lie from the final decree, which merely ascertains the items of the account which the appellants consented should be taken.

That an appeal cannot be taken from a decree entered by consent, counsel will cite 2 Daniell's Ch. Pr. 1179, 1180; Bradish *v.* Gee, Amb. 229; Harrison *v.* Rumsey, 2 Ves. 488; Atkinson *v.* Marks, 1 Cow. 693; Corning *v.* Cooper, 7 Paige, 587.

There is a case in Ohio which is otherwise, founded on the peculiar provisions of the statute allowing appeals. Brewer *v.* The State of Connecticut *et al.*, 9 Ohio, 189.

But there is nothing in the provisions of the Judiciary Act of 1789, or in the act of March 3, 1803, section 2, allowing and regulating appeals in equity, to prevent the application by this court of the rule, that when a decree has been taken by consent it cannot be disturbed by an appeal or a rehearing.

The object of the act of 1803 is stated in the case of The San Pedro, 2 Wheaton, 141, 142. The only question in this case is whether the consent decree, entered May Term, 1849, (p. 18,) does not render the final decree (pp. 51, 52) a decree by consent also. It will be contended that it does—

1. Because, by the first decree, the appellants consented that the appellees were entitled to the perpetual injunction, and "the account prayed for in the bill;" and all that remained to be done was to ascertain what account was prayed for in the bill.

2. Because, by the first decree, it was expressly declared

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that the parties consented to have the account commence at such a time as should be found by the master and be confirmed by the court—a stipulation as binding on both parties as if they had made the same point the subject of arbitration.

But if the appeal was rightly taken, counsel for the appellees will contend—

II. That the second decretal order to the master, by which he was directed to ascertain “the amount of profits which may have been, or with due diligence and prudence might have been, realized by the defendants for the work done by them” with the machine complained of, taken in connection with the principles laid down by the court in their opinion, (see appendix to this brief,) stated the true rule for this case.

1. It appears, by an account filed with the master at the first hearing, that the appellants had been using the machine complained of from July, 1845, to July, 1848, and had planed therewith 3,962,760 feet of boards during that time.

It also appears that they had received an average of two dollars per thousand feet for this work; and in their answer they state that this work was done at an average expense of one dollar and fifty cents per thousand feet, leaving fifty cents only as the net profit actually realized on a thousand feet. But they do not profess to do this with entire accuracy, but as an “approximate estimate.”

In this state of the facts, the master, assuming that he was to find only the actual net profits realized, heard evidence on the part of the complainants which tended to show that a thousand feet of boards could be planed for a less cost; and, also, evidence on the part of the respondents tending to show that it would cost as much as they had stated in their answer; but he held that the result of the whole evidence did not authorize the conclusion that the respondents had not truly stated the actual cost, and accordingly he reported one dollar and fifty cents as the cost per thousand, leaving an actual profit of fifty cents only.

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As it stood on the master's first report, therefore, there was evidence tending to show that, in charging one dollar and fifty cents per thousand as the cost of planing, the respondents had conducted the business with less skill and prudence than it might have been conducted. The master's conclusion was based wholly on the idea that the actual net profits furnished the rule, and that the evidence did not control the statement of the answer as to the amount of such actual profits.

An exception being taken and argued, it appeared to the court that here was a state of facts which required the application of a different rule, and the cause was recommitted to the master by the second decretal order, and the accompanying instructions.

The rule announced was, that the master was to report the profits which the respondents might have made with due diligence and prudence; and the principle adopted by the court was, that the respondents were to be charged as involuntary trustees, accountable, like mortgagees in possession and other similar trustees, for the profits which might have been received with due care and prudence.

To apply this rule, rendered it necessary to hear evidence on both sides, and to take the average given by all the testimony of what it would cost to plane one thousand feet. The result of the whole evidence given to the master at both hearings may be thus stated:

(The counsel then went into some long calculations respecting the cost of planing.)

2. There is no technical difficulty in a court of equity in adopting and applying such a rule as that directed by the second decretal order to the master.

Where the court has jurisdiction to give the principal relief sought, it will make a complete decree, and give compensation for the past injury,—as in bills for specific performance. *Newham v. May*, 13 Price. 749; *Nelson v. Bridges*, 2 Beavan, 239; *Phillips v. Thompson*, 1 Johns. Ch. R. 150; *Parkhurst v. Van Cortlandt*, Id. 273; *Pratt v. Law & Campbell*, 9 Cranch, 456; *Cathcart v. Robinson*, 5 Peters, 269; 2 Story's Eq. Jur., sec. 796. So, also, in in-

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junction bills for waste. *Jesus College v. Bloom*, 3 Atk. 262; *Garth v. Cotton*, Id. 751; *Lee v. Alston*, 1 Bro. Ch. R. 194.

The jurisdiction in equity conferred upon the Circuit Courts, in patent causes, by statute, contemplates full power to give the plaintiff as ample redress as he could have at law, except that the damages cannot be trebled. Patent Act of July 4, 1836, secs. 17, 14.

3. There being no technical difficulty in applying a rule that involves elements of computation and gives an approximate compensation to the party injured, the question is simply one of principle, viz., what rate of profits shall a party who has long infringed a patent be required to account for in equity?

The court below did not direct the master to find damages, nor did he go into that inquiry. He inquired, as he was directed to do, whether the profits actually made by the respondents were as large as they might have been with the exercise of due care and prudence.

a. Any other rule, in a case of this kind, would put the patentee entirely in the power of the trespasser, and enable the latter to fix the rate at which he should account for the use of the machine.

b. The rule applied in this case by the court below was correct in principle. It was to hold the party accountable, as an involuntary trustee, for what the patentee might have realized by the same exercise of the right, the evidence showing that he had made the cost of the work excessive. The principle is well settled, that a court of inquiry sometimes forces the character of a trustee upon an intruder or wrong-doer, or one who is in possession under color of right, and who takes rents or profits which belong to another, or might have taken them.

The particular class of trustees referred to in the opinion of the court below are mortgagees. The following authorities show the application of the rule: *Anonymous*, 1 Vernon, 45; *Chapman v. Tanner*, Id. 267; *Coppring v. Cooke*, Id. 270; *Jenkins v. Eldredge*, 3 Story, 325-331; *Dexter v. Arnold*, 2 Sumner, 108-130.

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c. This is a case of first impression. All the authorities and precedents which declare that the infringer is to account in equity for the "profits" made by the unlawful use of the invention, contemplate a case where the actual profits are all that could have been made, or else that question has not been raised. This is a case where the evidence shows that the respondents so conducted their business that the actual profits were less than half what might have been realized by the patentee from the same business.

III. The objection that the account ought not to have been taken from the date of the (reissued) patent, viz., July 8, 1845, but should have commenced May 20, 1848 (the date of Wilson's deed of confirmation to Brooks, one of the complainants), is now too late. By consent of parties, the account was to commence at such time as should be found by the master and confirmed by the court (p. 18). The master found the facts, and the court directed the account to commence at the date of the reissued patent. No appeal lies from the decree thus consented to.

Besides, the bill was brought in the name of the original owner of the reissued patent, Woodworth's administrator, Wilson, his assignee, and Brooks and Tyler, the sub-assignees; and, by consent, the respondents admitted the right to the injunction and account prayed for.

IV. If the appeal can open this question, it is submitted that the decree was right.

The first patent to Woodworth, the inventor, was granted December 27, 1828. November 16, 1842, Woodworth's administrator obtained from the Commissioner, under the statute of 1836, sec. 18, an extension for seven years from December 27, 1842. December 7, 1842, the administrator granted to Brooks an exclusive territorial right for the residue of the extended term, viz., to December 27, 1849.

January 11, 1844, the administrator conveyed all his interest to Wilson.

July 8, 1845, the administrator surrendered the renewed patent granted to him by the Commissioner, and obtained a reissue under the Act of 1836, sec. 13, on account of a defective specification.

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July 20, 1847, Brooks assigned to Tyler one-half of his territorial right.

May 20, 1848, Wilson, by his deed, confirmed Brooks' title, and Brooks, by his deed dated July 1, 1848, confirmed his previous grant to Tyler.

The bill was filed July 10, 1848, in the name of the administrator, Wilson, Brooks, and Tyler, to obtain an account for infringements commenced at least at the date of the surrender and reissue, and steadily continued to the time of filing the bill. The court directed the account to commence with the date of the reissued patent.

Three positions will be maintained:

1. That the complainants, who sought this redress, jointly represented the whole legal and equitable title, and were jointly entitled to the relief from the date of the reissued patent. Even if it were true that a reissue does not give a legal title to the assignee whose grant was taken before the reissue (which is not admitted), it still leaves his equitable title, as against strangers and trespassers, as valid as it was before.

2. An assignee of the whole existing interest under a patent has the same legal title in the reissued patent, granted under the Act of 1836, sec. 13, for a defective specification, which he had before the reissue, without any confirmatory grant from the patentee. *Woodworth v. Stone*, 3 Story, 749; *Woodworth v. Hall*, 1 Wood. & Min. 248.

The two cases of *Wilson v. Rousseau*, 4 How. 646 [4 Am. & Eng. 436], and *Bloomer v. McQuewan*, 14 How. 539 [5 Am. & Eng. 434], deny to previous assignees a legal title under an extension, and recognize only their right to continue the use of the specific machines purchased.

They admit, therefore, that the extension is a grant of a new estate to the patentees. A reissue under the thirteenth section of the statute is not a new grant in any sense, but merely the correction of errors or omissions in the specifications; and the statute merely restricts the right of recovery to infringements committed after the correction has been made.

3. If the complainants, Brooks and Tyler, needed any

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confirmation of their title, they had it before the bill was filed, and relates it back to the earliest period when the statute will permit recovery for infringements under a re-issued patent.

V. The objection that the account ought not to have been taken beyond the time of filing the bill, covers the work done in the course of fifteen days. The bill was filed July 10, 1848, and the account covers the work done to July 25. It appears that the injunction was served on the last-mentioned day. Record, pp. 13, 14. The amount planed in the month of July was 73,821 feet. So that, at the rate of 4,200 feet per day, the respondents must have worked their machine more than seventeen days in the month of July; that is to say, they did more than seven days' work after the bill was filed. Record, p. 19. It does not appear precisely why the master took the account to the 25th of July, but probably it was because the respondents rendered it to that time, they not having stopped before. After the bill was filed, they had notice of the complainants rights, and on their own admission they were infringers, and bound to account. To allow the present objection to prevail, would be to say, that, in a suit for an injunction and account, the right being admitted, the respondent may go on working after the bill is filed, and the complainant must file another bill to recover for what is done after the first bill is filed, and before the account is taken. There is no technical necessity for this, and it would be most onerous, as leading to endless litigation.

VI. The objection as to the interest allowed on the items which accrued after the filing of the bill, assumes that work was done by the respondents after the bill was filed. By their own admission they had no right to use the machine. The master brought the account down to the time when the respondents rendered it, July 25; and if a part of the items thus covered accrued after the respondents were notified, those items must, in contemplation of law, be treated as if they had already accrued when the bill was filed, in taking a continuing account.

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Mr. Justice DANIEL delivered the opinion of the court.

The appellees, on the 24th of July, 1848, obtained from the court above mentioned an injunction to restrain the appellants from using or vending one or more planing machines, substantially the same in construction and mode of operation as the machine which had been patented to William Woodworth, deceased.

In their bill they allege the originality of the invention of the patentee, the extension of the patent after his death for the space of seven years beyond its original limitation to the appellee William W. Woodworth, as administrator of the inventor, and the grant by said administrator to the appellee Brooks of the exclusive right to construct and use the invention within certain specified limits for the entire period of that extension. The bill further alleges a second extension by act of Congress of the patent to the said administrator for the term of seven years from the 27th day of December, 1849; but states that in consequence of doubts entertained as to the correctness of the specification, and of the fact of said letters patent having been found to be inoperative, they were duly surrendered, and new letters patent, bearing date on the 8th day of July, 1845, were issued to the appellee William W. Woodworth, and his assigns, for the residue of the term of twenty-eight years from the 27th of December, 1828. That subsequently to this last renewal the appellee, William W. Woodworth had granted to the appellee Wilson, and to his assigns, all the right and title acquired by him by the issue of the last letters patent with the amended specification. That the appellee Brooks, by his deed of the 20th of July, 1847, had granted and assigned to the appellee Tyler one-half of Brooks' right in the patent to Woodworth for the term ending on the 27th of December, 1849, to be used within the town of Lowell, and not elsewhere. That the appellee Wilson, by deed of the 20th of May, 1848, assigned and confirmed to Brooks and his assigns the exclusive right of constructing and using twenty planing-machines, according to the letters patent with the amended specification, and gave authority to Brooks, in Wilson's name, to execute all such deeds of confirmation to the

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assignees of any rights and privileges within the county of Middlesex as he should deem fit, and that in virtue of this power and authority, he (Brooks) did, by his deed of July 1, 1848, grant and confirm to the appellee Tyler, in the name and behalf of the said Wilson, as well as in his own name, all the rights and privileges described in the deed from Brooks to Tyler of the 20th of July, 1847. The bill further alleges that the appellants were then using, and for some time had used, within the city of Lowell, one of the machines, substantially the same in construction and mode of operation as the planing-machine in the said last-mentioned letters patent described, the exclusive right to make, use, and vend which is by law vested in the appellees. The bill also charges, that theretofore two actions at law had been instituted in that court, the one against a certain James Gould, and the other against Rodolphus and James, Edwards and Cyrus Smith, for violation of the exclusive privileges granted to the plaintiffs in those actions under patent last aforesaid, by using a machine substantially the same with the said planing-machine invented by the said William Woodworth, and that, upon issues made up in both these actions, the jury found that the defendants had infringed the patent, and subjected them to the payment of damages. It avers the use, as before stated, by the appellants of their machine, to be an infringement of the Woodworth patent, and a violation of the exclusive rights and privileges of the appellees; and concludes with a prayer that the appellants may be decreed to account for and pay over to the appellees all gains and profits which have accrued from using their said machines since the expiration of the said original patent; that they may be restrained by injunction from using or vending any one or more of said machines; that the machine or machines in the possession or under the control of the appellants may be destroyed or delivered over to the appellees, who ask also for general relief.

The appellants, by their answer, state that during a part of the time which has elapsed between the autumn of 1841 and April 1, 1844, they have used in their mill at Lowell a single planing-machine, constructed according to a patent

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granted to James H. Hutchinson on the 16th of July, 1839, which machine, in some of its combinations, substantially resembles the machine specified in the patent granted to Woodworth in 1845, but is unlike any machine specified in the patent to Woodworth in 1828. They aver, also, that the planing business had been carried on as aforesaid, in virtue of the Hutchinson machine, at Lowell, with the full knowledge of the appellee Brooks, and without objection from him, until within a short time previously, and that they had no knowledge or belief of any infringement by them of the patent to Woodworth until after the decision in Gould's case, after which decision they were informed that the patent to Woodworth had been surrendered and reissued with a new specification, the validity of which reissued patent had not, within their knowledge or belief, been established, until the decision of the suit against the said Edwards and Smith. The answer denies the originality of Woodworth's claim, by averring that James, Joseph, Aaron, and Daniel Hill, and Leonard Gilson, in the district of Massachusetts, as early as 1827, and John Hale, of Bloomfield, in the State of New York, in the year 1828, had knowledge of, and had made and used, planing-machines essentially the same, and prior to the pretended invention of William Woodworth, deceased.

At the May Term of the court, 1849, this cause coming on to be heard upon the bill, the answers, replications, and exhibits, by the consent of the parties it was decreed by the court that the appellees (the complainants below) were entitled to the perpetual injunction and to the account prayed for by the bill, said account to commence at such time as shall be found by the master and be confirmed by the court. The decree proceeds, that the master, in taking said account, shall have power to require the parties to produce before him, on oath, all books and papers relating thereto, and to hear such oral evidence as either party may produce, and on the motion of either of the parties, to examine either of the other parties upon interrogatories; and all further directions are reserved until the coming in of the master's report.

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In pursuance of this decretal order, upon the examination of the parties on oath, and upon evidence produced *aliunde*, the master reported that the amount of gains and profits received by the defendants below upon 3,962,700 feet of plank, the number of feet planed by them, was at the rate of fifty cents per thousand feet, no exception being taken to the amount of the work stated to have been done by the said defendants, or to the gross amount at which the work was charged by them per thousand; but exception being taken to the report of the master, upon the ground that the rate of profit charged to the defendants below should have been one dollar instead of fifty cents per thousand, the court, by a further decretal order, recommitted the report to the master, with instructions to ascertain the amount of profits which may have been, or with due diligence and prudence might have been, realized by the defendants for the work done by them or their servants by the machines described in the complainants' bill, and that the account of profits should commence from the date of the letters patent issued with the amended specifications. In obedience to the decretal order last mentioned, the master made a second report, by which he charged the defendants for profits on the work done by their machine, at the rate of one dollar per thousand feet, instead of fifty cents, as in his former report, from the 8th day of July, 1845, the date of the re-issued patent. He says it is true that the rate of profit adopted by him is conjectural, "but that he does not think he has infused into the case any element too unfavorable to the defendants; that by the decision of the court they were trespassers and wrong-doers, in the legal sense of the words, and were consequently in a position which might make them liable to be mulcted in damages greater than the profits they have actually received, the rule being not what benefit they have received, but what injury the plaintiffs have sustained." To this second report of the master exceptions were filed by the appellees, (the plaintiffs below,) founded upon the departure of the master from the safe and just rule of actual profits, as prayed for by the bill, and the adoption of a rule of proceeding which was vague and con-

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jectural, and unsustained by the evidence in the cause. At the May Term, 1851, the Circuit Court decreed that this report of the master, except so far as interest is thereby disallowed, should be confirmed, and that the appellants should, within ten days, pay to the appellees the sum of \$3,962.96, with interest thereon from the day of filing the bill, with costs. It is this decree, founded upon the antecedent proceedings herein adverted to, that we are to review; and it may here be remarked, that the statement of those proceedings has been unavoidably protracted, from the necessity for considering two questions of a preliminary character raised in the argument, and which it is proper to dispose of before deciding upon and before reaching the merits of this cause.

1st. It has been insisted, on behalf of the appellants, that the appellee Tyler, claiming as assignee under Woodworth, Wilson and Brooks, and asserting a title complete in himself within a certain locality, could not regularly unite in his bill those persons whom he had shown had no title within the same locality, and who could not, therefore, be embraced in a decree in his favor,—a decree which, in its terms and effect must exclude every kind of interest in those co-plaintiffs within the same limits. It is true, as a rule of equity pleading, that none should be made parties, either as complainants or defendants who have no interest in the matters in controversy, or which can be affected by the decree of the court. *Vide Story's Eq. Plead.*, ch. 4, section 231. So, too, in section 232 of the same work it is said: "In cases where the want of interest applies, it is equally fatal when applicable to one of several plaintiffs as it is when applicable to one of several defendants. Indeed, the objection in the former case is fatal to the whole suit, whereas, in the latter case, it is fatal (if taken, in due time) only as against the defendant improperly joined." In the same work, section 544, it is said, that "In cases of misjoinder of plaintiffs the objection ought to be taken by demurrer; for if not so taken, and the court proceeds to a hearing on the merits it will be disregarded, at least if it does not materially affect the propriety of the decree."

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The language of Lord Langdale, in the case of *Raffity v. King*, as reported in the Law Journal, vol. 6, p. 93, is very clear upon this question, where he says: "As to the objection to John Raffity being made a plaintiff, I am not satisfied it would, under any circumstances, be considered of such importance as to deprive the other plaintiffs of the relief they are entitled to. There have been cases in which the court, with a view to special justice has overcome the difficulty occasioned by a misjoinder of plaintiffs." And in the case of *Morley v. Lord Hawke*, cited in [*Small v. Attwood*], 2 Young & Jervis 520, before Sir William Grant, the rule is thus stated as to the misjoinder of plaintiffs: "The defendant objected to any relief being granted in that state of the record; and without determining the effect of the objection, if brought forward earlier, I think it is now too late. If the objection had been stated in the answer, the plaintiffs might have obtained leave to amend their bill, and might have made John Raffity a defendant instead of a plaintiff, for which there is an authority in the case of *Aylwin v. Bray* (2 Young & Jervis 518, note); and in such a case as this where the objection is reserved to the last moment, I think it ought not to prevail."

In the case before us the objection of misjoinder of the plaintiffs nowhere appears upon the pleadings, nor, for aught that is disclosed, was it insisted upon even at the hearing. It is urged for the first time after the hearing and after a final decree; and to allow this objection at so late a stage of the proceedings would be a surprise upon the appellees, and might operate the most serious mischiefs. In this case, and at this time, the allowance of such an objection would be peculiarly improper; for here the objection cannot be viewed as having been merely waived by reasonable and ordinary implication, but the defendants have expressly consented to a decree between the parties as they were then arrayed upon the record. As to this objection, therefore, we think it comes too late to be of any avail, and should not affect the cognizance of the court, either as to the parties or the subject-matter of the controversy.

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2d. On the part of the appellees (the complainants in the Circuit Court), it has been insisted that the decretal order, made in this cause by consent, covered and ratified in advance all the subsequent proceedings on the part of the court, rendering those proceedings, inclusive of the final decree, a matter of consent, which the appellants could have no right to retract, and from which, therefore, they could not legally appeal. In order to try the accuracy of this argument, and of the conclusions sought to be deduced therefrom, it is proper to examine the order which is alleged in support of them. The words of that order are as follows:

"This cause came on, &c., and by consent of parties it is declared by the court,"—what? "That the complainants are entitled to the perpetual injunction and the account prayed for by the bill." It seems to us incomprehensible, that by this consent of the defendant below, he had consented to anything precise and unchangeable beyond the perpetual injunction; much more so that he had thereby bound himself to acquiescence in any shape, or to any extent of demand which might be made against him under the guise of an account. Indeed, the complainants below, and the Circuit Court itself, have shown, by their own interpretation of this decretal order, that they did not understand it to mean—as, in truth, by no just acceptation it could mean—anything fixed, definite, and immutable; for the complainants below excepted to the report of the master, and the court recommitted that report, with a view to its alteration. Nor can we regard the reference to the master as in the nature of an arbitration; for if so deemed, the award of that officer must have been binding, unless it could be assailed for fraud, misbehavior, or gross mistake of fact. In truth, the account consented to was the account prayed for by the bill, and in the plain words of the bill, viz., "that the defendants may be decreed to account for and pay over all such gains and profits as have accrued to them from using the said machine since the expiration of said original letters patent." This language is particularly clear and significant: such gain and profits, and such only, as have actually accrued to the defendants; and we are un-

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able to perceive how, by such an assent, the appellants (the defendants below) could have been concluded against exceptions to anything and everything which might have been evolved by that report, however illegal or oppressive.

Considering next the decretal order for the recommitment of the first report, the second report made in obedience to that order, and final decree founded upon the second report, we are constrained to regard them all as alike irreconcilable with the prayer of the bill, with the just import of the consent decree, and with those principles which control the action of courts of equity. In the instructions to the master, it will be seen that he is ordered "to ascertain and report the amount of profits which may have been, or with due diligence and prudence might have been, realized by the defendants for the work done by them or by their servants by means of the machines described in the complainants' bill, computing the same upon the principles set forth in the opinion of the court, and that the account of such profits commence from the date of the letters patent issued with the amended specification." The master, in this report, made in pursuance of the instructions just adverted to, admits that the account is not constructed upon the basis of actual gains and profits acquired by the defendants by the use of the inhibited machine, but upon the theory of awarding damages to the complainants for an infringement of their monopoly. He admits, too, that the rate of profits assumed by him was conjectural, and not governed by the evidence; but he attempts to vindicate the rule he had acted upon by the declaration that he was not aware that he had "infused into the case any element too unfavorable to the defendants; that by the decision of the court they were trespassers and wrong-doers, in the legal sense of these words, and consequently in a position to be mulcted in damages greater than the profits they have actually received, the rule being not what benefit they have received, but what injury the plaintiffs have sustained." To what rule the master has reference in thus stating the grounds on which his calculations have been based, we do not know. We are aware of no rule which converts a court

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of equity into an instrument for the punishment of simple torts; but upon this principle of chastisement the master admits that he has been led, in contravention of his original view of the testimony, and upon conjecture as to the reality of the facts, and not upon facts themselves, to double the amount which he had stated to be a compensation to the plaintiffs below, and the compensation prayed for by them, and the Circuit Court has, by its decree, pushed this principle to the extreme, by adding to this amount the penalty of interest thereon from the time of filing the bill to the date of the final decree.

We think that the second report of the master, and the final decree of the Circuit Court, are warranted neither by the prayer of the bill, by the justice of this case, nor by the well-established rules of equity jurisprudence.

If the appellees (the plaintiffs below) had sustained an injury to their legal rights, the courts of law were open to them for redress, and in those courts they might, according to a practice which, however doubtful in point of essential right, is now too inveterate to be called in question, have claimed not compensation merely, but vengeance, for such injury as they could show that they had sustained. But before a tribunal which refuses to listen even to any save those whose acts and motives are perfectly fair and liberal, they cannot be permitted to contravene the highest and most benignant principle of the being and constitution of that tribunal.

There they will be allowed to claim that which, *ex aequo et bono*, is theirs, and nothing beyond this.

In the present case it would be peculiarly harsh and oppressive, were it consistent with equity practice, to visit upon the appellants any consequences in the nature of a penalty. It is clearly shown that the appellants, in working their machine, were proceeding under an authority equal to that (the same, indeed) which bestowed on Woodworth and his assignees the right to their monopoly. The appellants were using a machine patented by the United States to Hutchinson, and might well have supposed that the right derived to them from such a source was regular and legiti-

Order.

mate. They were, then, in no correct sense, wanton infringers upon the rights of Woodworth, or of those claiming under him. So soon as the originality and priority of the Woodworth patent was ascertained by law, the appellants consented to be perpetually enjoined from the use of their machine (the Hutchinson machine), and to account for whatever gains and profits they had received from its use. Under these circumstances, were the infliction of damages, by way of penalty, ever consistent with the practice of courts of equity, there can be perceived in this case no ground whatever for the exercise of such a power.

On the contrary, those circumstances exhibit in a clearer light the propriety of restricting the account, in accordance with the prayer of the bill, to the actual gains and profits of the appellants (the defendants below) during the time their machine was in operation, and during no other period. We are therefore of the opinion that the decree of the Circuit Court is erroneous, and should be, as it is hereby, reversed with costs, and that this cause be remanded to the Circuit Court, with instructions to proceed therein in conformity with the principles ruled in this opinion.

ORDER. This cause came on to be heard on the transcript of the record from the Circuit Court of the United States for the District of Massachusetts, and was argued by counsel; on consideration whereof, it is now here ordered, adjudged, and decreed by this court that the decree of the said Circuit Court in this cause be, and the same is hereby, reversed with costs; and that this cause be, and the same is hereby, remanded to the said Circuit Court, for further proceedings to be had therein, in conformity to the opinion of this court.

Notes:**1. Joinder of parties:**

Woodworth *v.* Wilson, 4 How. 712 [4 Am. & Eng. 542].

Notes and Citations.

3. Punitive damages:

Seymour *v.* McCormick, 16 How. 480 [p. *post*].

4. Measure of damages, when actual gains and profits:

Dean *v.* Mason, 20 How. 198 [p. *post*].

Burdell *v.* Denig, 92 U. S. 716.

Birdsall *v.* Coolidge, 93 U. S. 64.

Marsh *v.* Seymour, 97 U. S. 348.

Root *v.* Railroad, 105 U. S. 189.

Yale Lock M'fg Co. *v.* Sargent, 117 U. S. 536.

Mitigation of damages in case of innocent infringer:

Hogg *v.* Emerson, 11 How. 587 [5 Am. & Eng. 279].

Corning *v.* Burden, 15 How. 252 [p. 69 *ante*].

Mowry *v.* Whitney, 14 Wall. 620.

Patent in suit:

No. . . Woodworth, W., Dec. 27, 1828. Planing Mill.
Reissue No. 71, July 8, 1845.

OTHER SUITS ON SAME PATENT:

See Brooks *v.* Fiske [p. 64 *ante*].

Notes and Citations.

Cited:**IN SUPREME COURT OF UNITED STATES:**

- Dean *v.* Mason, 1858. 20 How. 198; Bk. 15, L. ed. 876.
Rubber Co. *v.* Goodyear, 1870. 9 Wall. 788; Bk. 19, L. ed. 566.
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Root *v.* Railroad Co., 1882. 105 U. S. 189. Bk. 26, L. ed. 975.
Dobson *v.* Carpet Co., 1885. 114 U. S. 439. Bk. 29, L. ed. 177.
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IN CIRCUIT COURTS:

- Goodyear *v.* Allyn, January, 1868. 6 Blatch. 38; 3 Fish 374.
Perry *v.* Corning, May, 1868. 6 Blatch. 184.
Carew *v.* Boston Elastic Fabric Co., October, 1871. 3 Cliff. 356;
5 Fish. 90.
Magic Ruffle Co. *v.* Elm City Co., October, 1875. 13 Blatch. 151;
2 Ban. & Ard. 152; 8 O. G. 773.
Sayles *v.* Richmond, Fredericksburg & Potomac R. R. Co., April,
1879. 3 Hughes, 172; 4 Ban. & Ard. 239; 7 The Reporter
743.
Burdett *v.* Estey, April, 1880. 19 Blatch. 1; 5 Ban. & Ard. 308.
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IN TEXT-BOOKS:

- 2 Abb. Pat. Law, 1886, pp. 361, 370.
Walker on Pats., 1883, p. 485.
Curtis on Pats., 4th ed., § 486.
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Statement of the case.

GEORGE W. AND HENRY SIZER, PLAINTIFFS
IN ERROR, v. WILLIAM V. MANY.

16 How. 98—164. December, 1858.

[Bk. 14, L. ed. 861; 1 Whit. 937.]

Second writ of error. Mandate. Jurisdiction. Costs.

1. After a case has been brought to the Supreme Court and decided and a mandate issued to the Court below, if a second writ of error is sued out, it brings up for revision nothing but the proceedings subsequent to the mandate (p. 195).
2. Where such being the case, the only question before the court was that of costs, which had been taxed less than \$2,000, held that the court had no jurisdiction under Act 1789 (p. 196).
3. Held further that the court had no jurisdiction under Act 1836, § 17, which is confined to cases involving the construction of the patent laws, and the claims and rights of patentees under them. That the amount of costs which either party shall be entitled to recover is not regulated by these laws (p. 196).
4. Practice of taxation of costs *nunc pro tunc* after the receipt of the mandate from the Supreme Court, approved (p. 196).

[Citations in the opinion of the Court:]
Browder v. McArthur, 7 Wheat. 58, p. 196.
Sibbold v. U. S., 12 Pet. 488, p. 196.

THIS case was brought up by writ of error from the Circuit Court of the United States for the District of Massachusetts.

Mr. George T. Curtis, on behalf of the defendant in error, moved to dismiss the writ of error for the want of jurisdiction.

The circumstances were these:

At the October term in the year 1848 of the Circuit Court of the United States for Massachusetts District, Many, the defendant in error, recovered a judgment against the

Statement of the case.

plaintiffs in error in an action for the infringement of letters patent, which was entered and recorded in the words following: "It is thereupon considered by the court that the said William V. Many recover against the said George W. and Henry Sizer the sum of seventeen hundred and thirty-three dollars and seventy-five cents damages, and costs of suit, taxed at ——."

The said Sizers thereupon, at the same term of the Circuit Court, sued out a writ of error to this court, for the purpose of having the said judgment revised. This writ of error was duly entered and prosecuted in this court, and at the December Term, 1851, the judgment of the Circuit Court was affirmed by a divided court; and therefore it is not reported in Howard.

The mandate which went down recited the judgment of the Circuit Court as above given, and then proceeded thus:

"You therefore are hereby commanded that such execution and proceedings be had in said cause as, according to right and justice and the laws of the United States, ought to be had, the said writ of error notwithstanding."

On the receipt of this mandate, the attorney for the defendant in error (the original plaintiff below) presented the same to the Circuit Court, held by the district judge, and applied for leave to have the costs in the action taxed and inserted in the blank left in the original record of the judgment. This motion was refused by the district judge.

The defendant in error thereupon, at the December Term of this court, in the year 1852, applied to this court for a mandamus to direct the court below to tax and allow his costs in the original action, amounting to \$1,811.59. The court refused the application, for reasons which appear in the case. *Ex parte* Many, 14 How. 24.

In May, 1853, Mr. Curtis, counsel for Many, renewed his motion to the district judge, setting out in writing the mandate of this court in the original cause, and the amount of the costs, and praying the court to make an order allowing of their taxation an insertion in the original judgment, and praying for execution as directed by the mandate of this court.

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Opposition was made to this motion by Sizer *et al.*, but the motion was granted, as appears by the following extract from the record. It is proper to remark that the court was held by the district judge alone, Mr. Justice Curtis having been of counsel and not sitting. The costs in the Circuit Court amounted to \$1,811.59.

And the said Sizer *et al.*, by their counsel, objected to the granting of the said motion for an *allocatur* as to the said costs, or to their being inserted in the judgment, and claimed and requested that if the court should allow the said costs, and direct the clerk to insert the amount in the record of said judgment, then the defendants should have a right to sue out a writ of error, and for that purpose that the court here should either certify that it is reasonable that there should be such writ of error, or should add interest upon the amount of said costs from the time of the rendition of the original judgment to the present time, so as to make the amount more than two thousand dollars, and that no execution should issue if, within ten days, a writ of error should be sued out, and security given according to law; to which claims and requests, made by the defendants, the plaintiffs objected, and insisted upon the said motion.

And now, the court having considered the said motion filed by the plaintiff, and the objections, claims, and requests made by the defendants, and deeming it to be the legal right of the plaintiff to have the said costs allowed, and the amount thereof inserted in the original judgment in this cause, and that it is not within the discretion of the court to allow or disallow the same, it is ordered by the court that the said costs, as taxed in said motion, be allowed, and that the amount thereof be inserted in the original judgment in this cause.

And the court here doth deem it reasonable that the said defendants should be allowed to bring a writ of error to the Supreme Court; and it is further ordered by the court, that execution, as prayed for in said motion of the plaintiff, shall issue after the expiration of ten days, Sundays exclusive, from the making of the order, unless the said defendant shall within said ten days give security according to law,

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and serve a writ of error, by leaving a copy thereof for the plaintiff in the office of the clerk of this court; and if such security should be given, and such service made within ten days, then that execution should not issue until the further order of the court.

By the court.

H. W. FULLER, Clerk.

The writ of error was sued out, and brought all these proceedings up to this court.

The motion to dismiss was argued by *Mr. Curtis*, in favor of it, and by *Mr. Robb* against it.

Mr. Curtis. The writ of error now before the court, although it brings up the proceedings in the Circuit Court prior to the mandate in the original cause, in contemplation of law can present for revision here solely the question, whether the Circuit Court erred in making the order by which the costs were allowed and directed to be inserted in the original judgment.

Over this question this court can have no jurisdiction, because—

1. The amount in controversy is less than \$2,000.

The sole amount or item in controversy under the motion of the plaintiff below, and involved in the order of the Circuit Court thereon, was the costs prayed for, being \$1,811.59.

The original judgment had been reviewed in this court by the first writ of error; and after a mandate has issued from this court affirming a judgment below and directing execution, a second writ of error can bring up nothing but the proceedings subsequent to the mandate. *Ex parte Sibbald*, 12 Pet. 488, 492; *Browder v. McArthur*, 7 Wheat. 58.

It cannot be pretended that this court can acquire jurisdiction of this writ of error upon the ground that the court below has allowed it in the exercise of a discretion conferred by statute (July 4, 1836, sec. 17) in patent cases, where the amount in controversy is less than \$2,000. The settled construction of that statute, is that it confers a discretion on the courts below to allow writs of error in cases where the

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amount in controversy is less than \$2,000, for the purpose of having some question settled that involves the construction of the Patent Acts. *Hogg v. Emerson*, 6 How. 439, 478 [5 Am. & Eng. 1]; *Wilson v. Sanford*, 10 How. 99 [5 Am. & Eng. 122]. The court below, by allowing the first writ of error which brought up the original judgment for a revision of the merits of the case, had exhausted all the discretion that the statute confers; and the question of allowing the plaintiff's costs to be taxed *nunc pro tunc*, and inserted in the judgment, had nothing to do with the construction of the Patent Laws.

Again, this court cannot take jurisdiction of this writ of error, because—

2. The order of the court below, although in form a final order or judgment, is, in fact and substance, an interlocutory order. The part of the order of which the plaintiffs in error complain, is that allowing the costs; and this was asked and allowed as a proceeding *nunc pro tunc*, and therefore was, in contemplation of law, prior to the final judgment from which the first writ of error was prosecuted. That part of the order which allows the execution in case the writ of error is not prosecuted within ten days, is not a final judgment in the sense of the Judiciary Act.

Mr. Robb made the following points:

1. The amount in dispute between the parties exceeds the sum of \$2,000, although the amount of costs allowed by the court below to be inserted in the judgment, by way of amendment, is less than that sum. The necessary result of the allowance of the amendment is to subject the plaintiff to the payment of \$2,000 and upwards.

2. The defendant in error cannot, by a voluntary remittit of the excess above \$2,000, against the consent of the plaintiffs in error, defeat their right to a writ of error from this court.

3. This court will not regard the order of the court below, allowing the amendment as a proceeding *nunc pro tunc*, and as of the October Term, 1848, of that court, if thereby the right of appeal to this court will be defeated.

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4. The proceedings of the court below, in the execution of the mandate, are the subject of revision by this court; and it is error in the inferior court to grant any relief whatever after the mandate, or to examine it for any other purpose than execution. *Ex parte Sibbald*, 12 Peters 492. And the order or judgment purporting to be pursuant to and in execution of the mandate will be reviewed by this court; and if it appear by the record that such order is at variance with the mandate, the court will exercise jurisdiction for the purpose of examining into the grounds of such variance. The variance in this case is matter of substance. In contemplation of law, a judgment for a sum expressed as damages and "costs to be taxed," or taxed at —, is a judgment for damages alone, and execution can issue only for that sum. *Cook et al. v. Brister*, 4 Har. 73, and cases cited. This court will exercise jurisdiction over such proceedings, although the additional relief erroneously granted in the court below be less in amount than \$2,000.

5. This cause is now for the first time properly before this court upon the entire record, and the previous writ of error and the proceedings thereon in this court were without jurisdiction, because the judgment of the Circuit Court upon which it was brought was not final. When costs are taxed upon a judgment, such taxation is to be considered as the period at which final judgment is pronounced. *Salter v. Slade*, 3 Nev. & M. 717; *Butler v. Bulkeley*, 8 Moore, 104; 1 Bing. 233; *Godson v. Lloyd*, 1 Gale 244; *Wright v. Lewis*, 4 Jur. 1112, B. c.; *Blackburn v. Kymer*, 1 Chas. Marshall, 278. And the order of the court allowing the costs to be taxed should be treated as the completion of the judgment of the Circuit Court in the cause.

6. The present writ of error, therefore, is properly allowed by the court below in the exercise of the discretion conferred by the seventeenth section of the Act of July 4, 1836.

Mr. Chief Justice TANEY delivered the opinion of the court.

A motion has been made to dismiss the writ of error in this case for want of jurisdiction.

Opinion of the court.

The case, as it comes before us, is this: Many, the defendant in error, in the year 1848, recovered a judgment in the Circuit Court for the District of Massachusetts, against the plaintiffs in error, in an action for the infringement of certain letters patent. The verdict and judgment were for less than \$2,000, but the writ of error to remove the case to this court was allowed under the Patent Law of 1836. From some oversight or accident, the costs were not taxed in the Circuit Court before the transcript of the record was transmitted to this court; and the judgment as it stood upon the transcript was for the damages awarded by the jury and costs of suit, leaving a blank space open for the insertion of the amount of the costs.

The judgment of the circuit court was affirmed at the December Term, 1851, and the usual mandate sent down directing execution.

Upon the receipt of the mandate by the Circuit Court, the defendant in error applied for leave to have the costs taxed, and the amount inserted in the blank left for that purpose in the original record of the judgment. The motion was refused. And thereupon the defendant in error, at December Term, 1852, applied to this court for a mandamus directing the court below to tax and allow his costs in the original action, amounting, as he alleged, to \$1,811.59. But the court refused the motion, upon the ground that a mandamus could not lawfully be issued to a Circuit Court to guide its judgment in the taxation of costs.

At a subsequent term of the Circuit Court, the defendant in error renewed his motion for an order allowing the taxation of these costs and their insertion in the original judgment; and the court thereupon allowed the taxation of costs, and directed the amount above mentioned to be inserted in the original judgment. But the court at the same time allowed a writ of error from their decision, and ordered that this second writ of error should operate as a *supersedeas* of the execution prayed for, if sued out within the time fixed by law. It is this writ of error that is now before the court, and which the defendant in error has moved to dismiss.

Opinion of the court.

It has been settled, by the decisions of this court, that after a case has been brought here and decided, and a mandate issued to the court below, if a second writ of error is sued out it brings up for revision nothing but the proceedings subsequent to the mandate. None of the questions which were before the court on the first writ of error can be reheard or re-examined upon the second; and there is nothing therefore now before the court but the taxation of costs. (*Browder v. McArthur*) 7 Wheat. 58; (*Sibbald v. U. S.*) 12 Pet. 488, 492.

The sum taxed being less than \$2,000, no writ of error will lie under the Act of 1789. This act gives no jurisdiction to this court over the judgment of a Circuit Court, where the judgment is for less than that sum.

Neither can the allowance of the writ by the Circuit Court give jurisdiction where the only question is the amount of costs to be taxed, and the amount allowed is less than \$2,000. The discretionary power in this respect vested in the Circuit Courts by the act of July 4, 1836, sec. 17, is evidently confined to cases which involve the construction of the Patent laws, and the claims and rights of patentees under them. But the amount of costs which either party shall be entitled to recover is not regulated by these laws. The costs claimed are allowed or refused in controversies arising under the Patent Acts, upon the same principles and by the same laws which govern the court in the taxation of costs in any other case that may come before it. The same laws, therefore, must be applied to them in relation to the writ of error, and must limit the jurisdiction of this court as in other cases.

The writ of error must therefore be dismissed for want of jurisdiction. But as the question raised in this case may often occur in the Circuit Courts, and it is important that the practice should be uniform, it is proper to say that we consider the decision of the Circuit Court, allowing those costs to be taxed after the receipt of the mandate from this court, to have been correct, and conformable to the general practice of the courts. The costs are perhaps never in fact taxed until after the judgment is rendered, and in many

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cases cannot be taxed until afterwards. And where this is the case, the amount ascertained is usually, under the direction of the court, entered *nunc pro tunc* as a part of the original judgment. And this mode of proceeding is necessary for the purposes of justice, in order to afford the necessary time to examine and decide upon the several items of costs to which the successful party is lawfully entitled.

ORDER. This cause came on to be heard on the transcript of the record from the Circuit Court of the United States for the District of Massachusetts, and was argued by counsel; on consideration whereof, it is now here ordered and adjudged by this court that this cause be, and the same is hereby, dismissed for the want of jurisdiction.

DISMISSED.

Notes:

3. Act 1819, § 1; **Act 1836, § 17:** Act 1870, § 55; R. S., § 4921.

Jurisdiction, sum less than \$2,000, see

Wilson *v.* Sandford, 10 How. 99, [5 Am. & Eng. 122].

Brown *v.* Shannon, 20 How. 55 [p. *post*].

Patent in suit:

No. 640 . Truscott, Wolf & Dougherty. March 17,
1838. Car Wheels.

OTHER SUITS ON SAME PATENT:

Many *v.* Jagger, 1848. 1 Blatchf. 872; Fish. Pat. Rep. 222.

Many *v.* Sizer, 1849. 1 Fish. 17.

Many *v.* Sizer, 1849. 1 Fish. 31.

Notes and Citations.

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IN SUPREME COURT OF UNITED STATES:

Roberts v. Cooper, 1858. 20 How. 467 : Bk. 15. L. ed. 969.

Tyler v. Magwire, 1873. 17 Wall. 253; Bk. 21, L. ed. 576.

Supervisors v. Kennicott, 1877. 94 U. S. 498; Bk. 24, L. ed. 260.

IN CIRCUIT COURTS:

Craig v. Steamer "Hartford," July, 1856. MacA. 91.

Coburn v. Schroeder, August, 1881. 19 Blatch. 493; 12 Reporter 389.

IN TEXT-BOOKS:

Walker on Pats., 1883, p. 381.

Curtis on Pats., 4th ed., § 499.

Dec., 1853.]

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Statement of the case.

WILLIAM H. SEYMOUR AND DAYTON S. MORGAN, PLAINTIFFS IN ERROR, *v.* CYRUS H. McCORMICK.

16 How. 480-491. Dec., 1853.

[Bk. 14, L. ed. 1024; 1 Whit. 944.]

Actual damages must be proven. License fee. Infringement of improvement.

1. Measure of damages. Acts of 1790, 1800 and 1836 reviewed (p. 211).
2. The patent Act of 1836 confines the jury to the assessment of "actual damages." The power to inflict punitive damages is committed to the discretion and judgment of the Court (p. 211).
3. There can be no general rule of damages which will apply equally to all cases. The reason stated (p. 212).
4. Where an inventor finds it profitable to exercise his monopoly by selling licenses to make or use his improvement, he has himself fixed the average of his actual damage, when his invention has been used without his license (p. 213).
5. Actual damages must be actually proved, and cannot be assumed as a legal inference from any facts which amount not to actual proof of the fact (p. 213).
6. In the suit for the infringement of patent No. 5385, McCormick, C. H., Oct. 23, 1847, Harvester, which was an improvement on a prior patented machine of his, *held* that it was error to instruct the jury, that as to the measure of damages the same rule is to govern, whether the patent covers an entire machine or an improvement on a machine (p. 214).

THIS case was brought up by writ of error from the Circuit Court of the United States for the Northern District of New York.

The manner in which the suit was brought, and the charge of the Circuit Court, which was excepted to, are stated in the opinion of the court. The reporter passes

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over all other questions which were raised and decided, except those upon which the decision of this court turned.

It was argued by *Mr. Gillet* for the plaintiffs in error, and by *Mr. Stevens* and *Mr. Johnson* for the defendants in error. There was also a brief filed by *Mr. Selden* for the plaintiffs in error.

The following points are taken from the brief of *Mr. Gillet* for the plaintiffs in error:

Sixth. Where the claim on which the suit is founded is for an improvement on old machines, patented or unpatented, the plaintiff is not entitled to recover, as a measure of damages, the mechanical profits that he could make upon the whole machine, including the old part. His damages are limited to the profits on making and vending the improvement patented and infringed.

The plaintiff recited in his declaration and furnished oyer of his old patent of 1834, for a reaping machine, which expired in 1848, and his patent of 1845, which is described as an "improvement upon his patented machine." In his patent of 1847, he claims "new and useful improvements in the reaping-machine formerly patented by me," in which he also claims other improvements besides the one in controversy, which is his last claim, and relates to the seat. For the purpose of this suit, the machine described in the patent of 1834, (which had, in fact, become public property,) and the improvements in the patent of 1845, and a large portion of those included in that of 1847, the defendants had a perfectly lawful right to use. This covered the whole of the improved reaping-machine, except what related to the seat, and its combination with the reel. It cost the defendants to make their machine, which had no seat, about \$64.26. There was no proof to show the extent of the cost of the plaintiff's seat. One was made by Zinck for one dollar. The plaintiff allowed Brown, in effect, 1845-1846, \$75 each for making machines without the elevated seat; and he proved on this trial, by Blakesley, that it cost him only \$36, and, by Dorman, \$37, to

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make them with it. There can be no pretense that the addition of the seat, and what is covered by the last claim, added much, if anything, to the cost of constructing the improved machine. The plaintiff proved, by Blakesley, that the manufacturer's profit on the whole machine, including a thirty-dollar patent fee, was \$74.

It is evident that the manufacturer's profit constituted the principal item of gain in constructing and selling the plaintiff's reaper. The court instructed the jury that this profit on the two old machines, and on that part of the new not in controversy, could be recovered as a part of the plaintiff's "actual damage" for violating the last claim of the patent of 1847. The old machine of 1834 was public property, and everybody had a right to construct and use it. The patents show that it contained the great and fundamental parts, and nearly the whole of the new machine. As the plaintiff had decided not to proceed on his patent of 1845, that was, in effect, public property. By waiving any right to proceed on the first claim of his patent of 1847, the plaintiff limited himself to the seat, combined with the reel. The defendants had a right to make every other part of the improved machine, and having the right, the profits up to that point were lawfully theirs. They had the right to construct the whole, save the seat. If a profit could be made upon such construction, it was as clearly theirs as if they had been made upon a machine totally unlike the plaintiff's. There is no law, statute or otherwise, which prohibits their making and receiving such profits. The court instructed the jury that all these profits belonged to the plaintiff, but pointed to no law showing him entitled to them. The manufacturer's profits were distinct from his patent profits, which he estimated and charged the defendants and his partners generally at \$30. The charge of the court gives him both. It makes the monopoly of a patent confined to an inexpensive improvement carry with it a monopoly of manufacturer's profits upon what is public property, precisely the same as if the whole had been included in the claim on which the trial was had. The ruling of the judge allowed the plain-

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tiff damages to as great an extent as if the trial had been on, and had established, the old patents of 1834 and 1845, and on the first claim of that of 1847, as well as on the last. If the defendants pay these damages, there is nothing to prevent the plaintiff suing on the patent of 1845, and on the first claim of that of 1847, because this trial and verdict were confined to the last claim of the latter patent. They were not recovered upon; but the plaintiff was adjudged to enjoy their advantages under the head of manufacturer's profits. But we deny that the Patent Laws confer a monopoly of profits on anything not actually patented. It would be extending the statute so as to make it cover, in effect, things that the patentee did not invent, and which by law belonged to the public at large. This principle would authorize the patentee of an improvement in steamboat machinery, or railroad cars, carding, spinning, weaving, and other like machines, to recover, on a patent for some trifling improvement of either, the entire profits of manufacturing the whole apparatus to which it might be attached.

The judge's rule allows the plaintiff precisely the same damages as if his last claim covered the whole reaping-machine, and had been held to be valid. Under his ruling, if the material parts, other than the seat, had been covered by several other patents, the defendants would have been responsible on each, as well as to the plaintiff, for all profits, manufacturing as well as for the patent-right. In such a case the plaintiff's rights, as against the defendants, would be precisely as strong as when the latter used what is now public property. If the plaintiff should bring a new suit on his patent of 1845, the recovery on that of 1847 would be no bar, and he might obtain a second manufacturer's profit. The defendants sought to attack the validity of the patent of 1845, but the evidence was ruled out; still the plaintiff was allowed to recover for the manufacturer's profits of the part of the machine covered by this patent, just the same as if it had been a part of the last claim of the patent of 1847. If the defendants had been patentees of the whole machine except the seat, and they had in-

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fringed the patent for that, could the plaintiff recover manufacturer's profits on the whole machine? Clearly not. Still the rights of the defendants to make and use all but the seat are just as strong and legal, when they use what is public property, or what is not covered by the last claim of the patent of 1847, as if they exercised them under a patent. The fact that they had or had not a patent for everything but the seat, can neither increase nor diminish the plaintiff's rights to damages; they must rest solely upon his patent, and not upon those of others. The law allows him all the profit he can make on his patented improvement, and nothing beyond. The judge's instruction was clearly erroneous, and vitiates the verdict.

Seventh. In estimating the plaintiff's damages for an infringement, his "actual damages" alone are to be considered, and the jury are not authorized to presume that if the defendants had not made and sold machines, "all persons who bought the defendants' machines would necessarily have been obliged to go to the patentee and purchase his machines."

The proof showed that the plaintiff manufactured his machines only at Chicago, in Illinois, and his sales were in the Western States, except a few in Western New York. The defendants manufactured their machines at Brockport, near Rochester, in New York, and sold them there, in Canada, and some at the West, as proved. It was proved by Hanna: "The demand within my knowledge has been unparalleled, the manufacturer oftentimes not being able to supply the demand at certain points." The plaintiff offered no proof tending to show that he could and did supply all the demands for his machine, and could have furnished more if called for. In the absence of this evidence, and in direct conflict with the oath of the plaintiff's own witness, who was his superintendent, the court instructed the jury, that, as a matter of law, they were to presume that if the defendants had not constructed and sold any machines, the plaintiff would have manufactured and sold machines to the same persons to whom the defendants had sold. Hence, the jury were instructed to presume, "in the judgment of

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the law," what was grossly improbable, and what the plaintiff himself had actually disproved. The law does not presume that all the persons who purchased of the defendants would have purchased of the plaintiff, because the law does not presume absurdities, and what is substantially a physical impossibility; nor does it presume, without evidence, that the plaintiff had introduced a witness who had sworn falsely. This part of the charge is clearly erroneous. The court should have submitted this matter to the jury, to pass on as a question of fact.

(Mr. Stevens' eighth point was relative to the following exception which had been taken by the defendants below, namely:)

To that part of the charge which states, "the general rule is, that the plaintiff, if he has made out his right to recover, is entitled to the actual damages he has sustained by reason of the infringement; and those damages may be determined by ascertaining the profits which, in judgment of law, he would have made, provided the defendants had not interfered with his rights. That view proceeds upon the principle, that if the defendants had not interfered with the patentee, persons who bought the defendants' machines would necessarily have all been obliged to go to the patentee and purchase his machine,"—the defendants counsel excepted.

Eighth. The tenth exception cannot be sustained. That exception is to that part of the charge which states that the rule of damages is "that the plaintiff is entitled to recover the actual damages he has sustained by reason of the infringement." Those damages may be determined by ascertaining the profits which the plaintiff would have made if the defendants had not interfered with his rights.

It is submitted that this is the correct rule of damages in any case; but in this case its correctness cannot be doubted. The defendants, with a full knowledge of plaintiff's rights, intentionally violated them. They were intentional wrong-doers, and were, therefore, bound to pay the plaintiff all the damage he had sustained by their tortious acts, just as much as they would be bound to pay him the full value of

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a horse or any other chattel of which they had tortiously deprived him.

It was, indeed, contended, on the trial, that defendants were only bound to pay such profits as they had made by this intentional piracy.

Without stopping to discuss the question whether there may not be considerations, in a suit in equity, where the defendants ignorantly infringed a patent, which might limit the damages in accordance with the rule contended for by the defendants, it is respectfully submitted, that in a suit at law, where the defendants have willfully, knowingly, and intentionally pirated the invention of the patentee, and appropriated it to their own use, the rule of damages laid down by the court in this case is correct.

An infringer can afford to sell the machine patented at a less profit than the patentee can.

He has spent no time, exercised no intellect, in excogitating the discovery or invention.

He has spent no time nor money in procuring the patent and bringing it into public use. Any other rule of damages, therefore, than that laid down by the court, would do great injustice to the patentee.

According to the rule contended for by defendants, if they had sold the reapers made by them for simply what it cost to construct them, or had given them away, although it deprived the patentee of the profits which he might have made upon those reapers, yet he could recover no damages.

But the defendants' counsel did not request the court to charge that the rule of damages was different from that stated by the court. They simply excepted to the charge of the court in that respect, without giving any reasons or stating how otherwise they desired the court to charge in that regard.

As to the rule of the damages, see *Pierson v. Eagle Screw Co.*, 3 Story 402, 410; *Allen v. Blunt*, 2 Wood. & Min. 123, 446-47.

Mr. Justice GRIER delivered the opinion of the court.

The plaintiff below, Cyrus H. McCormick, brought this

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action against the plaintiffs in error, Seymour & Morgan, for the infringement of his patent-right. The declaration consisted of two counts.

The first alleged that the plaintiff was the true and original inventor of certain new and useful improvements in the machine for reaping all kinds of small grain, for which he obtained letters patent on the 21st of June, 1834; and, moreover, that the plaintiff was the inventor of certain improvements upon the aforesaid patented reaping-machine, for which he obtained letters patent on the 31st day of January, 1845. And it charged that the defendant had made three hundred reaping-machines which infringed the inventions and improvements fourthly and fifthly claimed in the schedule or specification of the last-named letters patent.

The second count alleged that the plaintiff was the first inventor of certain other improvements upon his said reaping-machine before patented, for which he obtained letters patent on the 23d day of October, 1847; and that the defendant manufactured and constructed three hundred machines embracing the principles of the last-named invention and improvements. The defendants pleaded not guilty; and the case being called for trial in October, 1851, they prayed a continuance of the cause, on account of the absence of certain witnesses material to their defense against the charge laid in the first count, to wit, the infringement of the patent of 1845.

The court intimated an opinion that the affidavit was sufficient to put off the trial of the cause; whereupon the plaintiff's counsel stated to the court that rather than have the trial put off, they would not, on said trial, seek to recover against the defendant on account of any alleged infringement or violation by the defendants of the plaintiff's rights under his letters patent bearing date January 31, 1845, set forth in his declaration, but would proceed solely for a violation of the rights secured to him by his letters patent bearing date October 23, 1847, set forth in his declaration, under the last claim specified in that patent relating to the seat for the raker.

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The trial then proceeded on the last count in the declaration, for the infringement, by defendants, of this last patent; and testimony offered to show that the plaintiff was not the original and first inventor of the reaping-machine, as described in his patents of 1834 and 1845, was rejected.

Numerous exceptions were taken by defendants in the course of the trial, and to various instructions contained in the charge of the court. Most of these involve no general or important legal principle, and could not be understood without prolix statements with regard to the facts of the case and the structure of the peculiar machines. To notice them in detail would be both tedious and unprofitable. We deem it sufficient, therefore, to say that the defendants have failed to support their exceptions as to the rulings of the court concerning the testimony, and that the charge of the learned judge is an able and correct exposition of the law as applicable to the case, with the exception of the points which we propose now to examine, and which are contained in the following portion of the charge:

"The only remaining question is that of damages. The rule of law on this subject is a very simple one. The only difficulty that can exist is in the application of it to the evidence in the case. The general rule is, that the plaintiff, if he has made out his right to recover, is entitled to the actual damages he has sustained by reason of the infringement, and those damages may be determined by ascertaining the profits which, in judgment of law, he would have made, provided the defendants had not interfered with his rights.

"That view proceeds upon the principle that if the defendants had not interfered with the patentee, all persons who bought the defendants' machines would necessarily have been obliged to go to the patentee and purchase his machine. That is the principle on which the profits that the patentee might have made out of the machines thus unlawfully constructed, present a ground that may aid the jury in arriving at the damages which the patentee has sustained.

"It has been suggested by the counsel for the defendants, that inasmuch as the claims of the plaintiff in question here

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are simply for improvements upon his old reaping-machine, and not for an entire machine and every part of it, the damages should be limited in proportion to the value of the improvements thus made, and that therefore a distinction exists, in regard to the rule of damages, between an infringement of an entire machine and an infringement of a mere improvement on a machine. I do not assent to this distinction. On the contrary, according to my view of the law regulating the measure of damages in cases of this kind, the rule which is to govern is the same whether the patent covers an entire machine or an improvement on a machine. Those who choose to use the old machine have a right to use it without incurring any responsibility; but if they ingraft on it the improvement secured to the patentee, and use the machine with that improvement, they have deprived the patentee of the fruits of his invention, the same as if he had invented the entire machine; because it is his improvement that gives value to the machine, on account of the public demand for it. The old instrument is abandoned, and the public call for the improved instrument; and the whole instrument, with the improvement upon it, belongs to the patentee. Any person has a right to use the old machine; and if an inventor ingrafts upon an old machine, which he has a right to use, an improvement that makes it superior to anything of the kind for the accomplishment of its purposes, he is entitled to the benefit of the operation of the machine, under all circumstances, with the improvement ingrafted upon it, to the same degree in which the original inventor is entitled to the old machine.

"There are some data, furnished by the counsel on both sides, which it is proper the jury should take into view in ascertaining the damages, provided they arrive at this question in the case. It is conceded that just three hundred machines have been made by the defendants, of the description to which I have called your attention, and testimony has been gone into on both sides for the purpose of showing the cost of the machines, and the prices at which they sold. In order to ascertain the profits accruing to the party who makes machines of this description, you must first ascertain

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the cost of the materials and labor, and the interest on the capital used in the manufacture of the machines. You must also take into account the expenses to which the manufacturer is subjected in putting them into market, such as that of agencies and transportation, also of insurance; and where the article is sold on credit, a deduction must also be made for bad debts. All these things must be taken into account, in order to bring into the cost every element that properly goes to constitute it in the hands of the manufacturer. When you have ascertained the aggregate sum of the cost, deduct it from the price paid by the purchaser, and you have the net profit on each machine. By this process you are enabled to approximate to something like the actual loss that the patentee sustains in a case where his right has been violated by persons interfering with him and putting into market his improvement."

The plaintiffs in error complain that these rules with regard to damages, as thus laid down by the court, are incorrect, and have produced a verdict for most ruinous damages, far beyond anything justified by the facts of the case. 1. Because the jury were instructed that it is a legal presumption that if defendant had not made and sold machines, all persons who bought the defendant's machines would necessarily have been compelled to go to the patentee and purchase his machines. That this principle was enunciated as a binding principle of law, although the plaintiff below had given no evidence to show that he could have made and sold a single machine more than he did, or was injured in any way by the competition of the defendants, or hindered from selling all he made or could make. And, secondly, because the jury were instructed that the measure of damages for infringing a patented improvement on a machine in public use is the same as if the defendant had pirated the whole machine, and every improvement on it previously made; and, as a consequence, that the plaintiff below had a right to recover as great damages for the infringement of the patent in his second count as if he had proceeded on both counts of his declaration, and shown the infringement of all the patents claimed; and that in conse-

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quence of these instructions they have been amerced in damages to the enormous sum of \$17,306.66, and with costs to nearly the round sum of \$2' ,000.

We are of opinion that the plaintiffs in error have just reason of complaint, as regards these instructions and their consequent result.

The first Patent Act of 1790 made the infringer of a patent liable to "forfeit and pay to the patentee such damages as should be assessed by a jury, and, moreover, to forfeit to the person aggrieved the infringing machine."

The act of 1793 enacted "that the infringer should forfeit and pay to the patentee a sum equal to three times the price for which the patentee has usually sold or licensed to other persons the use of said invention." Here the price of a license is assumed to be a just measure of single damages, and the forfeiture by way of penalty is fixed at treble that sum. But as experience began to show that some inventions or discoveries had their chief value in a monopoly of use by the inventor, and not in a sale of licenses, the value of a license could not be made a universal rule as a measure of damages. The act of 17th of April, 1800, changed the rule, and compelled the infringer "to forfeit and pay to the patentee a sum equal to three times the actual damage sustained by such patentee." This act continued in force till 1836, when the act now in force was passed.

Experience had shown the very great injustice of a horizontal rule, equally affecting all cases, without regard to their peculiar merits. The defendant who acted in ignorance or good faith, claiming under a junior patent, was made liable to the same penalty with the wanton and malicious pirate. This rule was manifestly unjust; for there is no good reason why taking a man's property in an invention should be trebly punished, while the measure of damages as to other property is single and actual damages. It is true, where the injury is wanton or malicious, a jury may inflict vindictive or exemplary damages, not to recompense the plaintiff, but to punish the defendant.

In order to obviate this injustice, the Patent Act of 1836

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confines the jury to the assessment of "actual damages." The power to inflict vindictive or punitive damages is committed to the discretion and judgment of the court, within the limit of trebling the actual damages found by the jury.

It must be apparent to the most superficial observer of the immense variety of patents issued every day, that there cannot, in the nature of things, be any one rule of damages which will equally apply to all cases. The mode of ascertaining actual damages must necessarily depend on the peculiar nature of the monopoly granted. A man who invents or discovers a new composition of matter, such as vulcanized India-rubber, or a valuable medicine, may find his profit to consist in a close monopoly, forbidding any one to compete with him in the market, the patentee being himself able to supply the whole demand at his own price. If he should grant licenses to all who might desire to manufacture his composition, mutual competition might destroy the value of each license. This may be the case, also, where the patentee is the inventor of an entire new machine.

If any person could use the invention or discovery by paying what a jury might suppose to be the fair value of a license, it is plain that competition would destroy the whole value of the monopoly. In such cases the profit of the infringer may be the only criterion of the actual damage of the patentee. But one who invents some improvement in the machinery of a mill could not claim that the profits of the whole mill should be the measure of damages for the use of his improvement. And where the profit of the patentee consists neither in the exclusive use of the thing invented or discovered, nor in the monopoly of making it for others to use, it is evident that this rule could not apply.

The case of Stimpson's patent for a turnout in a railroad may be cited as an example. It was the interest of the patentee that all railroads should use his invention, provided they paid him the price of his license. He could not make his profit by selling it as a complete and separate machine.

An infringer of such a patent could not be liable to damages to the amount of the profits of his railroad, nor could the actual damages to the patentee be measured by

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any known ratio of the profits on the road. The only actual damage which the patentee has suffered in such a case is the non-payment of the price which he has put on his license, with interest, and no more. There may be cases, as where the thing has been used but for a short time, in which the jury should find less than that sum; and there may be cases where, from some peculiar circumstance, the patentee may show actual damage to a larger amount. Of this a jury must judge from the evidence, under instructions from the court, that they can find only such damages as have actually been proved to have been sustained.

Where an inventor finds it profitable to exercise his monopoly by selling licenses to make or use his improvement, he has himself fixed the average of his actual damage, when his invention has been used without his license. If he claims anything above that amount, he is bound to substantiate his claim by clear and distinct evidence. When he has himself established the market value of his improvement, as separate and distinct from the other machinery with which it is connected, he can have no claim, in justice or equity, to make the profits of the whole machine the measure of his demand. It is only where, from the peculiar circumstances of the case, no other rule can be found, that the defendant's profits become the criterion of the plaintiff's loss. Actual damages must be actually proved, and cannot be assumed as a legal inference from any facts which amount not to actual proof of the fact. What a patentee "would have made, if the infringer had not interfered with his rights," is a question of fact, and not a "judgment of law." The question is not what speculatively he may have lost, but what actually he did lose. It is not a "judgment of law," or necessary legal inference, that if all the manufacturers of steam-engines and locomotives who have built and sold engines with a patented cut off, or steam whistle, had not made such engines, that therefore all the purchasers of engines would have employed the patentee of the cut-off or whistle; and that, consequently, such patentee is entitled to all the profits made in the manufacture of such steam-engines by those who may have used his

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improvement without his license. Such a rule of damages would be better entitled to the epithet of "speculative," "imaginary," or "fanciful," than that of "actual."

If the measure of damages be the same, whether a patent be for an entire machine or for some improvement in some part of it, then it follows that each one who has patented an improvement in any portion of a steam-engine, or other complex machines, may recover the whole profits arising from the skill, labor, material, and capital employed in making the whole machine, and the unfortunate mechanic may be compelled to pay treble his whole profits to each of a dozen or more several inventors of some small improvement in the engine he has built. By this doctrine, even the smallest part is made equal to the whole, and "actual damages" to the plaintiff may be converted into an unlimited series of penalties on the defendant.

We think, therefore, that it is a very grave error to instruct a jury "that as to the measure of damages the same rule is to govern, whether the patent covers an entire machine, or an improvement on a machine."

It appears, from the evidence in this case, that McCormick sold licenses to use his original patent of 1834, for twenty dollars each. He sold licenses to the defendants to make and vend machines containing all his improvements, to any extent, for thirty dollars for each machine, or at an average of ten dollars for each of his three patents. The defendants made and sold many hundred machines, and paid that price and no more. They refused to pay for the last three hundred machines, under a belief that the plaintiff was not the original inventor of this last improvement, whereby a seat for the raker was provided on the machine, so that he could ride, and not be compelled to walk, as before. Beyond the refusal to pay the usual license price, the plaintiff showed no actual damage. The jury gave a verdict for nearly double the amount demanded for the use of the three several patents, in a suit where the defendant was charged with violating one only, and that for an improvement of small importance when compared with the whole machine. This enormous and ruinous verdict is but

Notes and Citations.

a corollary or necessary consequence from the instructions given in that portion of the charge of the court on which we have been commenting, and of the doctrines therein asserted, and to which this court cannot give their assent or concurrence.

The judgment of the Circuit Court is reversed, with a *venire de novo*.

ORDER. This cause came on to be heard on the transcript of the record from the Circuit Court of the United States for the Northern District of New York, and was argued by counsel; on consideration whereof, it is now here ordered and adjudged by this court, that the judgment of the said Circuit Court in this cause be, and the same is hereby, reversed with costs; and that this cause be, and the same is hereby, remanded to the said Circuit Court, with directions to award a *venire facias de novo*.

REVERSED AND REMANDED.

Notes :

2. Act 1790, § 4; Act 1793, § 5; Act 1800, § 3; **Act 1836, § 14;** Act 1870, § 59; R. S., 4919.
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Punitive damages :

Livingston v. Woodworth, 15 How. 546 [p. 167, *ante*].

Innocent infringer; mitigation of damages :

Hogg v. Emerson, 11 How. 587 [5 Am. & Eng. 279].

Corning v. Burden, 15 How. 252 [p. 69, *ante*].

Livingston v. Woodworth, 15 How. 546 [p. 167, *ante*].

Mowry v. Whitney, 14 Wall. 620.

Notes and Citations.

4. License fee as measure of damages :

- Hogg *v.* Emerson, 11 How. 587 [5 Am. & Eng. 279].
City of New York *v.* Ransom, 23 How. 487.
Philp *v.* Nock, 17 Wall. 460.
Packet Co. *v.* Sickles, 19 Wall. 611.
Burdell *v.* Denig, 92 U. S. 716.
Birdsall *v.* Coolidge, 93 U. S. 64.
Root *v.* Railway, 105 U. S. 189.
Clark *v.* Wooster, 119 U. S. 322.
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Actual gains and profits as measure of damages :

See Woodworth *v.* Livingston, 15 How. 546 [p. 167
ante], note 4.

Absence of license fees, royalty, &c. :

- Suffolk Mfg. Co. *v.* Hayden, 3 Wall. 315.
Philp *v.* Nock, 17 Wall. 460.
Root *v.* Railway, 105 U. S. 189.
Yale Lock Mfg. Co. *v.* Sargent, 117 U. S. 536.
U. S. *v.* McKeever, 23 O. G. 1530.
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5. Damages must be proven,

- City of New York *v.* Ransom, 23 How. 487.
Philp *v.* Nock, 17 Wall. 460.
Robertson *v.* Blake, 94 U. S. 728.

else are nominal.

- City of New York *v.* Ransom, 23 How. 487.
Robertson *v.* Blake, 94 U. S. 728.
Black *v.* Thorne, 111 U. S. 122.

Notes and Citations.

6. Improvement. Rule of damages.

Littlefield v. Perry, 21 Wall, 205.

Mason v. Graham, 28 Wall. 261.

Garretson v. Clark, 111 U. S. 120; and see
Gould's Mfg. Co. v. Cowing, 105 U. S. 253.

McKeever v. U. S., 23 O. G. 1530.

Patents in suit:

No. 3895 McCormick, C. H. January 31, 1845.

Harvester.

No. 5335 McCormick, C. H. October 23, 1847.

Harvester.

Re-issue No. 239. May 24, 1853.

OTHER SUITS ON SAME PATENTS:

McCormick v. Seymour, 1851. 2 Blatchf. 240.

McCormick v. Seymour, 1854. 3 Blatchf. 209.

McCormick v. Many, 1855. 6 McL. 539.

McCormick v. Seymour, 1856. 19 How. 96; 1 Whit. 1004 [p. post].

McCormick v. Talcott, 1857. 20 How. 402; 1 Whit. 1085.

Cited:

IN SUPREME COURT OF UNITED STATES:

Silsby v. Foote, 1858, Dis. Opin. 20 How. 378; Bk. 15, L. ed. 953.

City of New York v. Ransom, 1860. 23 How. 487; Bk. 16, L. ed. 515.

Mowry v. Whitney, 1872. 14 Wall. 620; Bk. 20, L. ed. 860.

Packet Co. v. Sickles, 1874. 19 Wall. 611; Bk. 22, L. ed. 203.

Birdsall v. Coolidge, 1876. 93 U. S. 64. Bk. 23, L. ed. 802.

Root v. Railroad Co., 1882. 105 U. S. 189; Bk. 26, L. ed. 975.

Dobson v. Carpet Co., 1885. 114 U. S. 439; Bk. 29, L. ed. 177.

Andrews v. Hovey, 1888. 124 U. S. 694.

Notes and Citations.

IN CIRCUIT COURTS:

- Hussey v. Whately, December, 1860; 1 Bond, 407; 2 Fish. 120.
Livingston v. Jones, November, 1861; 3 Wall. Jr. 330; 2 Fish. 207; 2 Pitts. R. 68.
- Burdell v. Denig, Oct. 1865; 2 Fish. 588.
- Schwarzl v. Holenshade, October, 1866; 2 Bond 29; 3 Fish. 116.
- Brodie v. Ophir Silver Mining Co., October, 1867; 5 Saw. 608; 4 Fish. 187.
- Whitney v. Mowry, October, 1868; 4 Fish. 141.
- Graham v. Mason, January, 1872; 1 Holmes 88; 5 Fish. 290; 1 O. G. 609.
- Hamilton v. Ives, January, 1873; 3 O. G. 30; 6 Fish. 244.
- Emerson v. Simm, February, 1873; 6 Fish. 281; 3 O. G. 293.
- American Nicholson Pavement Co. v. City of Elizabeth, September, 1874; 1 Ban. & Ard. 439; 6 O. G. 764.
- Goodyear Dental Vulcanite Co. v. Van Antwerp, March, 1876; 2 Ban. & Ard. 252; 9 O. G. 497.
- Buerk v. Imhaeusser, November, 1876; 14 Blatch. 19; 2 Ban. & Ard. 452; 10 O. G. 907.
- Mulford v. Pearce, February, 1877; 14 Blatch. 141; 2 Ban. & Ard. 542.
- Vaughan v. Cen. Pac. R. R. Co., August, 1877; 4 Sawy. 280; 3 Ban. & Ard. 27.
- Burdett v. Estey, November, 1878; 15 Blatch. 849; 4 Ban. & Ard. 7; 15 O. G. 877.
- Calkins v. Bertrand, July, 1881; 10 Biss. 445; 8 Fed. Rep. 755.
- Wooster v. Simonson, June, 1883; 16 Fed. Rep. 680; 16 Rep. 35.
- Maier v. Brown, September, 1883; 17 Fed. Rep. 786; 16 Rep. 585.
- Westcott v. Rude, April, 1884; 19 Fed. Rep. 880; 27 O. G. 719.
- Hall v. Stern, July, 1884; 20 Fed. Rep. 788.
- Gottfried v. Crescent Brewing Co., December, 1884, 22 Fed. Rep. 433; 30 O. G. 892.

Notes and Citations.

Stutz v. Armstrong, September, 1885, 25 Fed. Rep. 147.
Everest v. Buffalo Lubricating Oil Co., July, 1887; 31 Fed. Rep. 742.
Bell v. U. S. Stamping Co., September, 1887; 32 Fed. Rep. 549.

IN DECISIONS OF COMMISSIONER OF PATENTS:

Drawbaugh v. Blake, March, 1883; 23 O. G. 1221.

IN TEXT-BOOKS:

2 Abb. Pat. Law. 1886, pp. 340, 356, 357, 359, 361, 367, 454.
Walker on Pats., 1883, pp. 308, 388, 393, 396, 502.
Curtis on Pats., 4th ed., §§ 269, 338, 895, 476a.

Syllabus.

THE YORK AND MARYLAND LINE RAILROAD
COMPANY, PLAINTIFF IN ERROR, *v.* ROSS
WINANS.

17 How. 30-40. Dec., 1854.

[Bk. 15, L. ed. 27 ; 1 Whit. 956.]

Infringement. Corporate liability. Judicial notice.

1. Where the York and Maryland Line Railroad Co. (plaintiffs), whose stock was subscribed for by a Maryland company, partly owned the motive power on the road, employed and paid the agents and officers, and the cars constituting the alleged infringement were fitted and repaired at the common expense of the two corporations, *held* that plaintiff was a principal, coöperating with another corporation in the infliction of a wrong, and directly responsible for resulting damages (p. 233).
2. The law will strip a corporation or individual of every disguise, and enforce a responsibility according to the very right, in despite of all artifices (p. 233).
3. Where objection was taken to a patent that it was signed by "an acting Commissioner of Patents," and that the record contained no averment or proof of his title to the office, *held* that it was not tenable (p. 234).
4. Held further that the court will take notice judicially of the persons who from time to time preside over the Patent Office, whether permanently or transiently (p. 234).

[Citations in the opinion of the Court :]

- Beman *v.* Rufford, 1 Simon N. S. 550, p. 233.
 Winch *v.* B. & L. Railway Co., 13 Eng., L. & E. 506, p. 233.
 Welland Canal Co. *v.* Hathaway, 8 Wend. 480, p. 233.
 Peters *v.* Ryland, 8 Harris 497, p. 233.
 Bostwick *v.* Champion, 11 Wend. 571, p. 234.
 Champion *v.* Bostwick, 18 Wend. 175, p. 234.
 Weed *v.* Saratoga & Schenectady R. R. Co., 19 Wend. 534, p. 234.
 Wilson *v.* Rousseau, 4 How. 646 [4 Am. & Eng. 646], p. 234.

THIS case was brought up by writ of error from the Circuit Court of the United States for the Eastern District of Pennsylvania.

Argument of counsel.

The case is stated in the opinion of the court.

It was argued by *Mr. J. Mason Campbell* and *Mr. Johnson*, for the plaintiff in error, and by *Mr. St. George T. Campbell* and *Mr. Latrobe*, for the defendant.

The points made by the counsel for the plaintiff in error were the following:

The court below (Judge KANE) charged the jury, in substance, that as the infraction complained of was committed on the road of the plaintiff in error, though the cars were owned by the Baltimore and Susquehanna Railroad Company, the plaintiff in error, was responsible in this action, because the profits accruing from the use of the cars were divided between the two companies.

He also charged the jury, that in estimating the amount of damages, they were to be guided by the sum which had been fixed by the witnesses as the fair compensation for an annual license for each car, and were to allow such sum annually, for each car, for a period of six years antecedently to the institution of the suit.

The plaintiff in error will contend that the learned judge below erred in both parts of his charge—

1. As to the liability of the plaintiff in error. The cars which were assumed to be made in violation of the patent of the defendant in error were not built by, and did not belong to, the plaintiff in error. It is not liable, therefore, for their construction ; nor is it pretended that it has sold any. If liable at all, it is for a use of the cars.

Now, in point of fact, it did not run the cars in question over its road.

The whole transportation was done by the Baltimore and Susquehanna Railroad Company ; and if there has been any user by the plaintiff in error of cars in violation of the patent of the defendant in error, it is a constructive user, growing out of the agreement between it and the Baltimore and Susquehanna Railroad Company, by which one-third of the net revenue from transportation is credited to it, and a user in fact, under that agreement, by the Baltimore and Susquehanna Railroad Company.

Argument of counsel.

This agreement is supposed, by the learned judge below, to do one of two things: either to constitute the relation of principal and agent between the two corporations, or to make them partners.

As to the first view, it may be observed that the subject of the agency being the running of the cars, and the plaintiff in error having nothing to do with the running, it can hardly be deemed an agent, in the face of the fact that it does nothing in the agency. With still less plausibility can it be regarded as a principal; its supposed agent in that case, the Baltimore and Susquehanna Railroad Company, not only owning and running the obnoxious cars itself, but doing so by force of its own power in the premises.

As to the other view, to wit, that of a partnership between the plaintiff in error and the Baltimore and Susquehanna Railroad Company, a more extended examination is necessary.

In the first place, it seems impossible to establish this hypothesis, without conceding that these two corporations would have had a right to form a partnership expressly. Whether the partnership be expressed or implied, only relates to the nature of the evidence by which it is shown. The thing is the same, however proved. Now, the power to form a partnership is one which corporations do not possess, unless it be given in express terms, or by necessary implication. *Sharon Canal Co. v. Fulton Bank*, 7 Wend. 412; *Canal Bridge v. Gordon*, 1 Pick. 305.

There are neither such words nor implication in the present instance, and, of consequence, no partnership can be deduced where the power to create that relation is wanting.

If, however, the power be conceded, and no partnership has been in terms formed, it is only to be implied, in law, from the division of the net profits of transportation between the two corporations, provided for by their agreement.

But the reception of a part of the profits is not always attended with this consequence. Seamen and clerks may receive their pay in this form, without becoming partners

Argument of counsel.

thereby, either *inter se* or as to third persons. So a landlord may get his rent in the shape of profits, and not be made a partner by such receipt. The test seems to be in the *animus* of the parties as to the reservation of profits, and not in the reservation itself. If their purpose be compensation merely to one furnishing something necessary to the business, a partnership is not held to be created. Such is the present case, where it is plain that the object was merely to compensate the plaintiff in error for the use of its road, and to make the rent therefor commensurate with the use. Story on Part., secs. 36, 38; 3 Kent's Comm. 33; Perrine *v.* Hankenson, 6 Halstead 181; Heimstreet *v.* Howland, 5 Denio 68; Heckert *v.* Fegely, 6 Watts & Serg. 143; Boyer *v.* Anderson, 2 Leigh 550; Loomis *v.* Marshall, 12 Conn. 69; Collyer on Part., sec. 44, and note.

Conceding, however, *argumenti gratia*, that the relation of principal and agent, or of partners, existed between the two corporations, it cannot be denied that the infringements complained of were not committed by the plaintiff in error, but by the Baltimore and Susquehanna Railroad Company.

Now, the tortious acts of the company last named cannot be considered as acts done in the ordinary course of the business between it and the plaintiff in error, whatever be the relation between these parties; and to make the plaintiff in error responsible, it must be shown to be privy to their commission, before or after. Story on Agency, sec. 455; Collyer on Part., sec. 457; Keplinger *v.* Young, 10 Wheat. 358, 363 [4 Am. & Eng. 209].

But the learned judge below excludes altogether this element of accountability, and makes the plaintiff in error liable, without putting the fact of privity to the jury.

2. The charge below is also erroneous as to the amount of damages recoverable.

It gave the jury to understand that they could find against the plaintiff in error for a user of the patent of the defendant in error, for six years preceding the commencement of the suit.

But the declaration only charged (Record, 4) a user during

Argument of counsel.

the term of seven years for which the extension of the patent had been granted.

Now, the seven years' extension began only on the 1st of October, 1848, and all, therefore, that was recoverable under the declaration was for a user from the 1st of October, 1848, to the time of suit brought (April, 1851), a period of less than three years, instead of six, as charged.

3. The suit being only for infringements committed during the extension of the patent, it is further submitted that the extension being by the acting Commissioner of Patents, is unavailing to give the defendant in error any rights.

If this court, in (*Wilson v. Rousseau*) 4 Howard 646 [4 Am. & Eng. 436], meant to affirm the validity of the acts of such a functionary, as is supposed by Mr. Justice Woodbury, in 1 Woodbury and Minot 248, this point is not now open; but if it be open, the plaintiff in error relies on the first and second sections of the Patent Act of 1846, as governing the Patent Office, to the exclusion of the Acts of 1792 and 1795. 1 Stat. at Large 281, 415.

The counsel for the defendant in error made the following points:

1. The extension of the patent by the acting Commissioner, &c. (The argument upon this head is omitted.)

The remaining exceptions to the charge of the judge were,—

1. "That the New York and Maryland Line Railroad Company, and the Baltimore and Susquehanna Railroad Company were two distinct companies as to third persons." The force of this exception is not clearly apprehended. If it is meant to convey the idea that the judge should have charged that the two companies were the same, and not "two distinct companies as to third persons," it is difficult to perceive, first, how it could have been sustained in point of law; or, second, how it would serve the defendants below. They were two corporations, had two charters from different sovereignties, and had never been united by law. How could the judge say, then, that they were not two distinct companies?

Argument of counsel.

But if they were the same company as to third persons, the judge should, (as this exception supposes,) have so charged; and then the main point of defense, that the use by one was not the use by the other would have utterly failed.

In fact, however, upon this point, all the judge said, was that if there were two tort feasors, a suit could be maintained against either; for which proposition no authority is needed.

2. The second exception to the charge is—

In charging further, that whether the relation between them was that of agency or partnership, the liability of defendants was the same.

As a legal proposition, standing singly, this can hardly be questioned.

One of two partners is liable to an action for an infringement, as for any other tort committed by his authority, or participated in by him. This was all the judge said. He was not asked to charge—

1. That two corporations cannot form a contract of co-partnership.

2. Or that, under the evidence in this cause, there was no proof of partnership.

3. Or that there was no evidence of agency by which the defendants could be held liable.

Not being asked, he expressed no opinion on the point, but simply said, whether the relations were those of partners, or principal and agent, neither would affect the plaintiff's right. In this there was, it is admitted, no error. If the defendant desired specific instructions, they should have been prayed.

The judge, by limiting his illustration to partnership or agency, actually favored the defendants; for he might have charged that, under the facts, no matter by what name the relation of the companies was called, the defendants were liable, participating as they did in the tort. Grant that no copartnership contract can lawfully be made between two corporations; yet, if they did make it shall they be allowed to allege its unlawfulness against a third party, whose property is tortiously used for their profit?

Argument of counsel.

If they do make such a bargain, whether lawful or otherwise, and it result in a use by them of the patented improvement, the unlawfulness of the contract by which the use was accomplished can be no defense.

They are complained of for one unlawful act, and this would be to defend it by showing another.

If they participated in the use of the patented thing, no matter how, whether under a lawful or unlawful contract, they are liable. It is the doing of the thing, and not the mode in which it is done, that is complained of.

Without defining the relations of the parties, the defendants, upon this view, are clearly liable.

Whether the contract was lawful or unlawful, its effect was to make the act of one the act of the other; the use by one the use by the other.

If, however, the relation of the two companies is here to be considered, and its character, not made the subject of an express point in the court below, is to be argued, it will be contended that such a use of the thing patented was proved as made the defendants liable, in any view that can be taken of the case.

1. Whether the use proved was to be regarded as a direct and independent use by the defendants below.

2. Or as a use through their agents, (the Maryland company,) with their knowledge, by their authority, upon their property, and of which use they directly received a portion of the profits.

3. Or as a use, as a partner, with the Maryland company, paying a proportion of losses by, and receiving a proportion of the profits, as such, from the use.

4. Or whether contributing as they did their road, which was essential to the availability of the cars of the Susquehanna company, the defendants below were to be looked upon, as suggested by the judge's charge, as the agents of the former company.

1. There was evidence of a direct and independent use by the defendants below, to the prejudice of the patentee.

The defendants were a Pennsylvania company fully organized, and having possession of their road.

Argument of counsel.

The uses made of their road were their own uses. The road and the cars upon it are a single machine, the use of a part of which involves the use of all other parts. The cars are useless without the road. The road is useless without the cars. The terms upon which the cars are permitted to be used are immaterial. The injury complained of is the use.

It is this which distinguishes this case from the case of *Keplinger v. Young*, 10 Wheaton, 358. [4 Am. & Eng. 209.] There Young was held not to be liable, because he only purchased the product of a machine; but it would have been different had he taken the machine into his own keeping, and used it.

Indeed, in that case the court intimate that had the facts from which it might fairly have been inferred that Young used the machine been before them, the result might have been different.

2. Even if the fact of the ownership of the cars by the Maryland company is inconsistent with this view, yet the Maryland company, using the defendants' road only through their consent, can occupy no other position than that of agents, for whose acts, done in the course of their business, the principals must be responsible, especially as they are directly benefited by them.

The Pennsylvania company may, by law, run cars on their own road. The Maryland company has no right to do so, by law, within Pennsylvania. Their charter gives, and can give, no such authority; and such running would be a nuisance, if done by them in Pennsylvania, and could not be justified under their own charter. The Pennsylvania company, duly chartered, build a road; they need rolling-stock, and the patented cars are used as such, and they receive one-third of the net profits of the earnings thereof. Without this, the Maryland company could not use the Pennsylvania road; by it, they become, for a fluctuating compensation, the agents of the Pennsylvania company, to stock and run their road. If there can be no partnership, they enter Pennsylvania by virtue of this agency alone. A portion of the things done by them in

Argument of counsel.

the fulfillment of that agency, by the authority, with the sanction, and upon the property of the defendants, is to use the patented improvement. A proportion of the repairs upon it are charged to the principal; a portion of the profits from its use is paid to the principal. No authorities are needed to show that for an injury by an agent the principal or the agent may be sued. The ownership of the infringing machine is immaterial; its use alone is in controversy; and it will be submitted that such an use, by an agent, as is here proved, will render the principal liable.

3. Or, regarding the use as the result of a partnership with the Maryland company, the defendants paying a proportion of losses and receiving a proportion of the profits, as such, from the use, the latter must be liable to the patentee.

Under this head, the second of the exceptions to the charge of the judge will be properly considered.

There was some relation between the companies, surely. What was it? If in fact it be that the Maryland company were simply using a Pennsylvania charter to carry on their business,—a change of name merely,—the stock, property, and everything being owned by the same parties, then, in Pennsylvania, the Maryland company's use was the Pennsylvania company's use.

The judge does not, however, define the character of this relation. He was not called upon to do so.

If it were needful, it might be well contended that the relation of the companies was that of partnership. Corporations may form partnerships under circumstances, so far, at least, as to preclude them from setting up separate rights, to the prejudice of third persons.

In the case of *Canal Bridge v. Gordon*, 1 Pick., 297, which was a case where a bridge and an embankment leading to it were owned by different corporations, Parker, C. J., after referring to the technical difficulties of considering several corporations as copartners, goes on to say, what covers precisely the present controversy: "And yet, if they are all composed of the same individuals, using several corporate powers for the same end and purpose, with nothing

Argument of counsel.

but the form of a record to distinguish them, equity would seem to require that they should not be allowed to sever, to the prejudice of any person with whom either might contract."

And for the same reason, where both are benefited by the wrong done by one of them, they should not be allowed to sever.

That contracts of the same nature are looked upon and treated as partnerships, will further appear by reference to the following authorities: (*Erskine v. Moulton*) 4 Law and Equity Reports, 171; (*Burdick v. Cheadle*) 2 Id., 319.

In the present case, there was every element required to form a partnership contract.

It is not the case where a portion of the gross receipts was used as a mode of calculating rent, as in (*Helmstreet v. Howland*) 5 Denio, 68, cited by plaintiff in error, but a right to a share of the net profits, as such, which that case decides to be a criterion of partnership. Nor is it the case in (*Brockway v. Allen*) 17 Wendell, 412, where it was held that two corporations cannot sue jointly, as corporations, in contract; but where it was not held that if, in fact, such co-partnership existed, either could escape liability for a tort arising in that relation, by alleging its unlawfulness.

The law of New York, upon this question of partnership liability to third persons, is clearly settled in *Bostwick v. Champion*, 11 Wend., 571, where it was held, that where A, B, and C run a line of coaches, the route being divided between them into sections, each furnishing his own horses and coaches, and hiring drivers, and paying the expenses of his own section, the fare, less the tolls, being divided in proportion to the number of miles run, that a passenger injured by negligence of the drivers of A's coach might sue them all.

The court is referred to the opinion of Judge Nelson, at page 584, and to same case, Chancellor Walworth's opinion, (*Champion v. Bostwick*) 18 Wend., 175.

A division of profits, as profits, and a right to file a bill for an account, may be regarded as conclusive evidence of a copartnership contract.

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Both, it is submitted, concur here.

The distinction which, it is believed, will reconcile all the cases, is between a stipulation for a compensation proportioned to the profits, and one for an interest in such profits.

To this effect, the cases are numerous. See Carey on Part., 9 ; Story on Part., 36 ; Bissett on Part., 4 ; Collyer on Part., 44, and the cases here cited.

Every element referred to by these authorities exists here.

If they may so contract as partners, it will be contended that the evidence exhibits every feature required by law for that relation.

If not liable as joint tort feasors or partners, from want of legal authority to make such a contract, or if the contract as made does not by law create this relation, still the defendants are liable by reason of the use made of this road by the Susquehanna company.

Mr. Justice CAMPBELL delivered the opinion of the court.

The plaintiff is a corporation existing under a charter from the State of Pennsylvania, and authorized to construct a railroad from the town of York to the Maryland line. Its stock was subscribed for by the Baltimore and Susquehanna Railroad Company, a Maryland corporation, and their joint capital is vested in a continuous railroad from the city of Baltimore to York. The management of the road is committed to the Maryland company, which appoints the officers and agents upon it, and furnishes the rolling-stock necessary for its operation. The president and secretary of the two companies are the same. The directors of the Pennsylvania corporation (plaintiff) are selected by the Maryland company, and are qualified by a transfer of one or more shares of its stock to them, shortly before an election, and which they return on vacating their office. This nominal organization is made necessary by the charter, which requires that the majority of the officers shall be citizens of Pennsylvania, and that annual reports of the condition and business of the company shall be rendered to the legislature. To preserve appearances with the legislature, an annual statement is made.

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In this, the gross receipts of the entire road for the year are ascertained, and the expenses deducted ; the balance is then divided, one-third being assigned to the plaintiff ; but no money passes between the corporations. In these expense accounts, the salaries of officers, conductors, and engineers, the cost of locomotives and fuel, of the repairs and insurance of cars, and the losses of business, enter as constituent items. It was admitted, upon the trial of the cause, that a number of cars, made according to the specification of the patent of the defendant, had been used upon the road without his license, and for which he brought this suit. A verdict was rendered in his favor, and the judgment thereon is brought to this court, upon exceptions to the instructions of the Circuit Court to the jury.

The court charged the jury, that the road on which the infraction was committed was held under a Pennsylvania charter to the defendant in that court ; that the transportation on the road was carried on by the Maryland corporation ; and that the profits accruing from the use of the cars upon the road—that is, the profits of the infraction—are nominally divided between the two companies. That upon these facts, the plaintiff is entitled to recover against the present defendants, whether they are to be regarded as partners, or as principal, or agent of the Maryland corporation.

The plaintiff complains here of this charge, for that the cars employed were not built by, and did not belong to, the company ; that they were the exclusive property of the Maryland corporation ; and that the agreement to divide the profits did not constitute a partnership, nor evince a relation of principal or agent to impose a liability. This conclusion implies that the duties imposed upon the plaintiff by the charter are fulfilled by the construction of the road, and that by alienating its right to use, and its powers of control and supervision, it may avoid further responsibility. But those acts involve an overturn of the relations which the charter has arranged between the corporation and the community. Important franchises were conferred upon the corporation, to enable it to provide the facilities to communication and intercourse required for the public con-

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venience. Corporate management and control over these were prescribed, and corporate responsibility for their insufficiency provided, as a remuneration to the community for their grant. The corporation cannot absolve itself from the performance of its obligations, without the consent of the legislature. *Beman v. Rufford*, 1 Simon, N. S., 550; *Winch v. B. and L. Railway Company*, 13 L. & E., 506.

If, then, the case had terminated with the facts that the infringement of the defendant's patent had taken place, by the acts of persons using the corporate name of the plaintiff, with the assent of the corporate authorities, their liability would have been fixed.

But the case before us is, that the motive-power on the road partly belongs to the plaintiff; that the agents and officers employed are in its service, and are paid by it; and that the cars are fitted and repaired at the common expense of the two corporations. It follows, therefore, that the plaintiff is a principal, co-operating with another corporation, in the infliction of a wrong, and is directly responsible for the resulting damage.

Nor will the plea that the corporation has no independent nor responsible existence, as regards the Maryland company, and that its display of a president and directors, of conductors, engineers, and agents, of annual elections and annual statements, import only a formal and illusive representation before the Legislature of Pennsylvania, or their constituents, of a compliance with the conditions of the charter, avail the plaintiff. It is certainly true, that the law will strip a corporation or individual of every disguise, and enforce a responsibility according to the very right, in despite of their artifices. And it is equally certain, that, in favor of the right, it will hold them to maintain the truth of the representations to which the public has trusted, and estop them from using their simulation as a covering or defense. *Welland Canal Co. v. Hathaway*, 8 Wend., 480.

The Supreme Court of Pennsylvania, in *Peters v. Ryland, 8 Harris, 497*, has announced principles decisive of this case.

The court held, that the owner of a passenger-car, em-

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ployed on a railroad belonging to the State, and the motive-power and superintendence of which is furnished by the State, is responsible for the misconduct of the public agents. It says: "The case before them is *sui generis*; but it comes much nearer to that class of decisions in which it has been held, that several parties engaged in carrying over different portions of the same line of conveyance, each sharing in the profits of the whole route, and of course of each section of it, are all responsible for the faithful discharge of their duty, and liable to respond in damages for any injury which results from the negligence or unskillfulness of any of the proprietors and servants." (*Bostwick v. Champion*) 11 Wend., 571; (*Champion v. Bostwick*) 18 Id., 175; (*Weed v. Saratoga and Schenectady R. R. Co.*) 19 Id., 534.

"The State, as well as the carrier, is paid for every passenger transported on this railroad, which shows their community of interest; and if there be a common liability, that of the State cannot be enforced by action; and this circumstance does not diminish that of the carrier. Because they have a common interest, however, and share the business of transportation, it is apparent, that in holding the party before us to answer for the negligence of the State's agents, we do not punish one man for the misfeasance of another's servants."

The objection taken to the patent, that it is signed by "an acting Commissioner of Patents," and that the record contains no averment nor proof of his title to the office, is not tenable. The court will take notice judicially of the persons who from time to time preside over the Patent Office, whether permanently or transiently; and the production of their commission is not necessary to support their official acts. *Wilson v. Rousseau*, 4 How., 686 [4 Am. & Eng. 436.]

The judgment of the Circuit Court is affirmed.

ORDER. This cause came on to be heard on the transcript of the record from the Circuit Court of the United States for the Eastern District of Pennsylvania, and was argued by counsel; on consideration whereof, it is now here

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ordered and adjudged by this court, that the judgment of the said Circuit Court in this cause be, and the same is hereby, affirmed with costs, and interest until paid, at the same rate per annum that similar judgments bear in the State of Pennsylvania.

Notes:**3. Acting Commissioner.**

Wilson v. Rousseau, 4 How. 646 [4 Am. & Eng., p. 486].

4. Judicial notice, of what taken.**Facts of general knowledge and use.**

Brown v. Piper, 91 U. S. 37.

Terhune v. Phillips, 99 U. S. 592.

Slawson v. R. R. Co., 107 U. S. 649.

King v. Gallun, 109 U. S. 99.

Phillips v. City of Detroit, 111, U. S. 604.

Patent in suit:

No. . Winans, R., October 1, 1834. Eight-Wheeled Car.

OTHER SUITS ON SAME PATENT:

Winans v. Schenectady and Troy R. Co., 1851. 2 Blatchf. 279.

Winans v. Eaton, 1854. 1 Fish. 181.

Winans v. New York and Harlem R. R. Co., 1855. 4 Fish. 1.

Winans v. New York and Erie R. R., 1856. 1 Fish. 213.

Winans v. New York and Erie R. R., 1858. 21 How. 88; 1 Whit. 1096.

Notes and Citations.

Cited:**IN SUPREME COURT OF UNITED STATES:**

Thomas *v.* R. R. Co., October, 1880. 101 U. S. 71; Bk. 25, L. ed. 950.

IN CIRCUIT COURTS:

Emigh *v.* Chamberlain, September, 1861. 1 Biss. 367; 2 Fish. 192.

The Dorsey Harvester Revol. Rake Co. *v.* Marsh, April, 1873. 6 Fish. 387; 9 Phila. Rep. 395.

American Union Tel. Co. *v.* Union Pac. Ry. Co., April, 1880. 1 McC. 188.

Atlantic and Pacific Tel. Co. *v.* Union Pacific Ry. Co., 1880. 1 McC. 541.

IN STATE COURTS:

Board, etc., of Tippecanoe Co. *v.* Lafayette, M. & B., R. R. Co., May, 1875. 50 Ind. 85.

IN TEXT-BOOKS:

2 Abb. Pat. Law, 1886, p. 17.

Walker on Pats., 1883, pp. 122, 292, 297, 301.

Statement of the case.

THE TROY IRON AND NAIL FACTORY, APPELLANT, *v.* GEORGE ODIORNE, JR., AND FRANCIS ODIORNE.

17 How. 72. Dec., 1854.

[Bk. 15, L. ed. 37; 1 Whit. 967.]

Particular patent. Complete machine.

1. *Held* that a particular machine was set up and substantially finished prior to the application of H. Burden, made April 18, 1839, for letters patent No. 1757, granted Sept. 2, 1840, Spike making machine (p. 240).
2. The time when a particular apparatus was "constructed" in the sense of the stipulation was the time when it was attached to the machine, (substantially complete in its operative parts); it not being necessary that the machine should be geared and doing work (p. 240).

(Mr. Justice CURTIS, having been of counsel, did not sit in this cause.)

THIS was an appeal from the Circuit Court of the United States for the District of Massachusetts, sitting as a court of equity.

It was a bill filed by the Troy Iron and Nail Factory, a manufacturing corporation established in the State of New York, to restrain the Odiornes from infringing certain letters patent granted to Henry Burden on the 2d of September, 1840, and by him assigned to the complainants.

The respondents filed an answer, taking various grounds of defense, which it is not necessary, under the circumstances of the case, to particularize. At October Term, 1851, the following stipulation was signed by the parties, and filed in the cause:

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"The defendants agree not to deny the validity of the complainants' patent, provided they make out their title to the said letters patent to be good.

"They also agree not to deny that the machine complained of in the complainants' bill is an infringement on the patent granted to H. Burden on August 4, 1840. [Sept. 2.]

"If the complainants shall establish their title to the letters patent aforesaid, the proper decree may be entered for the complainants, unless the defendants shall prove that the spike-machine used by them, and complained of in the bill aforesaid, was constructed prior to the alleged application of H. Burden, made April 18, 1839, for letters patent therefor, according to the provisions of the statute of the United States, 1839, ch. 88, sec. 7; or was the result of an independent original invention, prior in time to the invention of the said Burden; in either of which cases, the proper decree shall be entered for defendants.

"C. P. CURTIS, JR., *Plaintiff's Attorney.*
"J. A. ANDREW, *for Defendants.*"

Much testimony was taken upon the subjects involved, and in December, 1852, the Circuit Court dismissed the bill. From this decree the complainants appealed to this court.

The case was argued by *Mr. George T. Curtis*, for the appellants; no counsel appearing for the appellee.

The argument upon the point upon which the court rested its decision consisted of an examination of the evidence bearing upon it, which it is not necessary to state.

Mr. Justice CATRON delivered the opinion of the court.

Henry Burden obtained a patent, in 1840, for a machine to make hook-headed spikes. He applied for the patent on the 18th of April, 1839. It was assigned to the Troy Iron and Nail Company, who filed a bill against the Odiornes, to enjoin them, and for an account for using a machine to

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make similar spikes; and which machine, it is alleged, infringed the monopoly secured to Burden by his patent of 1840. The case was brought to a hearing on the following stipulation:

"The defendants agree not to deny the validity of the complainants' patent, provided they make out their title to the said letters patent to be good.

"They also agree not to deny that the machine complained of in the complainants' bill is an infringement on the patent granted to H. Burden on August 4, 1840.

"If the complainants shall establish their title to the letters patent aforesaid, the proper decree may be entered for the complainants, unless the defendants shall prove that the spike-machine used by them, and complained of in the bill aforesaid, was constructed prior to the alleged application of H. Burden, made April 18, 1839, for letters patent therefor, according to the provisions of the statute of the United States, 1839, ch. 88, sec. 7; or was the result of an independent original invention, prior in time to the invention of the said Burden; in either of which cases, the proper decree shall be entered for defendants."

The only question presented for our consideration on the stipulation, is whether the machine employed by the appellees was constructed prior to the 18th of April, 1839, when Burden made application at the Patent Office for his patent.

The machine complained of was built by Richard Savary, for the Boston Iron Company, in the spring of 1839, and obtained by the appellees by assignment. Savary was the patentee of a machine to make ship and boat spikes, and, at the suggestion of the agents of the Boston Iron Company, added an attachment of an apparatus to make a hook-head to spikes; the process for making which Savary deposes he discovered in August, 1838. The time at which this apparatus was attached to the machine (substantially complete in its operative parts) is the time when the machine complained of was "constructed," in the sense of the stipulation, it not being necessary that the machine should be geared and doing work. We are satisfied that it was set

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up and substantially finished before the 18th of April, 1839, and therefore order the decree below to be affirmed.

ORDER. This cause came on to be heard on the transcript of the record from the Circuit Court of the United States for the District of Massachusetts, and was argued by counsel; on consideration whereof, it is now here ordered, adjudged, and decreed by this court, that the decree of the said Circuit Court in this cause be, and the same is hereby,

AFFIRMED WITH COSTS.

Patent in suit:

No. 1757. Burden, H. September 2, 1840. Spike making machine.

OTHER SUITS ON SAME PATENT:

Troy Iron & Nail Co. v. Corning, 1849. 1 Blatch. 467.

Troy Iron & Nail Co. v. Corning, 1869. 6 Blatch. 328; 3 Fish. 497.

Troy Iron & Nail Co. v. Corning, 1852. 14 How. 192 [5 Am. & Eng. 375].

Troy Iron & Nail Co. v. Winslow, 1874. 11 Blatch. 513; 1 B. & A. 98.

Syllabus.

JOSEPH BATTIN, PATENTEE, AND SAMUEL BATTIN, ASSIGNEE, PLAINTIFFS IN ERROR,
v. JAMES TAGGART, DEFENDANT IN ERROR.

SAME *v.* ROBERT RADCLIFFE, *et al.*, DEFENDANTS IN ERROR.

SAME *v.* JOHN G. HEWES, DEFENDANT IN ERROR.

17 How. 74-86. Dec., 1854.

[Bk. 15. L. ed. 37; 1 Whit. 969.]

Reversing in part *Ibid.*, 2 Wall., Jr., 101.

Reissue. Identity of original and reissued invention. Failure to claim in original no abandonment. Particular reissue considered. Delay in reissuing. Questions for Jury.

1. Where suit was brought on a reissue made nearly six years after the original patent, and claiming matter therein shown but not claimed, and the judge charged the jury that the failure to claim in the original the matter described, was a dedication of it to the public, and could not be revoked after it had passed into public use, either by reissue or otherwise. The instruction was held erroneous (p. 261).
2. Whether the defect be in the specifications, or in the claim under Act 1836, § 18, the patentee may surrender his patent, and by an amended specification or claim cure the defect (p. 262).
3. But a new and different invention cannot be claimed (p. 262).
4. By the defects provided for in the statute (Act 1836, § 18), nothing passes to the public from the specifications or claims within the scope of the patentee's invention (p. 262).
5. Where on reissue made six years subsequent to the original patent, the reissue, No. 142, J. Battin, Sept. 4, 1849, Coal Breaker, "described essentially the same machine as the former one did, but claimed as the thing invented the breaking apparatus only," whereas the original, No. 8292, Oct. 6, 1848,

Statement of the case.

claimed the breaking and screening apparatus, *held* that patentee had a right to do this; he had a right to restrict or enlarge his claim, so as to give it validity and effectuate his invention (p. 263).

6. It is the right of the jury to determine: whether the specifications, including the claim, were so precise as to enable any one skilled in the structure of machines to make the one described; the novelty of the invention; the identity of the invention in the original and renewed patent; the abandonment of the invention to the public (p. 264).

[Citations in the opinion of the Court:]

Battin v. Clayton, 2 Whar. Dig. 409, p. 261.

Grant v. Raymond, 6 Pet. 218 [4 Am. & Eng. 245], p. 262.

Shaw v. Cooper, 7 Pet. 292 [4 Am. & Eng. 286], p. 262.

Stimpson v. West Chester R. R. Co., 4 How. 380 [4 Am. & Eng. 398], p. 262.

IN error to the Circuit Court of the United States for the Eastern District of Pennsylvania.

The following is the statement of the facts in the case, as given by the counsel for the defendants:

On the 6th of October, 1843, Joseph Battin, alleging that he had "invented a new and useful machine for effecting simultaneously the breaking and screening of coal," received letters patent therefor.

The specification describes with equal particularity the breaking and the screening part of the machine; the former consisting of two iron rollers, revolving in opposite directions and armed with teeth, so that the teeth upon each shall stand opposite to the spaces formed by the teeth on the opposite roller; the latter consisting of an inclined screen with meshes of different sizes, suspended in such manner as to have a vibrating motion. The claim is as follows: "Having thus fully described the nature and operation of my machine for breaking and screening coal, what I claim as new therein, and desire to secure by letters patent, is the manner in which I have arranged and combined with each other the breaking rollers and the screen; the respective parts being formed and operating substantially as herein set forth and made known."

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January 20, 1844, a schedule of additional improvements by the patentee was annexed to said letters patent; the improvement consisting in a third or auxiliary roller placed above the two rollers as described in the original patent. This is described as an improvement "in the machine for effecting simultaneously the breaking and screening of coal," and it refers to the "original invention" as consisting "in the combination of the breaking and sifting apparatus with each other."

February 12, 1844, the patentee took out distinct letters patent for rollers of the kind described in the first patent of October 6, 1843. He alleges therein that in the said patent of October 6, 1843, "The manner of arranging and combining the toothed rollers was not made the subject of a claim, the said patent having been obtained for the combining of a roller breaking machine with a screen for separating the coal into different sizes required; but as the breaking rollers so formed, arranged and combined, are applicable to the ordinary cylinder breaking machine, when not used in combination with a screen; and as I have found by continued experiment that such rollers constitute a real improvement in any breaking machine, I have determined to secure to myself the benefit of such improvement in a distinct and separate patent therefor." He therefore makes claim to the rollers and takes out this patent therefor.

Suit was brought upon the patent of October 6, 1843, in the Circuit Court from which these proceedings have been brought up, and it was then decided by the Court that said patent was for the combination of the breaking and screening apparatus, and could not be supported or assailed by proof of the novelty or want of novelty of the parts. The patentee thereupon surrendered the patent of October 6, 1843, together with the additional improvement of January 20, 1844, and received a reissued patent dated September 4, 1849; and at the same time he surrendered the patent of February 12, 1844, which was canceled and not reissued.

The reissued patent described, but with greater prolixity, rollers similar to those described in the original patent of

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October 6, 1843 (and in the patent of February 12, 1844), and instead of claiming the combination of the breaking rollers and the screen for effecting simultaneously the breaking and screening of coal, claims "the arrangement of the teeth on the two rollers substantially as herein described, so that in their rotation, the teeth of one shall come opposite the space between the teeth of the other, with sufficient space between to hold lumps of the required size; the rollers being so combined by gearing as to make them rotate in opposite directions and with the required velocities to retain the relative position of the teeth of the two rollers as described."

This suit is brought for an alleged infringement of the reissued patent. Two trials were had, at first of which the plaintiff obtained a verdict; after a full argument a rule by the defendants for a new trial was made absolute by the Court, and on the second trial, verdict was found for defendant, to the judgment entered upon which this writ of error was taken.

(Reissued. 4 September, 1849.)

JOSEPH BATTIN,* Philadelphia, Pennsylvania, Letters Patent No. 3292, dated October 6, 1843. Extended for seven years from October 6, 1857.

The schedule referred to in these Letters Patent and making part of the same,—

To all whom it may concern:

Be it known that I, JOSEPH BATTIN, of the City of Philadelphia, in the State of Pennsylvania, have invented a new and useful machine for effecting simultaneously the breaking and screening of coal; and I do hereby declare that the following is a full and exact description thereof.

The breaking part of my machine consists of two rollers of cast-iron, the peripheries of which are provided with teeth so placed as that in the revolution of the rollers, the teeth upon each of them shall stand opposite to the spaces formed by two contiguous teeth on the opposite roller. These rollers are geared together in order to cause them to preserve the same relative positions. The coal to be

* Additional improvement added 20 January, 1844.

Statement of the case.

broken is to be thrown into a hopper above the rollers, which rollers revolve inwards towards the coal.

Below the rollers a long screen is suspended in such manner as that it may have a vibrating motion communicated to it endwise by means of revolving cams or wipers. Immediately under the rollers the screen is furnished with fine meshes, which allow the dust or minute particles only to pass through; next to this the meshes are larger, and through these the nut coal will pass; and this section is succeeded, in like manner, by a coarse screen, and so on to four, five, or more sizes. The screen is placed in an inclined position, and the coal, consequently, travels along it as it is made to vibrate, and is thereby assorted into different sizes.

The accompanying drawing is a perspective representation of the whole machine. A, A are the two cast-iron breaking rollers, and B the hopper into which the coal to be broken is thrown. C, C are the two gearing wheels affixed on the shafts of the rollers, and by which they are made to turn simultaneously and correctly. D is a fly-wheel to regulate the motion. E, E is the screen, which is sustained by the rods, F, F, which are attached by screw nuts, at their upper ends, to the rock shafts, G, G.

A cam or wiper shaft, H, crosses the frame of the machine and carries the cams or wipers, I. The shaft H is made to revolve by means of a pulley, J, driven by a band that passes around a pulley on the shaft of one of the iron rollers. The wipers act against a piece of metal projecting up from the screen frame. To cause the screen to act efficiently it ought to be made to strike against a suitable spring as it is thrown forward by the wipers. Between each of the screens a flat piece of metal, K, K, is interposed to separate the heaps of coal from each other. Motion may be communicated to the machine by any adequate power.

Having thus fully described the nature and operation of my machine for breaking and screening coal, what I claim as new therein, and desire to secure by Letters Patent, is the manner in which I have arranged and combined with each other the breaking rollers and the screen, the respective parts being formed and operating substantially as herein set forth and made known.

JOSEPH BATTIN.

Witnesses :

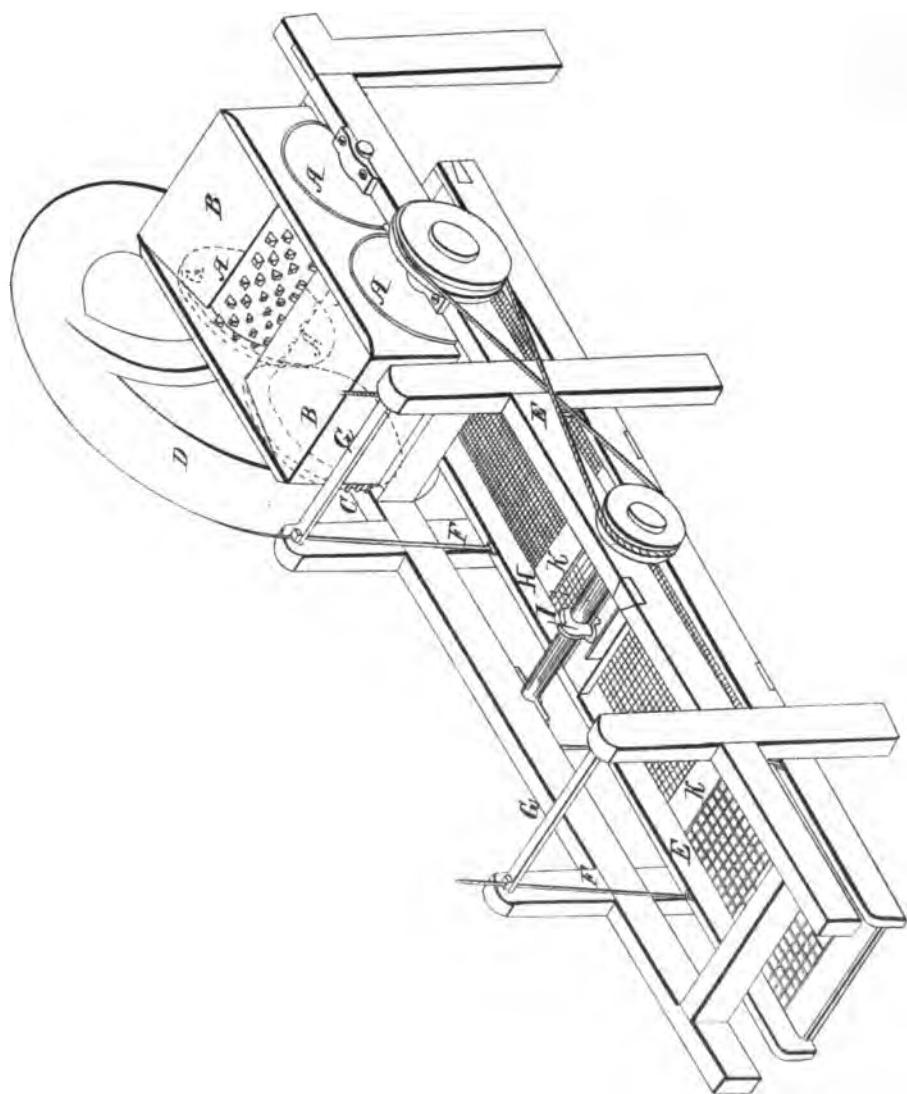
DAN CLARKE,
GEORGE ERETY.

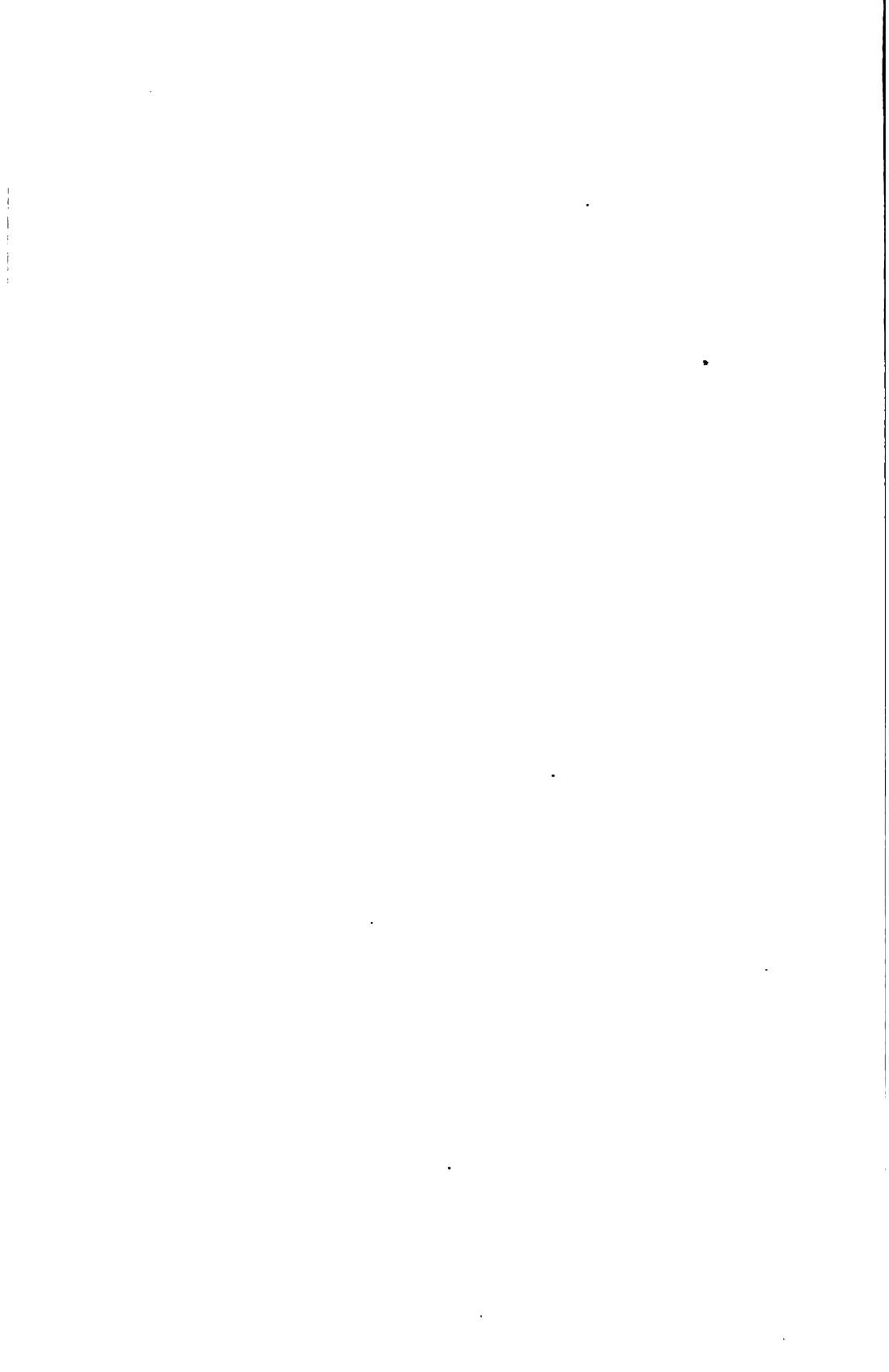
J. BATTIN.

Breaking and Screening Coal.

No. 3,292.

Patented Oct. 6, 1843.





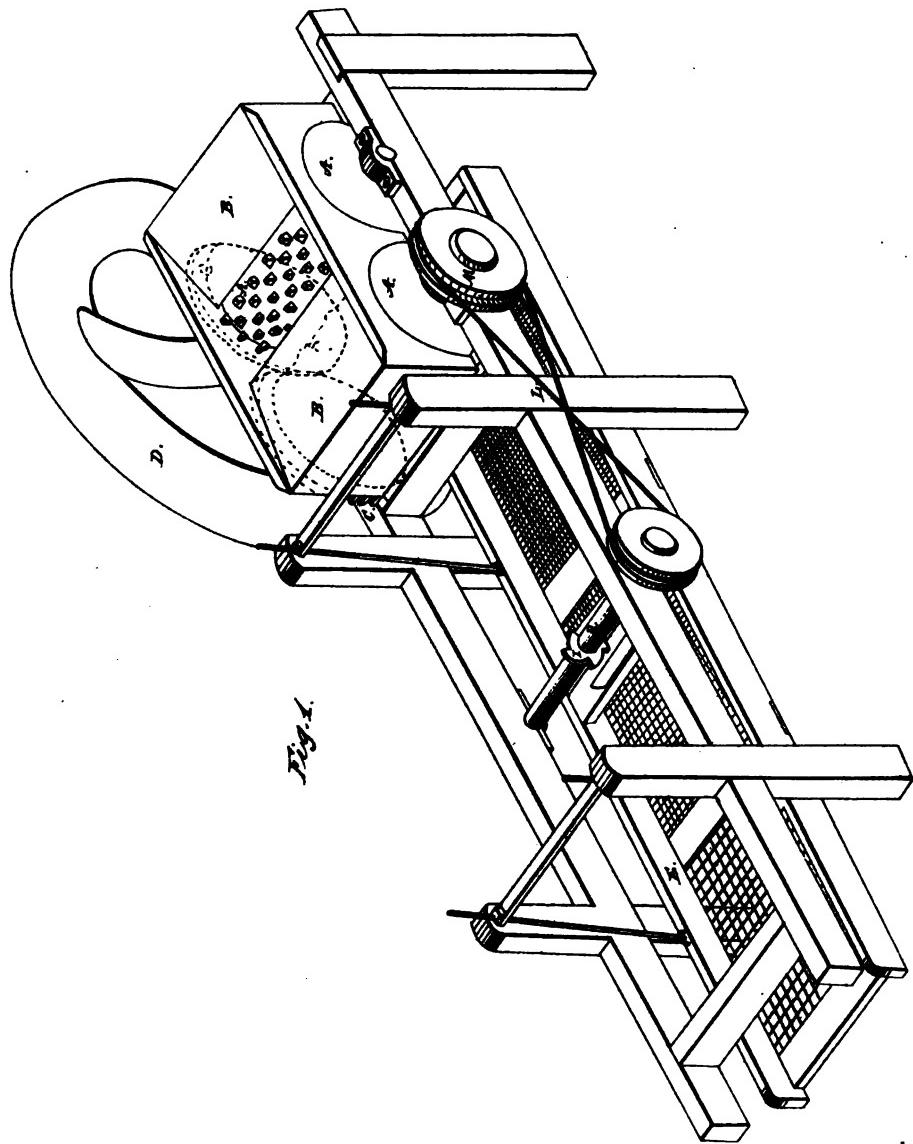
Sheet 1, 2 Sheets.

J. Battin.

Coal Breaker.

No 142.

Reissued Sept. 4, 1849.



J. Battin.

Street & 2 Sheets.

Coal Breaker.

77^e 142.

Reissued Sept. 4, 1849.

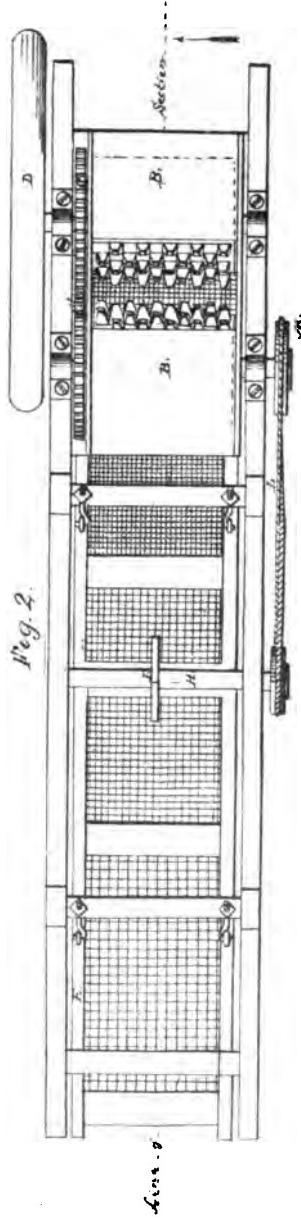


Fig. 2.

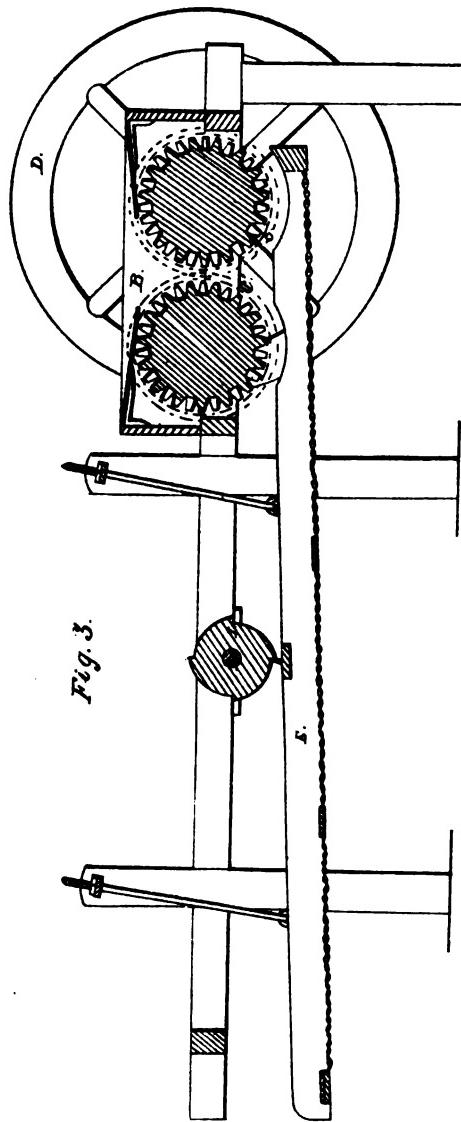


Fig. 3.



Statement of the case.

UNITED STATES PATENT OFFICE. JOSEPH BATTIN, OF PHILADELPHIA, PENNSYLVANIA. MACHINE, FOR BREAKING COAL. SPECIFICATION FORMING PART OF LETTERS PATENT No. 8,292, DATED OCTOBER 6, 1848; REISSUE No. 142, DATED SEPTEMBER 4, 1849.

To all whom it may concern:

Be it known that I, JOSEPH BATTIN, of the city and county of Philadelphia, and State of Pennsylvania, have invented new and useful improvements in the Machine for Breaking and Screening Coal, particularly anthracite; and I do hereby declare that the following is a full, clear, and exact description of the principle or character which distinguishes them from all other things before known, and of the manner of making, constructing, and using the same, reference being had to the accompanying drawings, making part of this specification, in which—

Figure 1 is a perspective view of the machine, and Fig. 2 is a plan and Fig. 3 a section.

The same letters indicate like parts in all the figures.

Anthracite coal, as taken from the mines, is generally in large lumps, which, for general consumption, require to be reduced into small lumps, the regularity in the size of the lumps being desirable, not only for convenience but for economy in burning, as the more regular the size of the lumps when of the size adapted to the grate the better the combustion.

Anthracite coal, for which the machine is chiefly intended, is very frangible, and when broken the fracture is irregular. If broken by percussion, the strength of the blow must not be great, or the whole will be reduced to powder, and if broken by pressure the moment the required separation has been effected the pressure must be withdrawn, or the mass will be pulverized.

The machines for crushing iron ore and stones, and grinding and crushing other substances used prior to my invention, when applied to the breaking of anthracite coal occasion waste by pulverization, and are not adapted to the peculiar nature of this material.

The object of my invention is to break this kind of coal in lumps of an approximately regular size and with little waste; and to these ends the principle or character of my invention for breaking coal into small lumps, and that which distinguishes it from all other machines before known for this or any analogous purpose, consists in combining together two rollers, the shafts of which are geared together to cause them to rotate in opposite directions with positive and equal motions when the peripheries of the said rollers are provided with teeth or projections so disposed or arranged that the teeth or projections on the one shall in the rotation come opposite

Statement of the case.

the spaces between the teeth or projections of the other, and *vice versa*, so that as the rollers rotate the teeth or projections on the rollers shall take the large lumps and break them into smaller lumps by making pressure on opposite sides thereof, but at points not coincident, and then by the continued rotation remove the pressure and liberate and discharge the broken pieces so soon as the desired effect has been produced.

The accompanying drawings represent the machine with a frame properly adapted to the purpose, but which may be varied at the pleasure of the constructor, and within the frame are arranged two parallel cast-iron rollers. The peripheries of these rollers are cast or otherwise formed with projections or teeth of a pyramidal form and arranged in rows running in the direction of helices, so that the space between any form contiguous teeth shall be a parallelogram with two of its angles in a line parallel with the axis and the other two at right angles thereto. The shafts of the two rollers are geared together by means of two cog-wheels, C C', that their peripheries shall rotate in opposite directions and with equal velocities, and their peripheries are placed at about a distance of three inches apart, more or less, according to the average size to which it is desired to break the coal. In this way the points of the teeth of one roller will in the rotation come opposite, and, if desired, enter for a short distance into the spaces between the teeth of the other, and *vice versa*; but the teeth of the two rollers never come into contact with each other. A hopper, B, may be placed above the space between the two rollers, with the lower aperture sufficient in capacity for the delivery to the rollers of the large lumps of coal as they come from the mine, and when properly broken by pressure between the rollers the products may drop or be received into a screen or sieve, E, which may be inclined from one end to the other, the upper end being so placed below the rollers as to catch all the coal. The surface of the screen should be made into three (more or less) divisions, the meshes of the second division being coarser than those of the first, and so on, increasing toward the lower end, which has the largest meshes. The requisite vibratory motion may be given to the screen by tappets I on a shaft, H, which receives motion by a band, L, from a pulley M, on the shaft of one of the breaking rollers. By this means as the broken coal falls on to the screen the particles pass through the meshes of the first division, those which are a little larger through the meshes of the second division, and so on to the end, the largest lumps being delivered at the end of the screen into an appropriate receptacle.

By the construction and arrangement of the breaking rollers it will be perceived that as they rotate the teeth constitute a series of

Statement of the case.

progressive levers, which act on opposite sides of the lumps, and, being placed so as not to coincide, snap or break the lumps between the points of pressure, this pressure gradually increasing until the separation is effected,—that is, during the rotation until the teeth reach a plane passing through the axis of the two rollers, and then the effect having been produced the teeth recede to liberate the lumps, and thus avoid the further reduction of the material. This mechanical action of the rotary teeth is thus adapted to the frangible or brittle nature of coal, which is readily pulverized when subjected to a continued percussion or pressing action.

It will be obvious from the foregoing that the form and size of the teeth may be greatly varied, as well as the space between the periphery of the two rollers, without changing the principle or mode of operation of my invention so long as the two rollers are geared together, and the teeth of one are in the rotation made to come opposite to or in the space between the teeth of the other, and *vice versa*, space sufficient to hold the required size of lumps of coal being left between the teeth of the two rollers when passing a plane which coincides with the axis of the two rollers.

What I claim, therefore, as my invention, and desire to secure by Letters Patent, is—

The arrangement of the teeth on the two rollers, substantially as herein described, so that in their rotation the teeth of one shall come opposite the spaces between the teeth of the other, with sufficient space between to hold lumps of the required size, the rollers being so combined by gearing as to make them rotate in opposite directions and with the required velocities to retain the relative position of the teeth of the two rollers, as described.

JOSEPH BATTIN.

Witnesses :

AMOS K. CARTER,
ALEX. PORTER BROWNE.

Messrs. C. M. Keeler and George M. Dallas, for the plaintiffs in error:

It is a presumption of law that an inventor does not design to dedicate his invention to the public, and his acts will be construed liberally to accord with such presumption.

Grant v. Raymond, 6 Pet. 243 [4 Am. & Eng. 245]; Woolwich on Ways, 4 Law Lib. 12.

Applying for, and obtaining letters patent is presumptive evidence of an intention on the part of the patentee to

Argument of counsel.

secure to himself the exclusive right of every part of such invention, *bona fide* invented by him.

Morris *v.* Huntingdon, 1 Paine 355; Grant *v.* Raymond, 6 Pet. 220 [4 Am. & Eng. 245]; Sloat *v.* Spring *et al.*, Harding 377; Shaw *v.* Cooper, 7 Pet. 315 [4 Am. & Eng. 286]; P. and T. R. R. Co. *v.* Stimpson, 14 Pet. 448 [4 Am. & Eng. 324].

The omission to claim a material part or element of an invention, fully described in letters patent, is not a dedication to the public, and the same may be subsequently covered by a reissue of such patent.

Stimpson *v.* Westchester R. R. Co., 4 How. 380—401 [4 Am. & Eng. 398]; act of July 4, 1836, section 13; 5 Stal. 117.

The Court erred in determining judicially by the construction of the surrendered and canceled patents, that the reissued patent of September, 1849, is not for the same invention intended to have been patented by the patent of October, 1843, instead of submitting the question, as matter of fact, to be determined by the jury.

The surrender and reissue of letters patent for amendment of errors was recognized as a common law right before the enactment of any statute on the subject.

Morris *v.* Huntington, 1 Paine 355; Grant *v.* Raymond, 6 Pet. 220 [4 Am. & Eng. 245]; Shaw *v.* Cooper, 7 Pet. 292—314 [4 Am. & Eng. 286].

These authorities hold that in the exercise of this common law right, the reissue reverts back to the date of the original from which it emanates.

See, also, Woodworth *v.* Stone, 3 Story 749; Allen *v.* Blunt, 3 Story 742; Woodworth *v.* Hall, 1 Wood & M. 248.

The court erred in ruling, as matter of law, that the patentee had dedicated or abandoned his invention to the public, instead of submitting it, as a question of fact, to be determined by the jury.

P. & T. R. R. Co. *v.* Stimpson, 14 Pet., 458 [4 Am. & Eng. 324]; Stimpson *v.* Westchester R. R. Co., 4 How. 380—401 [4 Am. & Eng. 398]; Sloat *v.* Spring *et al.*, Harding, 369, 377.

Argument of counsel.

Messrs. Garrick, Mallery, and Furman Sheppard, for the defendants in error:

If the patentee described the rollers and the screen, but did not claim them, it was a waiver of his right (if any he had) therein, as inventor, and an abandonment of them, by operation of law, to public use.

It is a publication of the invention and in the most effectual manner, and not being claimed, they constitute no part of the patent privilege, and are not protected by the patent.

Even where it is conceded that novel features are described in the specification, courts refuse to extend the privilege of the patent to such features, unless they are claimed by the patentee.

Bramah v. Hardcastle, Holroyd on Patents, *Saunders v. Aston*, 3 Barn & A. 886 [1 Am. & Eng. 466]. See also, *Cornish v. Keen*, Webb's Pat. Cas. 510 [2 Am. & Eng. 139]; *Huddart v. Grimshaw*, Webb's Pat. Cas. 86 [1 Am. & Eng. 128]; *Lewis v. Marling*, 4 C. & P. 52 [1 Am. & Eng. 417]; *Pennock v. Dialogue*, 2 Pet. 1 [4 Am. & Eng. 217]; *Shaw v. Cooper*, 7 Pet. 292 [4 Am. & Eng. 286]; *Pennock v. Dialogue*, 2 Pet. 1 [4 Am. & Eng. 217]; *Whittemore v. Cutter*, 1 Gall. 482; *Mellus v. Silsbee*, 4 Mason, 108; *Wood v. Zimmer*, Holt. N. P. 60 [1 Am. & Eng. 202]; *Wilson v. Rousseau*, 4 How. 674 [4 Am. & Eng. 436]; *Gayler v. Wilder*, 10 How. 491 [5 Am. & Eng. 188]; *Wheaton v. Peters*, 8 Pet. 591; *Dudley v. Mayhew*, 3 Comstock 9.

And if the patentee, by describing the rollers, without claiming them, allowed them to go into public use, with a waiver of his rights, if he had any, it is submitted that he cannot, in 1849, reclaim the rollers.

The want of sameness is evident on the face of the patents, and the repugnancy is manifest upon inspection and comparison.

It is submitted that a pair of breaking rollers with peculiarly arranged teeth is a different thing from the combination of "the roller breaking machine with a screen for separating the coal into the different sizes required;" that they

Opinion of the court.

are mechanically distinct machines, different inventions—constituting distinct patentable subject matter.

The reissued patent is not a corrected description and specification of the manner in which the patentee arranged and combined with each other the breaking rollers and the screen ; it is not for the combination at all, in any shape, but it is for something else ; the arrangement of the teeth on the two rollers. It is a change in the essential character of the claim itself—a substitution of one thing for another, and not an amended description of the same thing.

Mr. Justice MCLEAN delivered the opinion of the court :

This case is before us on a writ of error, to the Circuit Court for the Eastern District of Pennsylvania.

The action was brought for the infringement of a patent. The jury, under the instructions of the court, found a verdict for the defendant. Exceptions were taken to the rulings of the court, which present the points of law for consideration.

On the 6th of October, 1843, Joseph Battin obtained a patent for the invention of a new and useful improvement in the machine for breaking and screening coal.

After describing the different parts of the machine, he sums up by saying : having thus fully described the nature, and operation of my machine for breaking and screening coal, what I claim as new therein, and desire to secure by letters patent, is the manner in which I have arranged and combined with each other the breaking rollers and the screen ; the respective parts being formed and operating substantially as herein set forth and made known.

An improvement to the above machine, by adding an auxiliary roller, was patented to Battin, 20th January, 1844. And on the 12th of February, 1844, another patent was granted to him, for a new and useful improvement in the machine for breaking coal.

In his specification, he says that he had made a new and useful improvement, in the manner of combining and arranging the toothed rollers used in the machine for breaking coal, which rollers, as combined and arranged by me, are

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described as follows: In the specification attached to letters patent for a machine for the effecting simultaneously the breaking and screening of coal, granted to me under date of the 6th day of October, 1843. The breaking part of my machine consists of two rollers of cast iron, the peripheries of which are provided with teeth, so placed as that, in the revolution of the rollers, the teeth of each of them shall stand opposite to the spaces formed by two contiguous teeth on the opposite roller. These rollers are geared together, in order to preserve the same relative position.

In the above-named letters he says, the manner of arranging and combining the toothed rollers was^a made the subject of a claim, the said patent having been obtained for the combining of a roller breaking machine with a screen for separating the coal into the different sizes required; but as the breaking rollers, so formed and arranged, and combined, are applicable to the ordinary cylinder breaking machine, when not used in combination with a screen; and as I have found, by continued experiment, that such rollers constitute a real improvement in any breaking machine, I have determined to secure to myself the benefit of such improvement in a distinct and separate patent therefor. Rollers for the breaking of stone, of ores, of coal, of corn, and of other substances have been frequently constructed, and are well known, etc.

And, he adds, having thus fully described the nature of my improvement, in the manner of combining and arranging the toothed rollers used in the machine for breaking coal, what I claim therein as new, and desire to secure by letters patent is, the so forming and gearing of such rollers, as that the teeth of one of them shall always be opposite to a space between the teeth in the other, whenever they are operating upon the article to be broken; the same being effected substantially in the manner herein set forth.

And afterwards, on the 4th of September, 1849, the said Joseph Battin obtained a patent, in which it is stated that

^a Howard inserts "not."

Opinion of the court.

he had invented a new and useful machine for breaking coal, for which letters patent were granted to him, dated October 6, 1843, to which was added an additional improvement, dated 20th January, 1844, and said letters having been surrendered by him, the same have been cancelled, and new letters patent have been ordered to issue to him, on an amended specification. He also surrendered the patent granted to him the 12th of February, 1844, for an improved machine for breaking coal, which patent is hereby cancelled, but not reissued, &c.

After describing the invention, he sums up by saying: "What I claim, therefore, as my invention, and desire to receive^b by letters patent, is the arrangement of the teeth on the two rollers substantially as herein described, so that in their relation the teeth of one shall come opposite the spaces, between the teeth of the other, with sufficient space between to hold lumps of the required size, the rollers being so combined in gearing as to make them rotate in opposite directions, and, with the required velocities, to retain the relative position of the teeth of the two rollers as described."

In the sixth section of the patent act of 1836, it is declared that, "before any inventor shall receive a patent he shall deliver a written description of his invention, in such full, clear, and exact terms as to enable any person skilled in the art or science to which it appertains, to make and construct the same; and in case of any machine, he shall fully explain the principle, and the several modes of the application of the machine, so that it may be distinguished from other inventions; and shall particularly specify and point out the part, improvement, or combination, which he claims as his own invention or discovery."

And by the thirteenth section of the same act it is provided, "that when a patent shall be inoperative or invalid by reason of a defective or insufficient description or specification, or by reason of the patentee claiming in his specification, as his own invention, more than he had or shall

^b Howard substitutes "secure (receive, sic.)".

Opinion of the court.

have a right to claim as new, if the error has or shall have arisen by inadvertency, accident, or mistake, and without any fraudulent or deceptive intention, it shall be lawful for the commissioner, upon the surrender to him of such patent, &c., to cause a new patent to be issued to the said inventor for the same invention, for the residue of the period then unexpired, for which the original patent was granted, in accordance with the patentee's corrected description and specification. And the patent so issued shall have the same effect and operation in law on the trial of all actions hereafter commenced, for causes subsequently accruing, as though the same had been originally filed in such corrected form before the issuing of the original patent."

In his charge to the jury, the district judge said: "The case of Battin *v.* Clayton (2 Whar. Dig. 409), which was before us some time ago, grew out of an alleged infraction of this patent of 1843. We held, on the trial of that case, that the patent being merely for the combination of machinery, it could neither be supported nor assailed by proof of the novelty, or want of novelty, of the parts. The patent was thereupon surrendered, and a new one issued, on the 4th of September, 1849, under an amended specification, which described essentially the same machine as the former one did, but claimed, as the thing invented, the breaking apparatus only."

And he remarks: "It is said that the present defendants are using the apparatus described in this reissued patent, and that they should be mulcted in damages, accordingly." But there are two legal positions, of a general character, which appear to me to bar the plaintiff's right of recovery. They are these:

1. That a description by the applicant for a patent of a machine or a part of a machine, in his specification, unaccompanied by notice that he has rights in it as inventor, or that he desires to secure title to it as patentee, is a dedication of it to the public.

2. That such a dedication cannot be revoked, after the machine has passed into public use, either by surrender and reissue, or otherwise."

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The above instructions, we think, were erroneous.

Whether the defect be in the specifications or in the claim, under the thirteenth section above cited, the patentee may surrender his patent, and by an amended specification or claim, cure the defect. The reissued patent must be for the same invention, substantially, though it be described in terms more precise and accurate, than in the first patent. Under such circumstances, a new and different invention cannot be claimed. But where the specification or claim is made so vaguely as to be inoperative and invalid, yet an amendment may give to it validity, and protect the rights of the patentee against all subsequent infringements.

So strongly was this remedy of the patentee recommended, by a sense of justice and of policy, that this court, in the case of *Grant v. Raymond*, 6 Pet., 218 [4 Am. & Eng. 245], sustained a reissued and corrected patent before any legislative provision was made on the subject. In that case, the Chief Justice said: "It will not be pretended that this question is free from difficulty. But the Executive Departments, it is understood, have acted on the construction adopted by the circuit court, and have considered it as settled. We would not willingly disregard the settled practice, in a case where we are not satisfied it is contrary to law and where we are satisfied it is required by justice and good faith." The same principle was sanctioned in the case of *Shaw v. Cooper*, 7 Pet., 310 [4 Am. & Eng. 286].

How much stronger is a case under the statute, which secures the rights of the patentee by a surrender, and declares the effect of the reissued and corrected patent. By the defects provided for in the statute, nothing passes to the public from the specifications or claims, within the scope of the patentee's invention. And this may be ascertained by the language he uses.

In the case of *Stimpson v. The West Chester Railroad Co.*, 4 How. 380 [4 Am. & Eng. 398], it was held, that "where a defective patent had been surrendered, and a new one taken out, and the patentee brought an action for a violation of his patent right, laying the infringement at a date subsequent to that of the reissued patent, proof of the use

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of the thing patented, during the interval between the original and renewed patents, will not defeat the action." In the same case it was also held, that the proceeding before the commissioner, in the surrender and reissue of a patent, is not open for investigation except on the ground of fraud.

The patent of 1843 was not surrendered on the obtainment of the patent of 1844. That was intended to be a new invention of arranging and combining the toothed rollers, which, the patentee says, was not made the subject of a claim in the patent of 1843. The patent of 1844 was cancelled, but not reissued, when the patent of 1849 was issued. At that time, the patent of 1843, and the improvement thereon, dated January 20, 1844, were surrendered and cancelled, and new letters patent were issued on an amended specification.

The cause of the surrender of the patent of 1843, as stated in the charge to the jury, was the ruling of the court in the case of Battin v. Clayton (2 Whar. Dig. 409), and that the amended patent of 1849 was consequently obtained. That ruling is not now before us, nor is it necessary to inquire whether the patent of 1843, on the specifications and claim, was sustainable. The plaintiff, by a surrender of that patent, and the procurement of the patent of 1849, with amended specifications, abandoned his first patent and relied wholly on the one reissued. The claim and specifications in this patent, as amendatory of the first, were within the thirteenth section of the act of 1836. It is said with entire accuracy in the charge, in regard to the amended specification of the patent of 1849, that it "described essentially the same machine as the former one did, but claimed, as the thing invented, the breaking apparatus only." And this the patentee had a right to do. He had a right to restrict or enlarge his claim, so as to give it validity and to effectuate his invention.

In the argument, the counsel very properly considered the patent of 1844, as not in the case. It was designed to secure a new combination, not included in the first patent, and as the patent of 1844 was surrendered and cancelled and not reissued, it being equally disconnected with the

Notes and Citations.

patent of 1843, and the reissued and corrected patent of 1849, it can have no effect on the claim of the plaintiff.

We think the court also erred in saying to the jury, "We instruct you that your verdict, in each case, must be for the defendants."

This, as well as the two instructions above noted, took from the jury, facts which it was their province to examine and determine. It was the right of the jury to determine from the facts in the case whether the specifications, including the claim, were so precise as to enable any person skilled in the structure of machines, to make the one described. This the statute requires, and of this the jury are to judge.

The jury are also to judge of the novelty of the invention, and whether the renewed patent is for the same invention as the original patent; and they are to determine whether the invention has been abandoned to the public. There are other questions of fact which come within the province of a jury, such as the identity of the machine used by the defendant with that of the plaintiff's, or whether they have been constructed and act on the same principle.

The judgment is reversed, and the cause is remanded to the circuit court, for further proceedings.^c

Notes:**1. Failure to claim as an abandonment.**

Suffolk Co. v. Hayden, 3 Wall. 315.

Keystone Bridge Co. v. Phoenix Iron Works, 95 U. S. 274.

Miller v. Brass Co., 104 U. S. 350.

Mathews v. Boston Machine Co., 105 U. S. 54.

Eames v. Andrews, 122 U. S. 40.

Parker & Whipple v. Yale Clock Co., 128 U. S. 87.

^c Howard adds, "Judgment reversed and cause remanded."

Notes and Citations.

Abandonment by implication where there is delay in reissuing:

- Miller *v.* Brass Co., 104 U. S. 350.
James *v.* Campbell, 104 U. S. 356.
Mathews *v.* Boston Machine Co., 105 U. S. 54.
Bantz *v.* Frantz, 105 U. S. 160.
Johnson *v.* Railroad Co., 105 U. S. 539.
Clements *v.* Odorless Co., 109 U. S. 641.
Turner, etc., Manufacturing Co., *v.* Dover, 111 U. S. 319.
Mahn *v.* Harwood, 112 U. S. 354.
Wollensak *v.* Reiher, 115 U. S. 96.
Yale Lock, etc. Co., *v.* Sargent, 117 U. S. 536.
White *v.* Dunbar, 119 U. S. 47.
Newton *v.* Furst & Bradley Mfg. Co., 119 U. S. 373.
Ives *v.* Sargent, 119 U. S. 652.
Hartshorn *v.* Saginaw Barrel Co., 119 U. S. 664.
Matthews *v.* Iron Clad Mfg. Co., 124 U. S. 347.
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Reissue for matter disclaimed or rejected with patentee's acquiescence, invalid,

- Leggett *v.* Avery, 101 U. S. 256.
Goodyear D. V. Co. *v.* Davis, 102 U. S. 222.
Beecher *v.* Atwater Mfg. Co., 114 U. S. 523, and see
Eames *v.* Andrews, 122 U. S. 40.
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Reissue where adverse rights have accrued between date of original and reissue.

- Grant *v.* Raymond, 6 Pet. 218 [4 Am. & Eng. 245].
Stimpson *v.* R. R. Co., 4 How. 380 [4 Am. & Eng. 398].
James *v.* Campbell, 104 U. S. 356.
Clements *v.* Odorless Co., 109 U. S. 641.
Torrent Arms and Lumber Co., *v.* Rodgers, 112 U. S. 659.
Brown *v.* Davis, 116 U. S. 237.

Notes and Citations.

White *v.* Dunbar, 119 U. S. 47.

Newton *v.* Furst & Bradley Mfg. Co., 119 U. S. 373.

2. Act 1832, § 3; Act 1836, § 13; Act 1837, §§ 5 and 8;
Act 1870, § 53; R. S. 4916.

3. Reissue must be for same invention as original.

Seymour *v.* Osborne, 11 Wall. 516.

Gill *v.* Wells, 22 Wall. 1.

Corn Planter Patent, 23 Wall. 181.

Marsh *v.* Seymour, 97 U. S. 348.

Original patent in evidence on the question of identity.

Eureka Co. *v.* Bailey Co., 11 Wall. 488.

Seymour *v.* Osborne, 11 Wall. 516.

Russell *v.* Dodge, 93 U. S. 460.

Smith *v.* Goodyear D. V. Co., 93 U. S. 486.

Bates *v.* Coe, 98 U. S. 31.

Ball *v.* Langles, 102 U. S. 128.

Clark *v.* Wooster, 119 U. S. 322.

Identity of reissue and original a question for jury.

Stimpson *v.* Railroad, 4 How. 380 [4 Am. & Eng. 398].

Notes and Citations.

Reissues void for want of identity.

Collar Co. v. Van Deusen, 23 Wall. 580.

Wood Paper Patent, 23 Wall. 566.

Russell v. Dodge, 93 U. S. 460.

Powder Co. v. Powder Works, 98 U. S. 126.

Ball v. Langles, 102 U. S. 128.

Heald v. Rice, 104 U. S. 737.

Mathews v. Boston Machine Co., 105 U. S. 54.

Bantz v. Frantz, 105 U. S. 160.

Clements v. Odorless Co., 109 U. S. 641.

McMurray v. Mallory, 111 U. S. 97.

Eagleton v. West Bradley Co., 111 U. S. 490.

Torrent Arms Co. v. Rodgers, 112 U. S. 659.

Eachus v. Broomall, 115 U. S. 429.

Hartshorn v. Saginaw Barrel Co. 119 U. S. 664.

Worden v. Searls, 121 U. S. 14.

Parker & Whipple Co. v. Yale Clock Co., 123 U. S. 87.

4. See note 1 above.

5. Enlarged claims, when allowable in reissue.

Rubber Co. v. Goodyear D. V. Co., 9 Wall. 788.

Russell v. Dodge, 93 U. S. 460.

Miller v. Brass Co., 104 U. S. 350.

Eames v. Andrews, 122 U. S. 40.

Permissible variation on reissue.

O'Reilly v. Morse, 15 How. 62 [5 Am. & Eng. 483].

Russell v. Dodge, 93 U. S. 460.

Eames v. Andrews, 122 U. S. 40.

Notes and Citations.

Expanded reissue claims condemned.

- Burr *v.* Duryee, 1 Wall. 531.
Case *v.* Brown, 2 Wall. 320.
Carlton *v.* Bokee, 17 Wall. 463.
Swain Mfg. Co. *v.* Ladd, 102 U. S. 408.
Miller *v.* Brass Co., 104 U. S. 350.
James *v.* Campbell, 104 U. S. 356.
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Reissue claims broader than original void.

- Hopkins, etc., Mfg. Co. *v.* Corbin, 103 U. S. 786.
Miller *v.* Brass Co., 104 U. S. 350.
Mathews *v.* Boston Machine Co., 105 U. S. 54.
Moffitt *v.* Rogers, 106 U. S. 423.
Gage *v.* Herring, 107 U. S. 640.
Clements *v.* Odorless Co., 109 U. S. 641.
McMurray *v.* Mallory, 111 U. S. 97.
Turner & Seymour Mfg. Co. *v.* Dover, 111 U. S. 319.
Wollensak *v.* Reiher, 115 U. S. 96.
White *v.* Dunbar, 119 U. S. 47.
Ives *v.* Sargent, 119 U. S. 652.
Worden *v.* Searls, 121 U. S. 14.
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Reissue limited in order to be sustained.

- Swain Mfg. Co. *v.* Ladd, 102 U. S. 408.
James *v.* Campbell, 104 U. S. 356.
Gosling *v.* Roberts, 106 U. S. 39.
Cochrane *v.* Anilin, etc., 111 U. S. 298.
Brown *v.* Davis, 116 U. S. 237.
See also Wing *v.* Anthony, 106 U. S. 142.
Hoffheins *v.* Russell, 107 U. S. 182.
Gardner *v.* Herz, 118 U. S. 180.
Crawford *v.* Heysinger, 123 U. S. 589.
Matthews *v.* Iron Clad Mfg. Co., 124 U. S. 347.

Notes and Citations.

Patent in suit:

No. 3292. Battin, J., Oct. 6, 1843. Coal Breaker.
Reissue No. 142, Sept. 4, 1849.

OTHER SUITS ON SAME PATENT:

Battin v. Taggart, 1851. 2 Wall., Jr., 101.
Battin v. Silliman, 1855. 3 Wall., Jr., 124.

Cited:**IN SUPREME COURT OF UNITED STATES:**

Providence Rubber Co. v. Goodyear, 1870. 9 Wall. 788; Bk. 19,
L. ed. 566.
Seymour v. Osborne, 1870. 11 Wall. 516; Bk. 20, L. ed. 33.
Heald v. Rice, 1882. 104 U. S. 737; Bk. 26, L. ed. 910.

IN CIRCUIT COURT:

Crocker. Ms. D. C.
French v. Rogers, November, 1851. 1 Fish. 133.
Hussey v. McCormick, September, 1859. 1 Biss. 300; 1 Fish.
509.
Laidley v. James, April, 1860. Ms. D. C.
Atkins v. Singer, June, 1860. Ms. D. C.
In re Ball, June, 1860. Ms. D. C.
Ex parte Dyson, September, 1860. Ms. D. C.
Cahoon v. Ring, April, 1861. 1 Cliff. 592.
Peppenhusen v. Falke, June, 1861. 4 Blatch. 493; 2 Fish. 181.
Arnold v. Chittenden, January, 1863. Ms. D. C.
Arnold & Arnold v. Chittenden, January, 1863. Ms. D. C.
Hussey v. Bradley, March, 1863. 5 Blatch. 134; 2 Fish. 362.
Sickles v. Evans, October, 1863. 2 Cliff. 203; 2 Fish. 417.
Goodyear v. Providence Rubber Co., November, 1864. 2 Cliff.
351; 2 Fish. 499.

Notes and Citations.

- Forbes *v.* Barstow Stove Co., November, 1864. 2 Cliff. 379.
Whitely *v.* Swayne, February, 1865. 4 Fish. 117.
Cahart *v.* Austin, May, 1865. 2 Cliff. 528; 2 Fish. 543.
Morris *v.* Royer, March, 1867. 2 Bond 66; 3 Fish. 176.
Hofheins *v.* Brandt, July, 1867. 3 Fish. 218.
Crompton *v.* Belknap Mills, May, 1869. 3 Fish. 536.
Woodward *v.* Dinsmore, February, 1870. 4 Fish. 163.
Jordan *v.* Dobson, September, 1870. 2 Abb. 398; 4 Fish. 232.
Chicago Fruit House Co. *v.* Busch, March, 1871. 2 Biss. 472;
4 Fish. 395.
Parham *v.* American Buttonhole, Overseaming and Sewing Machine
Co., April, 1871. 4 Fish. 468; 1 Leg. Gaz. Rep. 145.
Bridge *v.* Brown, April, 1871. 1 Holmes 58; 6 Fish. 236.
Penn. Salt Mfng. Co. *v.* Thomas, October, 1871. 5 Fish. 148;
8 Phila. R. 144; 1 Leg. Gaz. R. 275.
Aultman *v.* Holley, Oct. 1873. 11 Blatch. 317; 6 Fish. 534.
Milligan & Higgins Glue Co. *v.* Upton, October, 1874. 4 Cliff.
237; 1 Ban. & Ard. 497.
Calkins *v.* Bertraud, December, 1875. 6 Biss. 494; 2 Ban. &
Ard. 215.
Miller & Peters Mfng. Co. *v.* Du Brul, May, 1877. 2 Ban. &
Ard. 618; 12 O. G. 351.
Herring *v.* Nelson, September, 1877. 14 Blatch. 293; 3 Ban. &
Ard. 55; 12 O. G. 758.
Atwood *v.* The Portland Co., July, 1880. 10 Fed. Rep. 283; 5
Ban. & Ard. 533.
Wilson *v.* Coon, December, 1880. 18 Blatch. 532; 6 Fed. Rep.
611; 19 O. G. 482.
Smith *v.* Merriam, January, 1881. 6 Fed. Rep. 713; 19 O. G.
601.
Kells *v.* McKenzie, November, 1881. 9 Fed. Rep. 284; 20 O. G.
1663.
Vermont Farm Machine Co. *v.* Marble, January, 1884. 19 Fed.
Rep. 307; 27 O. G. 621.
Railway Register Mfng. Co. *v.* Broadway & 7th Ave. R. Co., Feb-
ruary, 1886. 26 Fed. Rep. 522.

Notes and Citations.

IN DECISIONS OF COMMISSIONERS OF PATENTS:

Doty *v.* Osborne & Ballard, September, 1869. C. D., 1869, p. 77.
Edward Strain, November, 1870. C. D., 1870, p. 150.

IN STATE COURTS:

Hawkes *v.* Remington, November, 1872. 111 Mass. 171.

IN CANADIAN COURTS:

Withrow *v.* Malcom, September, 1882. 6 Ontario Rep. 12.

IN TEXT BOOKS:

2 Abb. Pat. Law, 1886, pp. 189, 199, 205, 337.
Walker on Pats., 1883, pp. 50, 59, 68, 70, 129, 155, 164, 176.
Curtis on Pats., 4th ed. §§ 281, 395 a.

Syllabus.

ISRAEL KINSMAN AND CALVIN L. GODDARD,
APPELLANTS, v. STEPHEN R. PARKHURST.

18 How. 289-295. Dec., 1855.

[Bk. 15, L. ed. 385; 1 Whit. 997.]

*Joint owners. Copartnership. Assignee with notice.
Objections to Master's report.*

1. Where defendants (partners of complainants) had actually received profits from the sales of the patented machines, which profits they did not show to have been, or to be, in any way liable to be affected by the invalidity of the patent, *held* in view of a certain agreement between defendants and complainants, that the invalidity of the patent was immaterial, and no bar to complainant's right to an account (p. 276).
2. Where defendants (partners of complainants) had made and sold patented machines under complainant's title and for his account, *held* that they were estopped from alleging the invalidity of complainants' patent (p. 277).
3. A copartnership agreement between two joint owners of letters patent for the manufacture and sale of the patented machines, stipulating that one of them should conduct the business alone is not a contract in restraint of trade (p. 278).
4. *Held* that the defendant, partner and joint owner with complainant respecting a patent right, could not secretly acquire and set up an outstanding right against his joint owner (p. 278).
5. Assignee who purchased *pendente lite*, and, with actual knowledge of the suit, is bound by the same equities as his assignor (p. 278).
6. Exceptions to master's report should be taken in the court below; it is too late to object to it here for the first time (p. 278).

[Citations in the opinion of the Court:]

Sharp v. Taylor, 2 Phil. ch. 801, p. 277.*Tenant v. Elliott*, 1 B. & P. 3, p. 277.*McBlair v. Gibbes*, 17 How. 286, p. 277.*Bartlett v. Holbrook*, 1 Gray 114, p. 277.*Wilder v. Adams*, 2 Wood. & M. 329, p. 277.

Opinion of the court.

APPEAL from the Circuit Court of the United States for the Southern District of New York.

The bill in this case was filed in the Circuit Court of the United States for the Southern District of New York by the appellee.

The court below found for the complainant, and entered a final decree for \$23,220.28 and costs. The defendants brought the case here on appeal.

A further statement appears in the opinion of the court.

Messrs. Kellar and Platt for appellants.

Mr. George Gifford for the appellees.

Mr. Justice CURTIS delivered the opinion of the court:

This is an appeal from a decree of the Circuit Court of the United States for the Southern District of New York, in a suit in equity brought by the appellee, Parkhurst, against the appellants. The bill states, and the proofs show, that Parkhurst, being the owner of the letters patent for improvements in the machine for ginning cotton and wool, on the 22d of May, 1845, entered into a written agreement with Kinsman, the substance of which was, that Parkhurst was to be the owner of two-thirds, and Kinsman of one-third, of the letters patent; that the business of manufacturing and selling the patented machines should be carried on by the parties on their joint account, in the proportions of two-thirds and one-third, Kinsman giving his personal attention to the business, and advancing a sum not exceeding \$1,000 for the purchase of machinery, stock, &c., for which advance he was to be repaid out of the first profits of the business. Kinsman was to pay Parkhurst \$2,000 in cash, and give his note for \$1,000, payable in sixty days. Under this agreement the manufacture and sales of the machines were begun and carried on until the 9th day of February, 1846, at which time the parties entered into a new agreement, the substantial part of which was as follows:

"Whereas, the party of the first part has advanced moneys, and become responsible for various sums of money which have been expended in getting up machinery and

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tools and stock, &c., for the manufacture of burning and carding machines, which were invented by the said Parkhurst; one-third part of which he sold and assigned to the party of the first part: Now, therefore, the party of the first part, in consideration of \$1 in hand paid by the party of the second part, the receipt whereof is hereby acknowledged, hereby covenants and agrees that, as soon as the profits which have accrued, and which may hereafter arise, from the manufacture and sale of the said machines so invented by the party of the second part, and so made and sold by the party of the first part, shall be sufficient to pay all legal demands for the purchase of machinery, tools, &c., &c., and other expenses incurred by said party of the first part, then he, the said party of the first part shall and will discontinue the manufacture and sale of said machines, invented as aforesaid, and that all machines which he shall manufacture and sell after this date should not be sold for a less profit than \$100 each, and that he will be accountable for 100 dollars profit on each and every machine made and sold from this day, unless he has the written consent of the party of the second part to sell at a less price."

"The party of the second part, in consideration of \$1 to him in hand paid by the party of the first part, the receipt whereof is hereby acknowledged, and also in consideration of the agreements aforesaid, hereby covenants and agrees with the party of the first part, that he will go on and manufacture the machines aforesaid as soon as the party of the first part discontinues the same, and that he will not sell any machine for a less profit than \$100, without the written consent of the party of the first part, and that he will pay over to the party of the first part one-third part and share of the said profits upon all machines which he makes and sells hereafter; and that, for any machines which he may manufacture, or have manufactured, before the discontinuing of the building of the same by the party of the first part, shall be subject to the same restrictions of selling for at least \$100 profit on each machine, one-third of which shall be paid to the party of the first part."

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The original and supplemental bills aver that under this agreement Kinsman prosecuted the business, and not only reimbursed himself for the cost of the machinery, tools, &c., and all his other advances, but, in violation of his agreement, continued the manufacture and sale of the machines so as to receive large profits, of which it prays an account, and also an injunction to restrain the further making or vending of the machines in violation of the agreement. A temporary injunction was applied for and obtained on the 3d day of July, 1847. On the 29th day of June, 1847, Kinsman made a transfer to the appellant, Goddard, who was then a clerk in his employment, of the tools, stock, &c., used in the manufacture; and after Kinsman was enjoined, the business was carried on in Goddard's name. A supplemental bill was then filed, making Goddard a party, charging him with notice of all the complainant's rights at the time of the transfer to him, alleging the transfer itself to have been only colorable, and praying an account and decree as against him and Kinsman. The Circuit Court made an interlocutory decree, declaring Parkhurst's right to an account, referring the cause to a master, to take and state the accounts, directing the master, in taking the accounts, to ascertain and report the number of machines made and sold by Kinsman and Goddard, or either of them; the advances made by Kinsman and Goddard, or either of them, and charging a profit of \$100 on each machine sold.

The master reported: and his report not being excepted to, was confirmed, and a final decree made that Kinsman and Goddard should pay to the complainant the amount reported by the master to be due from them. From this decree the appeal now before us was taken.

The principal objection made by the appellants to the decree of the court below, is that Parkhurst was not the original and first inventor of the thing patented. We are not satisfied that this is made out. But we have not found it necessary to come to a decided opinion upon this point, because we are all of opinion that, under the agreement of the 9th of February, 1846, the invalidity of the patent would not afford a bar to the complainant's right to an ac-

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count. Having actually received profits from sales of the patented machine, which profits the defendants do not show have been, or are in any way liable to be, affected by the invalidity of the patent, its validity is immaterial. Moreover, we think the defendants are estopped from alleging that invalidity. They have made and sold these machines under the complainant's title, and for his account, and they can no more be allowed to deny that title and retain the profits to their own use than an agent who has collected a debt for his principal, can insist on keeping the money upon an allegation that the debt was not justly due.

The invalidity of the patent does not render the sales of the machine illegal, so as to taint with illegality the obligation of the defendants to account. Even where money has been received, either by an agent or a joint owner, by force of a contract which was illegal, the agent or joint owner cannot protect himself from accounting for what was so received, by setting up the illegality of the transaction in which it was paid to him. Thus, where a vessel engaged in an illegal trade carried freight which came into the hands of one of the part owners, and on a bill filed by the other part owner for an account, the defendant relied on the illegality of the trade, but it was held to be no defense. *Sharp v. Taylor*, 2 Phil. Ch. 801. So in *Tenant v. Elliott*, 1 B. & P. 3, the defendant, an insurance broker, having effected an illegal insurance for the plaintiff, and received the amount of a loss, endeavored to defend against the claim of his principal by showing the illegality of the insurance, but the plaintiff recovered. See also, *McBlair v. Gibbes*, 17 How. 236.

Here, however, as already observed, there was no illegality; it is simply a question of failure of title, and as that does not appear in any manner to have affected the profits which the defendants received, there can be no ground to allow it to be shown in defense. *Bartlett, Adm'r, v. Holbrook*, 1 Gray 114; *Wilder v. Adams*, 2 Wood. & M. 329, are in point.

Similar views are decisive against the objection that this was a contract in restraint of trade. It was certainly com-

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petent for two persons, being joint owners of letters patent, whether valid or invalid, to enter into a copartnership for the manufacture and sale of the patented machines, and to stipulate that one of them should alone conduct the business. This was a provision for the prosecution of the business in a particular mode, and not for its restraint. It is a very common and not an illegal stipulation in partnership articles, that neither partner shall carry on that business for which the partnership is formed outside of the partnership and for his own account. Besides, if the contract to refrain from the manufacture could not be enforced as being against public policy, this would afford no answer to a claim for an account of profits actually realized by prosecuting the business, there being no connection between the illegal stipulation and the profits of the business.

It was insisted by the appellants that they did not act under the complainant's title, but under some right acquired from one Sargent. We are not satisfied that Sargent had even an inchoate right to a patent for the machines which the appellants made and sold. But even if he had, the defendant, Kinsman, could not secretly acquire the outstanding right of Sargent, if any, and set it up against his joint owner, Parkhurst, in derogation of his rights under the agreement of the 9th of February, which Kinsman entered into with knowledge of this alleged title of Sargent; and Goddard is bound by the same equities for he not only purchased *pendente lite*, and with actual notice of the suit, but we are satisfied the sale to him was made to enable Kinsman to attempt to evade the injunction.

The appellant, Goddard, objects that he has been charged by the final decree, jointly with Kinsman, for the profits on sales of machines made before the transfer to him by Kinsman. If this be so, it arises from the report of the master, who was directed by the interlocutory decree to report the sales made by Kinsman and Goddard, or either of them, and the advances and expenditures of them, or either of them.

If his report was in this or any other particular erroneous, it was incumbent on the defendants to have

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pointed out the error by an exception filed pursuant to the rules of the court on that subject. But no exception was filed, the report was confirmed, and the final decree was drawn up and entered without objection by the appellant, Goddard, reciting that it appears by the report of the master that the sum of \$23,220.28 is due and owing by Kinsman and Goddard to Parkhurst, and thereupon proceeds to decree them to pay that sum. When a motion to dismiss the appeal was made at a former day, on the ground that the master's report not having been excepted to, and the appellants not having objected to the final decree, there was nothing open on the appeal, the appellant's counsel declared that the appeal was designed only to review the interlocutory decree which had decided the merits of the cause, and that, unless error was found therein, there was no ground for the appeal. The motion to dismiss the appeal was overruled, the court being of opinion that it was open to the appellants to review the decision made by the interlocutory decree. But the interlocutory decree does not direct the master to charge Goddard and Kinsman jointly with profits on sales made by Kinsman alone. If the master put such an interpretation on the decree, it was an erroneous interpretation, and should have been brought before the court below by an exception. It is too late to object to it here for the first time.

The appellants also insist that they were charged with profits not actually received, by reason of the failure of the purchasers to pay, and other causes. But this was in accordance with the agreement of the 9th of February, which stipulates that Kinsman shall be accountable for \$100 profit on each machine made and sold by him. By force of this stipulation, he and Goddard, who acted with him under this agreement, took the risk of bad debts. It appears, from the master's report, that evidence tending to show that some of these losses were attributable to the interference of Parkhurst was offered to the master, and rejected by him. But no exception having been taken to bring this point before the Circuit Court, it is not open here.

Notes and Citations.

We have considered all the objections to the decree of the Circuit Court, and finding them untenable, we order the decree to be affirmed, with damages and costs.

Notes:

Partnership, see

Ambler v. Whipple, 20 Wall 546.

Patent in suit:

No. 4028. Parkhurst, S. R., May 1, 1845. Wool Carding Machine. Reissue No. 1137, Feb. 12, 1861.

OTHER SUITS ON SAME PATENT:

Cundell v. Parkhurst, 1847. 1 MacA. Pat. Cases 63.

Parkhurst v. Kinsman, 1848. 2 Blatchf. 72; Fish. Pat. Rep. 175.

Parkhurst v. Kinsman, 1848. 2 Blatchf., 76; Fish. Pat. Rep. 178.

Parkhurst v. Kinsman, 1848. 2 Blatchf. 78; Fish. Pat. Rep. 180.

Parkhurst v. Kinsman, 1849. 1 Blatchf., 488; Fish. Pat. Rep. 161.

Morris v. Lowell Mfg. Co., 1866. 3 Fish., 67.

Cited:**IN SUPREME COURT:**

Dale Tile Mfg. Co. v. Hyatt, March, 1888. 125 U. S. 46.

IN CIRCUIT COURTS:

Birdsall v. Perego, August, 1865. 5 Blatch. 251.

Cohn v. National Rubber Co., October, 1878. 3 Ban. & Ard. 568; 15 O. G. 829.

Notes and Citations.

Brown v. Lapham, April, 1886; 27 Fed. Rep. 77.

IN DECISIONS OF COMMISSIONER OF PATENTS:
Berry v. Stockwell, January 27, 1876. 9 O. G. 404.

IN STATE COURTS:
Davis & Co. v. Gray, December, 1867. 17 Ohio S. Rep. 330.
Marston v. Swett, April, 1875. 4 Hun. (N. Y.) 153.
Jackson v. Allen, March, 1876. 120 Mass. 64.
Jones v. Burnham, May, 1877. 67 Maine, 93.
Palmer's Appeal, November, 1880. 96 Penn. 106.

IN TEXT-BOOKS:
2 Abb. Pat. Law, 1886, p. 136.
Walker on Pats., 1883, p. 447.
Curtis on Pats., 4th ed., §§ 186, 414.

*Statement of the case.***WILLIAM H. SEYMOUR AND LAYTON S.
MORGAN, PLAINTIFFS IN ERROR, *v.* CYRUS
H MCCORMICK.****19 How. 96-107. Dec., 1856.**

[Bk. 15, L. ed. 557; 1 Whit. 1004.]

Particular patent construed. Delay in filing disclaimer. Prior publication, of what not evidence.

1. Claim 2 of patent No. 3895, C. H. McCormick, January 31, 1845, Harvester, viz.: "I claim the reversed angle of the teeth of the blade in the manner described," construed to claim the reversed angle of the teeth of the blade, and not to be in combination with another element, in view of the words "in the manner described," as charged by the court below (p. 304).
2. The granting of a patent for the improvement, together with the opinion of the court below maintaining its validity, repel any inference of unreasonable delay in filing a disclaimer to a claim alleged to be wanting in novelty (p. 305).
3. Under Act 1836, § 15, a prior publication describing a partially successful working machine is no evidence of its continued successful operation in the interim between such date of publication and a subsequent date when it was also shown to be in successful operation (p. 306).

[Citations in the opinion of the Court:]

O'Reilly *v.* Morse, 15 How. 121 [5 Am. & Eng. 483], p. 305.

In error to the Circuit Court of the United States for the Northern District of New York.

The original writ was sued out of the Circuit Court in the June Term, 1850. The declaration was filed August 23d, 1850, alleging that Cyrus H. McCormick was the first and original inventor of three certain improvements "in machines for reaping all kinds of small grain," for which three letters patent had been granted to him by the Commissioners of Patents of the United States. The first,

Statement of the case.

dated June 21, 1834; the second, January 31, 1845; the third, October 23, 1847, and that the defendants had manufactured and sold large numbers of reaping machines substantially like those patented by said McCormick in the said two last mentioned letters patent, without license or permission.

The defendants below prayed oyer of the three letters patent set out in the declaration, and it was given.

The defendants pleaded the general issue, and gave notice of various prior inventions and publications in public works, which they designed to give in evidence in their defense.

This case has once been before this court, and was sent back for a new trial, on the ground of an error in the instructions as to damages.

16 How. 480.

The former trial was on the patent of October 23, 1847.

The plaintiff's recovery in the present case was on the patent of January 31, 1845. The claims of the plaintiffs in that patent were as follows:

"I claim, 1st. The curved (or angled downward, for the purpose described) bearer, for supporting the blade in the manner described.

"2. I claim the reversed angle of the teeth of the blade, in manner described.

"3. I claim the arrangement and construction of the fingers (or teeth for supporting the grain), so as to form the angular spaces in front of the blade, as and for the purpose described.

"4. I claim the combination of the bow, L, and dividing-iron, M, for separating the wheat in the way described.

"5. I claim the setting of the lower end of the reel-post, R, behind the blade, curving it at R 2, and leaning it forward at top, thereby favoring the cutting, and enabling me to brace it at top by the front brace (S), as described, which I claim in combination with the post.

"CYRUS H. McCORMICK."

The exceptions taken on the trial and incorporated in a bill of exceptions, are twenty in number, whereof the first

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twelve are to rulings admitting or rejecting evidence, and the last eight to the charge.

Portions of the charge to the jury were substantially as follows: The patent upon which the action is founded was issued to the plaintiff on January 31, 1845, for an improvement in reaping machines. It seems that his experiments began as early as 1830 or 1831, and were continued down to 1834, when he first obtained a patent thereon. This machine, however, was not a successful one, and this seems to have been the fate of the experiments down to 1845, when a second patent was taken out for improvements on the first one. The machines did not go into general or successful operation until after the arrangement of the seat for the raker upon it, which was patented in 1847. Then the machines became eminently successful.

The improvements which were patented in 1845, and which were claimed by the plaintiff to have perfected his machine of 1834, as far as it respects cutting the grain and laying it on the platform, are two: the divider and the rearrangement of the reel-post.

It is said that neither of these improvements, assuming that the plaintiff was the author of them, is of a description entitling it to be regarded as the subject of the patent under our patent law. An improvement upon a machine, to constitute it an invention within the meaning of the law, must be new, not known or in use before; and it must also be useful. In other words, the person claiming the improvement must have found out himself, and created and constructed an improvement which had not before been found out or produced by any person, and which is beneficial to the public. This novelty, worked out by the mind of the inventor, connected with utility, constitutes the essence of the patentable subject under the law.

It is said by the learned counsel of the defendants that there is a claim in the patent outside of the two claims that are in controversy, which is void, because Mr. McCormick appears, from the evidence, not to have been its original and first inventor, and that inasmuch as he had made one void claim, his patent is void as it respects all the other

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claims. Although the evidence may show that he was the original and first inventor of all those other claims, as regards the law applicable to this point, the learned counsel is not strictly correct. The law is this: If a patentee makes a claim which is not well founded in the same patent with other claims which are well founded, he may disclaim, within a reasonable time, that which he had no right to claim, and then his patent will be good as to the residue—as good as if it had originally issued only for claims which are valid. If he omits to make a disclaimer, but brings a suit for the violation of his patent, and it satisfactorily appears upon the trial that he is entitled to be protected in a portion of the claims set up in his patent, but that he is not entitled to be protected in respect to another portion, he is still entitled to damages for a violation of the valid portion of his claims, the same as if all the claims were valid, so far as regards the mere right of recovery, but he gets no costs. That is the law. It has this qualification: If the jury are satisfied that there has been unreasonable negligence and delay on the part of the patentee in making a disclaimer as respects the invalid part of his patent, then the whole patent is inoperative, and the verdict must be for the defendants; as in this case, the claim on which the question arises is as follows:

"I claim the reversed angle of the teeth of the blade in manner described." It is said by the defendants that the plaintiff was not the first inventor of that arrangement, but that Moore was. Assuming that the position of the learned counsel for defendants is right, that the plaintiff was not the first inventor of what is claimed in that claim, if you believe that he was the first inventor of the divider, and of the arrangement of the reel-post, he may still be entitled to recover damages, unless he has unreasonably neglected and delayed to enter a disclaimer for what is covered by the claim in regard to the angle of the teeth.

The claim in question is founded upon two parts of the patent. As the construction of that claim is a question of law, we shall construe it for your guidance. In the forepart of the patent we have a description of the blade and of the

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blade case and of the cutter, and of the mode of fastening the blade and blade case and the cutter, and of the machinery by which the arrangement is made for the cutter to work. We have also the description of the spear-shaped fingers, and of the mode by which the cutter acts in connection with those fingers. Then, among the claims are these: "2. I claim the reversed angle of the teeth of the blade in manner described. 3. I claim the arrangement for the construction of the fingers or teeth for supporting the grain, so as to form the angular spaces in front of the blade, as and for the purpose described." Now, it is insisted, on the part of the learned counsel for the defendants, that this second claim is one simply for the reversed angles of the sickle teeth of the blade. These teeth are common sickle teeth, with their angles alternately reversed in spaces of an inch and a quarter, more or less. The defendants insist that the second claim is merely for the reversed teeth on the edge of the cutter, and that the reversing of the teeth of the common sickle as a cutter in a reaping machine was not new with the plaintiff; and that if it was new with him he had discovered it and used it long before his patent of 1845. The defendants claim that Moore had discovered it as early as 1837 or 1838; and it would also seem that the plaintiff had devised and used it at a very early day after his patent of 1834—that is, the mere reversing of the teeth. But on looking into the plaintiff's patent more critically, we are inclined to think that when the plaintiff says, in his second claim, "I claim the reversed angle of the teeth of the blade in manner described," he means to claim the reversing of the angles of the teeth in the manner previously described in his patent. You will recollect that it has been shown in the course of the trial, that in the operation of the machine, the straw comes into the acute angled spaces on each side of the spear-shaped fingers, and that the angles of the fingers operate to hold the straws while the sickle teeth, being reversed, cut in both directions as the blade vibrates. The reversed teeth thus enable the patentee to avail himself of the angles on both sides of the spear-shaped fingers: whereas, if the sickle teeth were not reversed in sections,

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but all ran in one direction like the teeth in the common sickle, he could use the acute angles upon only one side of the fingers, because the cutter could cut only in one direction. We are, therefore, inclined to think that the patentee intended to claim, by his second claim, the cutter having the angles of its teeth reversed in connection with the angles thus formed by the peculiar shape of the fingers; and as it is not pretended that any person invented that improvement prior to the plaintiff, the point relied on in this respect by the learned counsel for the defendants, fails.

The remainder of the charge related to the question of damages. The exceptions to the charge were as follows:

To so much of the charge of the court as instructed the jury in substance that the plaintiff, in his patent of January 31, 1845, did not claim the reversed angle of the teeth of the blade as a distinct invention, but only claimed it in combination with the peculiar form of the fingers described in the same patent, the defendants' counsel excepted.

The defendants' counsel requested the court to instruct the jury that if they should be satisfied that Hiram Moore was the first inventor of the reversed angle of the teeth of the blade, and that the plaintiff was notified of that fact by the testimony of Moore on the trial of this cause, in June, 1851, and had not yet disclaimed that invention, then, in judgment of law, he has unreasonably delayed in filing his disclaimer, and the verdict should be for the defendants.

The court declined to so instruct the jury, and the defendants' counsel excepted to the refusal.

The defendants' counsel further requested the court to instruct the jury that, if they should be satisfied that Hiram Moore was the first inventor of the reversed angle of the teeth of the blade, and that the plaintiff was notified of the fact by the testimony of Hiram Moore on the trial of this cause in June, 1851, and had not yet disclaimed that invention, then it was a question of fact for them to decide whether the plaintiff had or had not unreasonably delayed the filing of a disclaimer; and if they should come to the conclusion that there had been such unreasonable delay, their verdict should be for the defendants.

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The court refused so to instruct the jury, and the defendants' counsel excepted to the refusal.

The defendants' counsel requested the court to submit to the jury the question under the evidence in the case, whether the plaintiff did or did not claim, in his patent of January 31, 1845, the reversed angle of the teeth of the blade, independent of any combination.

The court refused to submit that question to the jury, and the defendants' counsel excepted to the refusal.

The defendants' counsel requested the court to charge the jury, that whether the adjustability of the inner bow of the divider, as described in the plaintiff's patent, was a necessary ingredient of the divider, was the question of fact for them to determine. And if they should find that it was and that the defendants did not use it, that then the defendants did not infringe that claim of the plaintiff's patent.

The court refused so to instruct the jury, and the defendants' counsel excepted to the refusal.

The court on that point then instructed the jury as follows: The inside iron in the plaintiff's divider is adjustable, so that it can be raised or lowered at pleasure. In heavy grain that stands high, and may be cut high from the ground, it is desirable to raise the reel sometimes, and then this inside iron could be raised also, to insure the division of the grain, and cause the reel to overlap and carry all the grain to the cutter.

It is claimed by plaintiff, that although the defendants used no inside iron, yet they attained the same result by the shape of the inside of their divider, which thus answers to the inside edge of the plaintiff's divider. The defendants insist that, assuming this to be true, their divider has no such adjustability as the plaintiff's, and is, therefore, distinguishable from it. The answer to that position is this: The adjustability does not vary the principle of operation of the divider. It enlarges its capacity, so that it may be worked in heavy grain; but the principle and mode of operation of the divider are the same, whether the inner iron be adjustable or not.

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The defendants' counsel excepted to this part of the charge, insisting that it was a question for the jury.

The defendants' counsel further requested the court to instruct the jury that the plaintiff, if entitled to a verdict, was entitled to only so much as the jury should be satisfied was the increased market value of the machines manufactured by the defendants, by reason of the use of the two improvements which they are charged with infringing, in place of using any other kind of divider and reel support, which had been before in public use.

The court refused to instruct the jury in relation to the subject matter of such request, otherwise than they had already charged, and the defendants' counsel excepted to the refusal.

The defendants' counsel also asked the court to instruct the jury that, from the facts that Bell's machine operated successfully in 1829, and that it operated well also in 1853, they were at liberty to infer that it had operated successfully in the intermediate period, or some part of it.

But the court held and charged that there being no evidence respecting it, except at the trial of it in 1829, and the trial of it in 1853, the jury could not infer anything on the subject, and refused to charge as requested. The defendants' counsel excepted to the refusal, and also excepted to the charge in this respect.

UNITED STATES PATENT OFFICE. CYRUS H. McCORMICK,
OF ROCKBRIDGE COUNTY, VIRGINIA. IMPROVEMENT IN
REAPING-MACHINES. SPECIFICATION FORMING PART OF
LETTERS PATENT No. 3,895, DATED JANUARY 31, 1845.

To all whom it may concern:

Be it known that I, CYRUS H. McCORMICK, of the County of Rockbridge and State of Virginia, have invented certain new and useful improvements upon my patent reaping machine; and I do hereby declare that the following is a full and exact description of the construction and operation of the same, reference being had to the annexed drawings, making a part of this specification.

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The first improvements which I would describe are in the cutting apparatus, as follows, viz: The blade-case A A A A A², in which the blade B B B B² plays and is secured, is a straight plate of iron, the length of the blade —say, one and one-fourth inch wide, three-eighths inch thick on the back, and less than one-eighth inch on the front edge, as at A, Figure 3. To the upper side of this plate is riveted a back, A', Figs. 3 and 5, say, three-sixteenths inch thick (thickness of the blade) and five-eighths inch wide, having a width of five-eighths inch in front of the back, as at A², Fig. 3, for the blade to act upon. The end of this plate next to the crank is widened toward the front, as at A², Figs. 5 and 9, and turned up so as to receive and fit the end of the blade (giving it room to act), which is also extended in width, as hereinafter described. The other end of the plate is also widened in like manner. At the ends the width of the blade B is extended in front, as at 4 4, Figs. 4, 5, to one and three-fourths inch, being twice its width at the cutting part, so that the edge of the blade, though projecting over the case—say, one-fourth inch, as at B', Fig. 3—is firmly and sufficiently supported by the ends, and prevented from a tendency to wear and turn down from the pressure of the cutting. The teeth of the blade are similar to those of a common sickle, except that their angle is alternately reversed in spaces of one and one-fourth inch, more or less, as at B³, Fig. 4, on an inverted section, the object of which is to equalize the cutting in both directions as the blade vibrates, and more effectually to keep the blade free from choking by cutting itself clear of blades of wheat, &c., in both directions. The blade-case is secured to the two projections of the frame of the platform, C, at 7 7 7 7, Figs. 1 and 5—say, three or four inches forward of the front pieces, C, of said platform—and it is supported between, at suitable distances apart, by two or three iron bearers, e, as shown in this cross-section, Fig. 3, screwed fast to the front piece of the platform, C, and so bent downward as to let straw or blades that may get in work out.

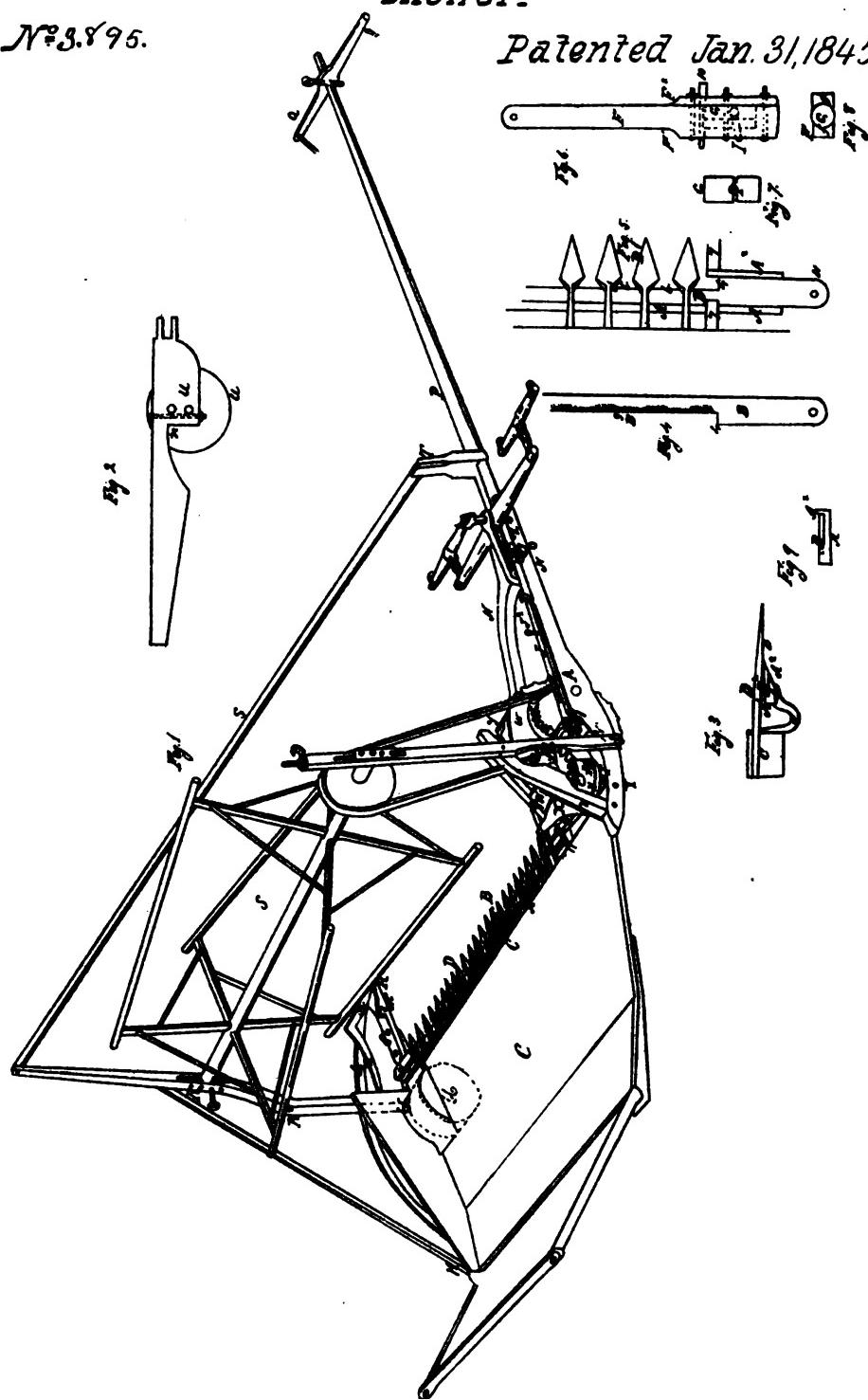
The fingers, D D D (twenty-seven in number, more or

C. H. McCormick.

Mower.

No. 3,895.

Patented Jan. 31, 1845.





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less), are made of bars of wrought-iron (but might be cast), about five-eighths inch square, one end of which is widened into a shape resembling a spear. These fingers are made fast in the frame of the platform, C, and extend forward above the blade, so that the hinder angle, d, Fig. 5, of the spear, is just behind the serrated edge, b, of the blade, B, thereby forming an acute angle between the edge, b, of the blade, and the shoulder, d, of the spear, by which the grain is prevented from yielding to the touch of the blade, B, as it vibrates, and is held fast, so that the cutting is insured, and that, too, dispensing with the under part of the finger (as with the double bearer or finger), on which blades of grass, &c., are liable to lodge and choke the machine. The fingers are intended to fit pretty close to the edge of the blade, and to be bent up a little from the back to prevent choking, as at B' B², Fig. 3. The blade may either cut on a level with the upper surface of the platform or below it, as at present constructed.

Next, the driver, F (or connecting-rod), is made of two pieces, F' F², put together with screw-bolts, and so hollowed out in the inside, as at f f, Fig. 8, as to receive round or cylindrical followers, G G G, in which the wrist of the crank I I I revolves, to be kept tight on the crank by the key 10, Fig. 6, instead of flat ones, by which arrangement they are enabled to roll in the driver, so as to accommodate themselves to any angle of the crank, varied by changing the height of cutting, thereby dispensing with extra followers to suit different sets of the machine, and the trouble of changing them. The machine is at present constructed for two heights of cutting, eight and ten inches (might have more variations), which is effected on the out or tongue side by two joints in the frame-work—one at the crank or connection of the hounds, N N, and platform, C Y V V, the other at the connection of the hounds and tongue, P O O Z—the two bolts, Y and Z, being pivots to the two joints, and the axle of the main ground-wheel at A, in the two hounds, a pivot on which to turn the frame to effect the change required. When the bolts V and O are in the lower holes of the hounds and tongue, the height of

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the blade from the ground will be eight inches, which is the lowest. The point of the tongue being fixed and immovable by the breast-piece, Q, made fast to the horse's hames by moving the bolts V and O into the holes V and O of the hounds and tongue upon the pivot, A, as before described, the hounds, together with the wheels, crank, and other frame-work attached to them, will turn, sinking the joint O O Z, and raising the joint Y V V, and, consequently, the blade to ten inches. By this operation the horizontal position of the platform and of the blade and driver, they being attached by a pin at 11 11 11, Figs. 1, 5, and 6, is preserved, while the turning of the hounds, crank, &c., as aforesaid, varies the angle of the crank to the blade and driver, and but for the rolling of the followers in the driver, as before described, would twist the blade.

The application of the fly-wheel, H, upon the axle of the crank, I, above the wrist, by which means the weight of the driver is counterbalanced (one side of the wheel being heavier than the other), the changes of action in the blade regulated and effected with more ease, less friction and strain upon the machinery, and consequent liability to wear and get out of order, and from which uniformity of action and resistance, the action of the blade and wheels is kept up in situations where otherwise it would fail by reason of the wheels slipping and not revolving.

The manner of ungearing the machine by the lever, J, so that when it is moving and not cutting, the operation of the wheels and blade can be stopped conveniently. This is effected by securing the lever to the top of the out hound by a screw-bolt, B, which serves as a fulcrum. One end of the lever extends—say four or five inches—back from the fulcrum to a suitable place, and is suitably shaped as a box, in which is placed and acts the lower end of the axle, g, at the pinion of the wheel, L, that operates the crank, and on and near the lower end of which said axle is a pinion, M, of nine teeth, that gears into the master cog-wheel, P, of thirty teeth. At some twelve inches before the fulcrum is a loose pin, J², put through the lever and into the hound, which holds it firmly to its place. To

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ungear the wheel it is then only necessary to take out this pin and move the end of the lever in toward the master cog-wheel, which moves the other end with the pinion out of gear; and the pin being put again into the lever and a different hole in the hound, it is kept out of gear until changed, as before. This is important in moving the machine from place to place, and also in cutting around a piece of grain it sometimes does not suit so well to cut on one side as on others. The divider, K, is an extension of the frame on the left side of the platform—say three feet before the blade—for the purpose, and so constructed as to effect a separation of the wheat to be cut from that to be left standing, and that whether tangled or not. E is a piece of scantling—say three feet long and three inches square—made fast to a projection of the platform by two screw-bolts. To the point of this piece, at K, is made fast by a screw a bow, L, of tough wood, the other end of which is made fast in the hinder part of the platform, at R, and it is so bent as to be about two and a half feet high at the left reel-post, and about nine inches out from it, with a regular curve.

The dividing-iron, M, is an iron rod of a peculiar shape, made fast to the point of the same piece, E, and by the same screw-bolt that holds the bow, K. From this bolt this iron rises toward the reel, S, at an angle of, say, thirty degrees, until it reaches it, then it is bent so as to pass under the reel as far back as the blade, and to fit the curve of it (the reel). From the bolt in the point aforesaid, the other end of this iron extends—say nine inches—along the inside of the piece, E, where it is held by another screw-bolt, M', and where it has a groove or slot in it to admit the other ends being raised or lowered (turning on the point-screw, K, as a pivot) to suit the height of the reel. By means of the bow to bear off the standing wheat and the iron to throw the wheat to be cut within the power of the reel, the required separation is made complete.

The manner of constructing the hounds, N N (or main wheel-pieces), and of connecting them with the tongue, P, and forming the movable joint, O O Z, as before described,

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corresponding with the joint, Y V V, in changing the height of the cutting, by which construction, too, the frame is greatly simplified and strengthened, sufficiently so to control the action of the machine firmly and permanently (the inside hound operating as a direct and strong brace to it) by means of the tongue, P, which is extended—say ten feet—forward, so as to balance the machine upon its two ground wheels, T and U, and is attached to the breast-piece, Q, as before described.

The reel-post, R (on the left side of the machine), instead of being placed before the blade, standing perpendicularly and braced as before, is set, say nine inches behind the blade, as at U, and so leaned forward as to bring the middle of it or point, R, at which the end of the reel is supported, to its former perpendicular, thereby, too, so putting the top of the post, V, forward, as to admit of being braced directly to the tongue, P, by means of the tongue-post, T, for the purpose of raising the end of it a little by the brace, S, passing partly over and in front of the reel. By this arrangement, first the bracing, as described, is effected with much more simplicity and strength; and, secondly, the lower end of the post at U being behind the blade and crooked out, as at R² (the end of the dividing-iron at m being bent inward), all tendency of straw hanging upon it (the post) and interfering with the cutting is removed. The top of this post and front brace, S, might be dispensed with by making the frame of the platform heavier and stronger, but it is believed not so well as at present constructed.

The manner of attaching the small ground-wheel to the left side of the platform, as at U, Fig. 2, by having different holes in the frame, as at U', for varying the height (by changing the axle of the wheel in them) of the cutting, and cutting away the under side of the frame at n, behind the axle, to prevent the collecting of earth and gravel by the upward motion of the wheel, so as to stop its revolution.

The manner of attaching the sand-board, W W, to the frame between the main ground-wheel and the other wheels, driver, &c., by constructing it of two pieces at right angles to each other, the piece, w, being placed between the ground-

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wheel and master cog-wheel, and made fast by the bolt, V, the other part, W, tapering between the ground-wheel and and driver, and made fast to the brace, q; and, lastly, the straw-board, X, made fast to the wheel-post, r, at r. and to the brace, at q, for the purpose of keeping the grain from the wheels, driver, &c.

I claim—

1. The curved or angled downward (for the purpose described) bearer for supporting the blade in the manner described.

2. The reversed angle of the teeth of the blade in the manner described.

3. The arrangement and construction of the fingers or teeth for supporting the grain, so as to form the angular spaces in front of the blade, as and for the purpose described.

4. The combination of the bow, L, and dividing-iron, M, for separating the wheat in the way described.

5 Setting the lower end of the reel-post, R, behind the blade, curving it at R^2 , and leaning it forward at top, thereby favoring the cutting, and enabling me to brace it at top by the front brace, S, as described, which I claim in combination with the post.

CYRUS H. McCORMICK.

Witnesses:

T. C. DONN,

R. I. A. CULVERWELL.

Messrs. H. R. Selden, P. H. Watson, E. M. Stanton, and Harding, for the plaintiffs in error:

1. The testimony which was offered with reference to the successful use of what was called, on the trial a horizontal divider, with a central ridge, should have been received. It was competent upon the question of utility of the plaintiff's invention, and also with reference to the amount of damages, it was material.

2. The question as to the practicable difference in value between the plaintiff's machines, with the divider and without, as to the comparative value of the machine with and without the seat and divider, and as to what the witness

Argument of counsel.

would give for a machine without the seat and divider, if he could get one for a fair price with a seat and divider, should not have been allowed.

3. The testimony in reference to the profits made by the plaintiff as the manufacturer of such machines was improperly received.

(*Seymour v. McCormick*) 16 How. 480 [p. 200 *ante*].

4. The question whether the plaintiff had granted licences to construct his machines or not should have been rejected; it was wholly foreign to the case, even upon the question of damages.

5. The plaintiff should have been required to produce the patent for his original machine of 1834, of which the invention patented in 1845 was alleged to be an improvement, so that the jury could see how much had become public property.

Lewis v. Davis, 3 C. & P. 502 [1 Am. & Eng. 406]; *Curtis*, sec. 141; *Lowell v. Lewis*, 1 Mas. 188.

The construction given in the court below to the second claim of the patent of 1845 was erroneous.

(a) The words, "in the manner described," used in the second claim, refer exclusively to the description of the construction of the sickle, without reference to the peculiar shape of the fingers, or to any combination whatever. They refer to the straight blade alone, with the specified positions of its teeth.

We suppose the correct rule for the interpretation of patents is laid down by Mr. Curtis, in his Treatise on Patents, sec. 126: "The nature and extent of the invention claimed by the patentee is the thing to be ascertained, and this is to be arrived at through the fair sense of the words he has employed to describe his invention. But that rule, even as limited or aided by the principle referred to, in sec. 132, viz: "That a specification should be so construed as—consistently with the fair import of the language—will make the claim co-extensive with the actual discovery," does not relieve the plaintiff here from the distinct claim of the reversed teeth of the blade as an independent invention.

Argument of counsel.

This principle was well applied in the case of Haworth *v.* Hardcastle, Web. Pat. Cas. 484 [2 Am. & Eng. 19], from which it was taken by Mr. Curtis.

See, also, Byam *v.* Farr, 1 Curt. 263; Act of 1836, sec. 13; Curt. sec. 386; Godson, Pat. 204, 205; Le Roy *v.* Tatham, 14 How. 176 [5 Am. & Eng. 313]; Act of 1836, sec. 6.

Both reason and the statute demand of him who claims the exclusive right, to define clearly the limits of his invention. It can in no case be difficult for an inventor to say distinctly whether he claims two or more elements singly, or merely in combination.

Evans *v.* Hettick, 3 Wash. 408; S. C. 1 Robb, 166.

(b) The point was material.

Hiram Moore used such a sickle as early as 1836, if not in 1834. Notice of this invention by Moore was given to the plaintiff as early as September, 1850.

The plaintiff, in his history of his invention, sworn to January 1, 1848, presented to the Commissioner of Patents for the purpose of obtaining an extension of his first patent, shows that he did not use the blade with reversed teeth until the harvest of 1841.

Under these circumstances we insist that the plaintiff was called upon during the three years that intervened between the trial in June, 1851, and that in October, 1854, to disclaim the invention of the reversed angle of the teeth of the blade.

It was, therefore a question for the jury, under the 9th section of the Act of March 3, 1837 (Curt. 489, 690), whether the plaintiff had not unreasonably neglected or delayed to enter at the Patent Office his disclaimer.

To allow a patentee, under such circumstances, to designedly delay a disclaimer, would defeat the manifest object of the last proviso to section 9, above referred to, which was to compel a patentee, who had inadvertently covered by his patent something to which he was not entitled, and thus wrongfully obstructed its free use, to remove the obstruction as soon as possible after the discovery of his mistake.

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7. The exceptions to the refusal of the court to instruct the jury that if they should be satisfied that Moore was the first inventor of the reversed angle of the teeth of the blade, plaintiff was notified of the fact by the testimony of Moore, on the trial of this cause in June, 1851, and had not yet disclaimed that invention, then it was a question of fact for them to decide whether the plaintiff had or had not unreasonably delayed the filing of the disclaimer, were well taken.

8. The question as to the immateriality of the adjustable feature of the plaintiff's divider, should have been submitted to the jury.

Curtis, secs. 220, 380, 385, 402.

9. If the question whether the adjustability of the divider was immaterial, belonged properly to the court as a question of construction, there was error in the charge to the jury on that subject, in saying, "The adjustability does not vary the principle of operation of the divider. It enlarges its capacity, so that it may be worked in heavy grain; but the principle and mode of operation of the divider are the same, whether the inner iron be adjustable or not."

The description given by the court ignores entirely the adjustable features of the divider, and puts forth substantially the "beneficial operation" or "useful effect" produced by the invention, as constituting its essence, rather than the machinery by which it is produced, thus making the patent cover an effect produced. Whether the patent might or might not rightfully cover the effect produced, need not be discussed.

See *Le Roy v. Tatham*, 14 How. 175 [5 Am. & Eng. 313]; *O'Reilly v. Morse*, 15 How. 112 [5 Am. & Eng. 483]; *Corning v. Burden*, 15 How., 269 [p. 69 *ante*].

It is sufficient here that the plaintiff did not claim this.

The adjustability and form of the inner iron are not only material, but constitute the main feature of novelty in plaintiff's divider.

Prouty v. Ruggles, 16 Pet. 336 [4 Am. & Eng. 351]; *Davis v. Palmer*, 2 Brook 298.

10. The instruction as to the measure of damages which

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were asked for by the defendants' counsel, should have been given to the jury.

(*Seymour v. McCormick*) 16 How. 488 [p. 200 *ante*]; *Sedgwick on Damages*, 2d ed. 69.

11. The request of instructions to the jury, "that from the facts that Bell's machine operated successfully in 1829, and that it operated well also in 1853, they were at liberty to infer that it had operated successfully in the intermediate period, or some part of it," should have been given, and the actual charge, "that there being no evidence respecting it except the trial of it in 1829, and the trial of it in 1853, the jury could not infer anything on the subject," was erroneous.

We think that on the evidence given, it was proper to submit to the jury the question as to its operation, and not to place it under the ban as an entire failure, which seems to be the effect of the charge as it was given.

If it operated well in 1829 and in 1853, which is clearly proved, and is assumed by the judge, it must certainly have been capable of operating well at any intermediate time. Whether actually used or not is wholly immaterial.

This prior invention of Bell's, if the court had not substantially excluded it from the consideration of the jury, would have furnished a complete answer to the charge of infringement of the fifth claim of Mr. McCormick's patent of 1845.

Evans v. Hettick, 3 Wash. 408; S. C. 1 Robb, 166.

12. It was erroneous to grant costs to the plaintiff, inasmuch as it appeared that he was not the first inventor of the reversed angle of the sickle, and had not filed a disclaimer prior to the commencement of the suit.

The testimony showed conclusively that Moore was the first inventor of the reversed angle of the teeth.

Messrs. E. M. Dickerson and Reverdy Johnson, for the defendant in error:

The counsel first discussed the first twelve exceptions, which related to the admission or rejection of testimony at the trial.

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They then proceeded as follows:

Thirteenth exception. The description annexed to the letters patent of plaintiff, describes a sickle with reversed cut teeth, and then describes the manner in which this reversed-cut sickle operates in connection with the spear-headed fingers, "forming an acute angle between the edge of the blade and the shoulder of the spear, by which the grain is prevented from yielding to the touch of the blade." The specification then claims, "the reversed angle of the teeth of the blade in manner described."

a. It also appeared, that ever since the date of the first reaping patent in 1834, the plaintiff had experimented with this reversed sickle edge without producing any successful result, until he combined it in the manner described in the patent of 1845.

b. The sickle, separate and apart from the machine, is no invention in whatever way the teeth are cut; but when combined in the machine in the manner described, the reversed cut becomes a very valuable invention, enabling the sickle to cut itself clear each stroke; whereas, if the sickle were cut only one way, and the fingers were straight, it would only operate on the grain half the time.

c. This part of the invention was not infringed.

Fourteenth exception. Unreasonable neglect to file a disclaimer under the 9th section of the Act of 1837, is a question of fact for the jury.

Fifteenth exception. There was no evidence that Moore had ever constructed a reversed-cut sickle in the manner described in the patent of plaintiff, nor that he had ever made one in any manner which was successful; the only claim being that in 1836-1837, he had made a reversed-cut sickle, and had never seen one before, while the plaintiff had done the same thing in 1834. There was, therefore, no fact for the jury to find, and it would have been erroneous if the court had submitted an hypothesis unsupported by evidence for their decision.

a. The construction of the claim also settled this point, because there was a pretence that such a manner of applying the reversed-cut sickle was old.

Argument of counsel.

Sixteenth exception. The construction of a patent is a question of law.

Seventeenth and eighteenth exceptions. First, the construction of the patent is a question of law. Second, the specification does not mention adjustability. In the description it is spoken of as a quality of the inside edge of the divider; but when the patentee specifies his invention, he declares it to be for a combination of elements, of which his adjustable iron was one. Whether any other form of inside edge of this divider is substantially the same as this adjustable iron, is a question of fact for the jury; but whether the adjustability is one of the things claimed by the inventor as essential to his invention, is a question of law, arising upon the face of the patent itself. The former of these questions was submitted to the jury by the court, and the latter was decided by the court itself.

a. The whole description relative to adjustment might be stricken out of the patent without affecting the specification, which would still be framed in the same words, as null, whereas, in this idea of adjustability, where essential, its withdrawal would destroy the claim of the combination.

b. The combination specified is of three parts, the outside bow, the inside iron, and the reel co-operating with the other two to effect a separation. The removal of any of these without substituting an equivalent would destroy the combination, and the grain would not be separated in the way described.

Nineteenth exception. "Actual damage" is the rule prescribed by the statute, and the rule sought to be established by this prayer, might be in direct conflict with the statute.

The increased market value might be much more than the patentee would be content to receive for his license, or it might be less. If the market value were the rule, it would place it in the power of an infringer to ruin any patent, by fixing a market value of the improvement which would be no compensation to the patentee.

Twentieth exception. The facts stated in this exception, that Bell's machine operated successfully in 1829 and in

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1853, are not evidence from which the jury could legally infer that it had operated successfully in the intermediate period, or any part of it; for there is no rule which raises a presumption of successful operation out of the facts assumed in the prayer, but rather the contrary, since if it ever did succeed at all, it most probably never would have been abandoned, and then its continued use to a more recent date would have been quite as easily proved as its use at any prior date.

Mr. Justice NELSON delivered the opinion of the court:
This is a writ of error to the Circuit Court of the United States for the Northern District of New York.

The suit was brought by McCormick against Seymour and Morgan, for the infringement of a patent for improvements in a reaping machine granted to the plaintiff on the 31st of June, 1845. The improvements claimed to be infringed were: 1st, a contrivance or combination of certain parts of the machinery described, for dividing the cut from the uncut grain; and 2d, the arrangement of the reel-post in the manner described, so as to support the reel without interfering with the cutting instrument.

In the course of the trial, a question arose upon the true construction of the second claim in the patent, which is as follows: "I claim the reversed angle of the teeth of the blade in manner described." This claim was not one of the issues in controversy, as no allegation of infringement was set forth in the declaration. But it was insisted, on the part of the defendants, that the claim or improvement was not new, but had before been discovered and in public use; and that, under the 9th section of the Act of Congress passed March 3, 1837, the plaintiff was not entitled to recover costs for want of a disclaimer of the claim before suit brought; and that, if he had unreasonably neglected or delayed making the disclaimer, he was not entitled to recover at all in the case.

The ground upon which the defendants insisted this claim was not new, was that it claimed simply the reversed angle of the teeth of the blade or cutters. The court below

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were of opinion that, reading the claim with reference to the specification in which the instrument was described, it was intended to claim the reversed angle of the teeth in connection with the spear-shaped fingers arranged for the purpose of securing the grain in the operation of the cutting—the novelty of which was not denied.

The majority of the court are of opinion that this construction of the claim cannot be maintained, and that it is simply for the reversed angle of the cutters; and that there is error, therefore, in the judgment, in allowing the plaintiff costs.

In respect to the question of unreasonable delay in making the disclaimer, as going to the whole cause of action, the court are of opinion that the granting of the patent for this improvement, together with the opinion of the court below maintaining its validity, repel any inference of unreasonable delay in correcting the claim; and that, under the circumstances, the question is one of law. This was decided in the case of *O'Reilly v. Morse*, 15 How. 121 [5 Am. & Eng. 483]. The Chief Justice, in delivering the opinion of the court, observed, that "the delay in entering it (the disclaimer) is not unreasonable, for the objectionable claim was sanctioned by the head of the office; it has been held to be valid by a Circuit Court, and differences of opinion in relation to it are found to exist among the justices of this court. Under such circumstances, the patentee had a right to insist upon it, and not disclaim it until the highest court to which it could be carried had pronounced its judgment."

Several other questions were raised in the case, which have been attentively considered by the court, and have been overruled, but which it cannot be important to notice at large, with one exception, which bears upon the fifteenth section of the Patent Act of 1836.

Bell's reaping machine was given in evidence, in pursuance of a notice under this section, with a view to disprove the novelty of one of the plaintiff's improvements; a description of it was read from "Loudon's Encyclopædia of Agriculture," published in London, England, in 1831. In

Notes and Citations.

addition to the description of the machine, it appeared in the work that the reaper had been partially successful in September, 1828 and 1829.

It also appeared, from the evidence of Mr. Hussey, that he saw it in successful operation in the harvest of 1853.

The court was requested, on the trial, to instruct the jury, that from the facts that Bell's machine operated successfully in 1829 and in 1853, they were at liberty to infer that it had been operated successfully in the intermediate period, which was refused. Without stating other grounds to justify the ruling, it is sufficient to say, that the only authority for admitting the book in evidence, is the 15th section of the Act above mentioned. That section provides, that the defendant may plead the general issue, and give notice in writing, among other things, to defeat the patent, "that it (the improvement) had been described in some public work anterior to the supposed discovery thereof by the patentee." The work is no evidence of the facts relied on for the purpose of laying a foundation for the inference of the jury sought to be obtained.

The judgment of the court below is affirmed, with the qualification, that on the case being remitted to the court below, the taxation of costs be stricken from the record.

Notes:

1. "Substantially as described." See
Winans v. Denmead, 15 How. 380 [p. 107 *ante*], note 5.

2. No unreasonable delay in disclaiming until after the decision of the highest court.
O'Reilly v. Morse, 15 How. 62 [5 Am. & Eng. 483].
Gage v. Herring, 107 U. S. 640.
Yale Lock Co. v. Sargent, 117 U. S. 536.

Notes and Citations.**3. Act 1836, § 15:** Act 1870, § 62; R. S. 4928.

Patent in Suit:

No. 3895. McCormick, C. H. January 31, 1845.
Harvester.

OTHER SUITS ON SAME PATENT:

McCormick v. Seymour, 1851. 2 Blatchf. 240.

McCormick v. Seymour, 1858. 16 How. 480; 1 Whit. 944 [p. 200 *ante*].

McCormick v. Seymour, 1854. 3 Blatchf. 209.

McCormick v. Many, 1855. 6 McL. 539.

McCormick v. Talcott, 1857. 20 How. 402; 1 Whit. 1085.

Cited:**IN SUPREME COURT OF UNITED STATES:**

Silsby v. Foote, 1857. 20 How. 378; Bk. 15, L. ed. 953.

Gage v. Herring, 1883. 107 U. S. 640; Bk. 27, L. ed. 601.

IN CIRCUIT COURTS:

Burdett v. Estey, November, 1878. 15 Blatchf. 349; 4 Ban. & Ard. 7; 15 O. G. 877.

Stutz v. Armstrong, July, 1884. 20 Fed. Rep. 843; 28 O. G. 367.

Matthews v. Flower, October, 1885. 25 Fed. Rep. 830; 33 O. G., 887.

Notes and Citations

IN DECISIONS OF COMMISSIONER OF PATENTS:

Edward Maynard, June, 1870, C. D., 1870, p. 54.

IN TEXT BOOKS :

2 Abb. Pat. Law, 1886, pp. 212, 437, 454.

Walker on Pats., 1883, pp. 141, 142, 358.

Curtis on Pats., 4th ed., §§ 269, 379.

*Syllabus.*JOHN BROWN, PLAINTIFF IN ERROR *v.*
DUCHESNE.

19 How., 188-199. Dec., 1856.

[Bk. 15, L. ed. 595; 1 Whit. 1015.]

Reversing *Ibid*, 2 Curt. 371.

Patent Law not extra territorial. Foreign patented article on foreign vessel in United States port is no infringement of domestic patent.

1. Rules governing the construction of statutes (p. 323).
2. The patent laws of the United States have no extra territorial jurisdiction (p. 323).
3. An inventor has no right of property in his invention upon which he can maintain a suit, unless he obtains a patent for it according to the acts of Congress (p. 324).
4. The rights of property and exclusive use granted to a patentee do not extend to a foreign vessel lawfully entering one of our ports, and the use of an improvement patented in the United States in the construction, fitting out, or equipment of such vessel, while she is coming into or going out of a port of the United States is not an infringement of the right of an American patentee, provided it was placed upon her in a foreign port, and authorized by the laws of the country to which she belongs (p. 328).

[Citations in the opinion of the Court:]

Commentaries on the Conflict of Laws, chap. 14, § 154, p. 322.

Caldwell *v.* Van Vlissengen, 9 Hare 416; 9 Eng. L. & Eq. 51, p. 322.

In error to the Circuit Court of the United States for the District of Massachusetts.

This action was brought in the Circuit Court of the United States for the District of Massachusetts by the plaintiff in error to recover damages for an alleged infringement of a certain patent.

The defendant demurred to the declaration, and the court below gave judgment in his favor. The plaintiff then sued out this writ of error.

Argument of counsel.

A further statement of the case appears in the opinion of the court.

Mr. Richard Henry Dana, Jr., for plaintiff in error:

The question for the court is, whether, under the circumstances of this case, there is an exemption from the operation of our patent laws, by reason of the nationality of the vessel.

Since this cause was argued in the Circuit Court, my attention has been called to the following case:

Caldwell v. Van Vlissengen, 9 Hare, 415; 9 Eng. L. & Eq. 51.

In that case the machine patented was a screw propeller. This was a substantial part of the vessel, and almost necessary to her use. The vessel was built and solely owned in Holland, where the invention was in free and common use. The affidavits set forth facts sufficient to establish an exemption, if national character can give one. The court fully considers the question, and decides against the exemption. On pp. 58, 59, the court puts the right to an injunction upon the ground that actions at law are maintainable in these cases. The court considers that the question of the exemption of foreign vessels, either entirely or in cases of reciprocity, is one of national policy, and to be dealt with by the Legislature, rather than by the courts.

After reading this decision, I wrote to Sir William Page Wood, the counsel for the respondents, then Solicitor-General, and now Vice-Chancellor, and received from him the following reply:

“31 GREAT GEORGE ST., WESTMINSTER, Nov. 6, 1855.

“MY DEAR SIR:—Your letter reached me yesterday. The case you refer me (*Caldwell v. Van Vlissengen*) was not appealed. I thought the decision was right, though it was against me. At the same time, I saw that there were inconveniences in the application of the law; and in the session of 1852, when a bill was passing through the House of Commons with reference to the amendment of the patent

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laws, I proposed the insertion of the following clause." [Here follows section 26 of the Act of 15 and 16 Victoria, ch. 83.]

The opinion of Sir William Page Wood is entitled to great weight before every judicial tribunal, as is well known to your Honors.

After this decision, the Act 15 and 16 Victoria, ch. 83 was passed, Section 26 of which is as follows (4 Chit. Stat. 217): "No letters patent for any invention (granted after the passing of this Act) shall extend to prevent the use of such invention in any foreign ship or vessel, or for the navigation of any foreign ship or vessel which may be in any port of Her Majesty's dominions, or in any waters within the jurisdiction of Her Majesty's courts, where such invention is not used for the manufacture of any goods or commodities to be vended within or exported from Her Majesty's dominions; provided always, that this enactment shall not extend to the ships or vessels of any foreign state, of which the laws authorize subjects of such foreign state, having patents or like privileges for the exclusive use or exercise of inventions within its territories, to prevent or interfere with the use of such inventions in British ships or vessels while in the ports of such foreign states or in the waters within the jurisdiction of its courts, where such inventions are not so used for the manufacture of goods or commodities to be vended within or exported from the territories of such foreign state."

Such is the state of the law in Great Britain, the greatest commercial nation of Europe. There is no reason to believe that the law of any other nation of Europe varies from that of England. Indeed, it is probable that other nations will do likewise, and keep in their own hands the power of granting or withholding such an exemption on considerations of policy, by legislation or treaty.

It is therefore respectfully suggested that the court should leave this question to the law-making and treaty-making departments of our government, in the mean time placing the law in this country upon the same basis upon which it rests in England.

Argument of counsel.

Is there any controlling reason why the court should not do this?

It is conceded that the Statute, in its terms, suggests no exemption. No interpretation of the Statute would suggest an exemption. If one is established, it must be by some imposed construction paramount over the plain language of the Acts.

The defendant's vessel, being private property, and here voluntarily for purposes of trade, has no exemption from general national jurisdiction.

Phillim. Int. Law. 367-373; The Exchange, 7 Cranch. 144; Story's Con. Laws, sec. 383.

International law respects absolute rights, the violation of which is cause of war, and comity or rights of imperfect obligation, the contravention of which is not presumed, but which each nation is competent to contravene, if it chooses. This distinction is well stated in Mr. Webster's letter to Lord Ashburton, in the appendix to Wheat. Law of Nations.

It will not be claimed that the prohibition or the use of such an article as this, in a private vessel, under these circumstances, is a violation of any absolute right secured by the law of nations. The government has the right to prohibit commerce altogether, or with particular nations, as by embargo or non-intercourse laws.

1 Kent's Com., sec. 33, *n*; Vattel, b. 2, ch. 7, sec. 94, ch. 8, sec. 100; ch. 2, secs. 25, 33; b. 1, ch. 8, sec. 90.

As a nation may prohibit trade, so it may lay conditions and restrictions.

Authorities cited *supra*: Vattel, b. 2, ch. 8, sec. 100.

The question is really under the *comitas gentium*. Between countries trading freely, is there a presumption from the law of comity that no nation will prohibit or restrict the use of such an invention under such circumstances so well settled as to authorize a court to establish the exception against the language of the Statute?

This can hardly be contended, since the case of Caldwell v. Van Vlissengen, and the Act 15 and 16 Victoria.

This is not a question of property or the domicil or *situs*

Argument of counsel.

of property. We admit the property in the article to be in the defendant; that it is part of the national wealth of France, and has its *situs* in France for purposes of taxation, and for all national purposes.

Hays v. Pacific Co., 17 How. 596.

The question is upon the restriction of its use within our dominions.

As the use of the machine is not alleged to be necessary, and the presence of the vessel here is voluntary, if the comity of nations does not allow the prohibition in this case, it would forbid it in all cases of patents; and vessels nominally owned in the British provinces and in the West India Islands may use all our nautical patents.

The foreigner and his personal property are subject to all burdens, taxes, and duties relating to the police and economical regulations of a state.

Vattel, b. 2, ch. 8, sec. 106.

They are subject to imposts and duties, prohibitions and restrictions.

Vattel, b. 2, ch. 8, sec. 106. 1 Kent's Com. 35.

The patent and copyright laws of a country stand upon the same ground with navigation laws, and laws prohibiting altogether or restricting certain kinds of trade for economical purposes, or to add to the military resources and strength, or to increase the effective power and industry of a country, or to develop its genius. As to these, each nation is the proper judge of its own policy.

Vattel, b. 2, ch. 2, secs. 25, 33.

Indeed, Vattel (b. 1, ch. 20, sec. 255) seems to define the police regulations of a country, so as to include patent laws.

In this state of the international law, and in the absence of all direct decisions in support of the defendant's position, it is respectfully suggested that the question should be treated as a political, rather than a legal question, and the British precedent be followed by the court, until Congress or the treaty-making powers shall act upon it.

Argument of counsel.

Messrs. Austin and Goodrich, for defendant in error:

1. Foreign vessels entering a port of the United States, by the express or implied permission of the government, do so under an implied immunity and reservation of the right belonging to them by the laws of the country to which they belong, with an implied understanding that the persons on board shall not violate the peace or domestic laws of the country.

Vattel's Law of Nations, b. 2, ch. 8, sec. 101.

The Alcyon, coming from the Island of Miquelon, may be deemed to have entered a port of the United States by express permission.

5 U. S. Stat. at L. 748, ch. 66, which specially mentions this island.

The question is, whether the patent law can be properly so construed as to include a use of said gaff saddle, notwithstanding the circumstances under which the said gaff saddle was incorporated into the structure of the Alcyon, and notwithstanding the express or implied permission of the United States by force of which she entered a port of the United States.

2. What shall or does constitute a vessel, must be determined exclusively by the law of the country to which the vessel belongs, *i. e.*, by the law of the owner's domicil.

This follows necessarily from general maxims of international jurisprudence.

Story on Con. of Laws, secs. 18, 20.

In order to ascertain what is or is not real property, we must resort to the *lex loci rei*.

Story Con. Laws, secs. 382, 447, so as of what is or what is not a corporation; Bank to Augusta *v.* Earle, 13 Pet. 519.

The Alcyon, although in the port of the United States, was still within the jurisdiction of France.

Children born on board of her while in Boston harbor, would have been French subjects.

Vattel L. of N., b. 1. ch. 19, sec. 216.

In re Bruce, Cromp. & I. 437, and *Thompson v. The Advocate-General*, 12 Clark & F. 1; *U. S. v. Wiltberger*, 5 Wheat. 76.

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The gaff saddle was rightfully part of the vessel by French laws.

Therefore, if the United States patent law operated to prevent the defendant from using the gaff saddle while in the harbor of Boston, notwithstanding it was part of his vessel, without plaintiff's permission, it operated just so far to impose a restriction of the implied permission accorded by the United States to all French vessels to enter the ports of the United States, and upon the express permission accorded to all French vessels from Miquelon.

The statutes of the United States relating to patents were not intended to affect, and do not affect, foreign vessels coming into the ports of the United States.

1st. The statutes of a country relating to patents are not such laws as a foreigner visiting this country temporarily, and not to become a resident, is bound to obey, so far as those laws relate merely to the use of articles purchased abroad and brought into the country solely for the personal use of the party in possession while a transient visitor.

Vattel L. of N., b. 2, ch. 8, secs. 101, 106, 109; Boulleinois *Traite des Statutes*, pp. 2, 3, 4; Universities of Oxford and Cambridge *v.* Richardson, 6 Ves., Jr. 689, which entirely supports this position.

2d. The United States, in granting Letters Patent, or any other exclusive privilege to a citizen, necessarily always reserve by implication their own rights of sovereignty, which are not to be affected by any individual or private privilege.

Examples of the application of this principle, are as follows:

(a) In regard to the right of eminent domain.

This exists inherently in every government.

Vattel's L. of N., b. 1, ch. 20, sec. 244; Bonaparte *v.* The C. & A. R. R. Co., 1 Bald. 220.

Independently of the principle that the right of eminent domain, being an attribute of sovereignty, could not be conveyed away, the conclusion above stated follows from the rule that in public grants nothing passes by implication.

U. S. *v.* Arredondo, 6 Pet. 738; Jackson *v.* Lamphire, 3 Pet. 289.

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(b) The constitutional power of Congress over commerce.

This power extends to navigation. 2 Sto. Com. on Con., sec. 1060, and to every species of commercial intercourse. 2 Sto. Com. on Con. 1061.

In the exercise of this power, Congress, in 1845, after the date of the plaintiff's patent, passed the law relating to French vessels coming from Miquelon, which law makes no exception as to the kind of vessel, or the mode of its rig, or the peculiarities of its structure.

As the grant to the plaintiff and the act of 1845 are in direct opposition, the grant must be construed against grantee.

Mills v. St. Clair County, 8 How. 569.

The defendant does not contend that he would have a right to bring into a port of the United States a cargo or any number of these contrivances for sale; nor even that he had a right to detach and sell that on board of The Alcyon. In this argument the gaff saddle is deemed a part of the schooner, in the same way as fixtures are parts of the realty.

(c) The power of Congress to alienate a portion of its territory.

This power exists in every government.

Vattel's L. of N., b. 1, ch. 21, sec. 263.

It was exercised in the Treaty of Washington, 1842.

8 U. S. Stat. at L. 572.

Every patent right then existing, extended over the whole country as then bounded. The alienation of a portion of the territory diminished the value, by diminishing the extent of every existing patent right; but they were all granted subject to the implied reservation of power on the part of the government, thus to diminish their value.

(d) The private right of every patentee is subject to the public right of the government to admit into the ports of the United States any foreign vessel, free from any private or public charges, tolls, or burdens, other than those imposed by treaty or the laws of nations.

The Attorney-General v. Burridge, 10 Price 350; *Same v. Parmeter*, 10 Price 378; *Parmeter v. Gibbs*, 10 Price, 412.

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The cases cited are exactly analogous in principle to the case at bar.

In the citations, the *jus privatum* was a grant by Charles I., of his property in land between high and low water mark; and the *jus publicum*, with which it interfered was the right of the public freely to pass and repass, upon the salt water, between high and low water mark.

In the present case the *jus privatum* is the exclusive right granted to the plaintiff to use within the jurisdiction of the United States a certain machine; and the *jus publicum* with which it interferes, is the right the public has to the free admission into the ports of the United States of all foreign vessels, being such according to the law of the country where they belong.

The grant by Charles I. of land between high and low water mark, was held void so far as it prevented this free passage. By parity of reasoning, the letters patent of the plaintiff must be held void, or rather as never having extended to foreign vessels visiting the ports of the United States, as The Alcyon visited Boston.

The principle here contended for, as it applies to ports and harbors, is clearly stated by Lord Hale, in his treatise *De Jure Maris*, cap. 6, p. 35, and in the *Treatise de Portibus Maris*, ch. on the *jus publicum*, p. 84, 89. "When a port is fixed and settled" * * * "though the soil and franchise, and dominion thereof *prima facie* be in the King, or by derivation from him in a subject, yet that *jus privatum* is clothed and superinduced with a *jus publicum*." So in the case at bar, the *jus privatum* of the patentee is subject to the *jus publicum* by which foreign vessels, however constructed, may enter our ports. This government, never having undertaken to decide, nor ever having granted to an individual the right to decide for the government, that certain vessels, or vessels constructed partly or wholly in a certain way, shall not enter our ports without paying a toll, or charge, or duty not imposed by treaty or special laws relating thereto.

3. The statutes relating to patents cannot properly be so construed as to include machines or contrivances forming

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a part of the original structure of foreign vessels entering the ports of the United States, as The Alcyon entered Boston harbor.

(a) Because such construction, for the reasons above stated, would introduce public mischiefs and manifest incongruities.

Sawin *v.* Guild, 1 Gall. 485; Talbot *v.* Seeman, 1 Cranch 1; Murray *v.* The Charming Betsey, 2 Cranch 64.

(b) These statutes were passed *alio intuitu*.

The reasoning of Judge Curtis in the opinion delivered by him in the case [Brown *v.* Duchesne, 2 Curt. 371]; also Lessee of Brewer *v.* Blougher, 14 Pet. 178. "The laws will restrain the operation of a statute within narrower limits than its words import, if the literal meaning of its language would extend to cases which the Legislature never designed to embrace in it," 198.

It cannot be supposed that Congress intended the statutes on patents to confer a right on a patentee, to interfere in any way with the exercise of a license conferred by government on a foreign vessel.

The same doctrine in Minor *v.* Mechanics' Bank of Alexandria, 1 Pet. 64.

4. Letters patent of the United States confer upon the grantee the exclusive right to the subject matter of the patent, to be exercised within their jurisdiction. A foreign ship coming within one of the ports of the United States with their express or implied permission, is without the jurisdiction within which this exclusive right is to be exercised.

(a) Foreigners within the territorial jurisdiction of a country, may yet be within its municipal jurisdiction for no purpose whatever. Such is the *status* of public ministers (Wheat. Elements on L. of N., part 3, ch. 1, sec. 14; part 2, ch. 2, sec. 9), and of foreign sovereigns entering the territory of another, and of foreign armies marching, &c., through the territory, and of a foreign ship of war.

Wheat. Elements of L. of N., part 3. ch. 1, sec. 14; part 2, ch. 2, sec. 9; The Exchange *v.* McFadden, 7 Cranch 135, 147.

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(b) Foreigners within the territory may be within the municipal jurisdiction of a country for all purposes. This is the *status* of foreigners who come into the country *animo manendi* becoming inhabitants.

Vattel's L. of N., b. 1. ch. 19, sec. 213.

(c) Foreigners within the territorial, may be within the municipal jurisdiction for some purposes and not for others. This is the case with transient persons and consuls. Vattel's L. of N., b. 2, ch. 8, secs. 205, 206, 208, 209.

Wheat. Elements, part 3, ch. 1, sec. 23.

The same principle applies to a part of a country in temporary possession of an enemy.

U. S. v. Hayward, 2 Gall. 485.

The goods imported and not entered, although within the territorial jurisdiction of the State, they are not subject to its municipal jurisdiction.

Harris v. Dennie, 3 Pet. 292.

This principle applies to a foreign commercial vessel visiting a port of the United States. It is within the jurisdiction of the United States so far that persons on board are bound to do no act against the public peace, or *contra bonos mores*, or against the revenue laws, &c., &c. But "for all the personal relations and responsibilities existing in the ship at the time she entered a port, and established or permitted by the laws of her own country, her authorities are answerable only at home; and to interfere with them in discharge of the duties imposed upon them, or the exercise of the powers vested in them, by those laws, on the ground of their being inconsistent with the municipal legislation of the country where the ship happens to be lying, is to assert for that legislation a superiority not acknowledged by the law and inconsistent with the independence of nations."

Mr. Legare's opinion, 4 op. of Atty-Gen. 98-102; Same Point, 6 Web. Works, 303.

5. The case of Caldwell v. Van Vlissengen, 9 Hare, 415; 9 Eng. L. & Eq. 51, will be cited by plaintiff in error as deciding the point before the court. On this point the defendants say:

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1st. It will be regarded by this court only so far as the reasoning commends itself to the court as sound.

2d. The case was not placed upon the grounds assumed in the case at bar. The principles here contended for were neither considered nor even presented to the court.

3d. The Statute of 15 and 16 Victoria, ch. 83, sec. 26, was passed in evident recognition of the existence and propriety of the principles of international law, contended for by the defendant in error.

Mr. Chief Justice TANEY delivered the opinion of the court.

This case comes before the court upon a writ of error to the Circuit Court of the United States for the District of Massachusetts.

The plaintiff in error, who was also plaintiff in the court below, brought this action against the defendant for the infringement of a patent which the plaintiff had obtained for a new and useful improvement in constructing the gaff of sailing vessels. The declaration is in the usual form, and alleges that the defendant used this improvement at Boston without his consent. The defendant pleaded that the improvement in question was used by him only in the gaffs of a French schooner, called The Alcyon, of which schooner he was master; that he (the defendant) was a subject of the Empire of France; that the vessel was built in France, and owned and manned by French subjects; and, at the time of the alleged infringement, was upon a lawful voyage, under the flag of France, from St. Peters, in the Island of Miquelon, one of the colonies of France, to Boston, and thence back to St. Peters, which voyage was not ended at the date of the alleged infringement; and that the gaffs he used were placed on the schooner at or near the time she was launched by the builder, in order to fit her for sea.

There is also a second plea containing the same allegations, with the additional averment that the improvement in question had been in common use in French merchant vessels for more than twenty years before The Alcyon was built, and

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was the common and well-known property of every French subject long before the plaintiff obtained his patent.

The plaintiff demurred generally to each of these pleas, and the defendant joined in demurrer; and the judgment of the Circuit Court being in favor of the defendant, the plaintiff thereupon brought this writ of error.

The plaintiff, by his demurrer, admits that The Alcyon was a foreign vessel, lawfully in a port of the United States, for the purposes of commerce, and that the improvement in question was placed on her in a foreign port to fit her for sea, and was authorized by the laws of the country to which she belonged. The question therefore, presented by the first plea, is simply this: whether any improvement in the construction or equipment of a foreign vessel, for which a patent has been obtained in the United States, can be used by such vessel within the jurisdiction of the United States while she is temporarily there for the purposes of commerce, without the consent of the patentee.

This question depends on the construction of the patent laws. For undoubtedly every person who is found within the limits of a government, whether for temporary purposes or as a resident, is bound by its laws. The doctrine upon this subject is correctly stated by Mr. Justice STORY, in his "Commentaries on the Conflict of Laws" (chap. 14, sec. 541,), and the writers on public law to whom he refers. A difficulty may sometimes arise in determining whether a particular law applies to the citizen of a foreign country, and intended to subject him to its provisions. But if the law applies to him, and embraces his case, it is unquestionably binding upon him when he is within the jurisdiction of the United States.

The general words used in the clause of the patent laws granting the exclusive right to the patentee to use the improvement, taken by themselves, and literally construed without regard to the object in view, would seem to sanction the claim of the plaintiff. But this mode of expounding a statute has never been adopted by any enlightened tribunal, because it is evident that in many cases it would defeat the object which the Legislature intended to accom-

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plish. And it is well settled that, in interpreting a statute, the court will not look merely to a particular clause in which general words may be used, but will take in connection with it the whole statute (or statutes on the same subject) and the objects and policy of the law, as indicated by its various provisions, and give to it such a construction as will carry into execution the will of the Legislature, as thus ascertained, according to its true intent and meaning.

Neither will the court, in expounding a statute, give to it a construction which would in any degree disarm the government of a power which has been confided to it to be used for the general good—or which would enable individuals to embarrass it, in the discharge of the high duties it owes to the community—unless plain and express words indicated that such was the intention of the Legislature.

The patent laws are authorized by that article in the Constitution which provides that Congress shall have power to promote the progress of science and useful arts, by securing for limited times to authors and inventors the exclusive right to their respective writings and discoveries. The power thus granted is domestic in its character, and necessarily confined within the limits of the United States. It confers no power on Congress to regulate commerce, or the vehicles of commerce, which belong to a foreign nation, and occasionally visit our ports in their commercial pursuits. That power and the treaty-making power of the general government are separate and distinct powers from the one of which we are now speaking, and are granted by separate and different clauses, and are in no degree connected with it. And when Congress are legislating to protect authors and inventors, their attention is necessarily attracted to the authority under which they are acting, and it ought not lightly to be presumed that they intended to go beyond it, and exercise another and distinct power, conferred on them for a different purpose.

Nor is there anything in the patent laws that should lead to a different conclusion. They are all manifestly intended to carry into execution this particular power. They secure to the inventor a just remuneration from those who derive

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a profit or advantage, within the United States, from his genius and mental labors.

But the right of property which a patentee has in his invention, and his right to its exclusive use, is derived altogether from these statutory provisions ; and this court have always held that an inventor has no right of property in his invention, upon which he can maintain a suit, unless he obtains a patent for it, according to the Acts of Congress ; and that his rights are to be regulated and measured by these laws, and cannot go beyond them.

But these Acts of Congress do not, and were not intended to, operate beyond the limits of the United States ; and as the patentee's right of property and exclusive use is derived from them, they cannot extend beyond the limits to which the law itself is confined. And the use of it outside of the jurisdiction of the United States is not an infringement of his rights, and he has no claim to any compensation for the profit or advantage the party may derive from it.

The chief and almost only advantage which the defendant derived from the use of this improvement was on the high seas, and in other places out of the jurisdiction of the United States. The plea avers that it was placed on her to fit her for sea. If it had been manufactured on her deck while she was lying in the port of Boston, or if the captain had sold it there, he would undoubtedly have trespassed upon the rights of the plaintiff, and would have been justly answerable for the profit and advantage he thereby obtained. For, by coming in competition with the plaintiff, where the plaintiff was entitled to the exclusive use, he thereby diminished the value of his property. Justice, therefore, as well as the Act of Congress, would require that he should compensate the patentee for the injury he sustained, and the benefit and advantage which he (the defendant) derived from the invention.

But, so far as the mere use is concerned, the vessel could hardly be said to use it while she was at anchor in the port, or lay at the wharf. It was certainly of no value to her while she was in the harbor ; and the only use made of it which can be supposed to interfere with the rights of the

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plaintiff, was in navigating the vessel into and out of the harbor, when she arrived or was about to depart, and while she was within the jurisdiction of the United States. Now, it is obvious that the plaintiff sustained no damage, and the defendant derived no material advantage, from the use of an improvement of this kind by a foreign vessel in a single voyage to the United States, or from occasional voyages in the ordinary pursuits of commerce; or if any damage is sustained on the one side, or any profit or advantage gained on the other, it is so minute that it is incapable of any appreciable value.

But it seems to be supposed that this user of the improvement was, by legal intendment, a trespass upon the rights of the plaintiff; and that although no real damage was sustained by the plaintiff, and no profit or advantage gained by the defendant, the law presumes a damage, and that the action may be maintained on that ground. In other words, that there is a technical damage, in the eye of the law, although none has really been sustained.

This view of the subject, however, presupposes that the patent laws embrace improvements on foreign ships, lawfully made in their own country, which have been patented here. But that is the question in controversy. And the court is of opinion that cases of that kind were not in the contemplation of Congress in enacting the patent laws, and cannot, upon any sound construction, be regarded as embraced in them. For such a construction would be inconsistent with the principles that lie at the foundation of these laws; and instead of conferring legal rights on the inventor, in order to do equal justice between him and those who profit by his invention, they would confer a power to exact damages where no real damage had been sustained, and would moreover seriously embarrass the commerce of the country with foreign nations. We think these laws ought to be construed in the spirit in which they were made—that is, as founded in justice—and should not be strained by technical constructions to reach cases which Congress evidently could not have contemplated, without departing from the principle upon which they were legis-

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lating, and going far beyond the object they intended to accomplish.

The construction claimed by the plaintiff would confer on patentees not only rights of property, but also political power, and enable them to embarrass the treaty-making power in its negotiations with foreign nations, and also to interfere with the legislation of Congress when exercising its constitutional power to regulate commerce. And if the treaty should be negotiated with a foreign nation, by which the vessels of each party were to be freely admitted into the ports of the other, upon equal terms with its own, upon the payment of the ordinary port charges, and the foreign government faithfully carried it into execution, yet the government of the United States would find itself unable to fulfill its obligations if the foreign ship had about her, in her construction or equipment, anything for which a patent had been granted. And after paying the port and other charges to which she was subject by the treaty, the master would be met with a further demand, the amount of which was not even regulated by law, but depended upon the will of a private individual.

And it will be remembered that the demand, if well founded in the patent laws, could not be controlled or put aside by the treaty. For, by the laws of the United States, the rights of a party under a patent are his private property; and by the Constitution of the United States, private property cannot be taken for public use without just compensation. And in the case I have just stated, the government would be unable to carry into effect its treaty stipulations without the consent of the patentee, unless it resorted to its right of eminent domain, and went through the tedious and expensive process of condemning so much of the right of property of the patentee as related to foreign vessels, and paying him such a compensation therefor as should be awarded to him by the proper tribunal. The same difficulty would exist in executing a law of Congress in relation to foreign ships and vessels trading to this country. And it is impossible to suppose that Congress in passing these laws could have intended to confer on the patentee a right of

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private property which would, in effect, enable him to exercise political power, and which the government would be obliged to regain by purchase, or by the power of its eminent domain, before it could fully and freely exercise the great power of regulating commerce, in which the whole nation has an interest. The patent laws were passed to accomplish a different purpose, and with an eye to a different object; and the right to interfere in foreign intercourse, or with foreign ships visiting our ports, was evidently not in the mind of the Legislature, nor intended to be granted to the patentee.

Congress may, unquestionably, under its power to regulate commerce, prohibit any foreign ship from entering our ports, which in its construction or equipment, uses any improvement patented in this country, or may prescribe the terms and regulations upon which such vessels shall be allowed to enter. Yet it may perhaps be doubted whether Congress could by law confer on an individual or individuals a right which would in any degree impair the constitutional powers of the Legislative or Executive Departments of the government, or which might put it in their power to embarrass our commerce and intercourse with foreign nations, or endanger our amicable relations. But, however that may be, we are satisfied that no sound rule of interpretation would justify the court in giving to the general words used in the patent laws the extended construction claimed by the plaintiff, in a case like this, where public rights and the interests of the whole community are concerned.

The case of *Caldwell v. Van Vlissengen*, 9 Hare 416; 9 Eng. L. & Eq. 51, and the Statute passed by the British Parliament in consequence of that decision, have been referred to and relied on in the argument. The reasoning of the Vice-Chancellor is certainly entitled to much respect, and it is not for this court to question the correctness of the decision, or the construction given to the Statute of Henry VIII.

But we must interpret our patent laws with reference to our own Constitution and laws and judicial decisions. And the court are of opinion that the rights of property and ex-

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clusive use granted to a patentee does not extend to a foreign vessel lawfully entering one of our ports; and that the use of such improvement in the construction, fitting out, or equipment of such vessel, while she is coming into or going out of a port of the United States, is not an infringement of the rights of an American patentee, provided it was placed upon her in a foreign port, and authorized by the laws of the country to which she belongs.

In this view of the subject, it is unnecessary to say anything in relation to the second plea of the defendant, since the matters relied on in the first are sufficient to bar the plaintiff of his action, without the aid of the additional averments contained in the second.

The judgment of the Circuit Court must therefore be affirmed.

Notes :**1. Rules as to construction of statutes.**

Evans v. Jordan, 9 Cranch 199. [4 Am. and Eng. 7.]
Wilson v. Rousseau, 4 How. 646. [4 Am. and Eng. 426.]

2. Inventor has no rights until he obtains a patent.

Gayler v. Wilder, 10 How. 477 [4 Am. & Eng. 188].

Patent in Suit :

Brown, John. December 31, 1838. Gaff for Sail Vessels.

Cited :**IN CIRCUIT COURTS :**

Gardiner v. Howe, May, 1865. 2 Cliff. 462.

Notes and Citations.

IN TEXT-BOOKS:

2 Abb. Pat. Law, 1886, pp. 3, 5, 6, 215.
Walker on Pats., 1883, pp. 100, 101, 111.
Curtis on Pats., 4th ed., §§ 289, 405a.

*Syllabus.***ISAAC HARTSHORN AND DANIEL HAYWARD,
PLAINTIFFS IN ERROR v. HORACE H. DAY.****19 How. 211-224. Dec. 1856.**

[Bk. 15, L. ed. 605; 1 Whit. 1031.]

Particular agreements construed.

1. Where, in consideration of an annuity and an indemnity for the expenses of procuring the extension of a certain patent, A appointed B his "trustee and attorney irrevocable to hold said patent, and to have control thereof," in order that it might "inure to the benefit of C," a part owner, "and those who hold a right to the use of said patent under and in connection with his (C's) licensees," reserving the right to use the improvement in his own business, and C acquiesced in the agreement; *held* that the entire interest and ownership in the patent passed to B for the benefit of C, his licensees, and those holding under him (p. 346).
2. *Held* further, that the right to the annuity was not a condition to the vesting of the interest in B, but rested in covenant of an agreement of prior date, and that on a failure to pay it regularly, the power of attorney could not be revoked (p. 348).
3. The agreement being a sealed instrument, having been partly executed, and long standing rights having grown up under it, evidence that it had been procured through fraudulent representations on the part of B, should not have been admitted (p. 349).

[Citations in the opinion of the Court:]

- Brooks v. Stolly, 3 McLean 526, p. 348.
Woodworth v. Weed, 1 Blatch. 165, p. 348.
Vrooman v. Phelps, 2 Johns. 177, p. 349.
Dorr v. Munsell, 13 Johns. 430, p. 349.
Welch v. Hicks, 5 Cow. 506, p. 349.
Smith v. Smith, 4 Wend. 471, p. 349.
Taylor v. King, 6 Munf. 358, p. 349.
Wyche v. Macklin, 2 Rand. 426, p. 349.
Stoever v. Weir, 10 S. & R. 25, p. 349.
Hisa, admxr, v. Lucas, 14 S. & R. 208, p. 349.

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Mordecai v. Yankersley, 1 Ala. 100, p. 349.

Burrows v. Alter, 7 Mo. 424, p. 349.

Donaldson v. Benton, 4 Dev. & Bat. 436, p. 349.

C. & H. Notes, part 2, p. 615, note 306 ed. Gould & Banks, 1850, p. 349.

(Mr. Justice CURTIS, having been of counsel, did not sit in this cause.)

In error to the Circuit Court of the United States for the District of Rhode Island.

This action was brought in the Circuit Court of the United States for the District of Rhode Island, by the defendant in error, against Isaac Hartshorn and Daniel Hayward, to recover damages for the infringement of a certain patent granted to one Chaffee, which had been assigned by him to the plaintiff.

The defendants pleaded the general issue, and also four special pleas. They also gave notice of several defenses under the plea of general issue. The plaintiff demurred to the four special pleas, and the demurrer was sustained by the court.

The questions at issue were very fully investigated on the trial below, the trial occupying a period of six weeks. It resulted in a verdict and judgment in behalf of the plaintiff for \$4,000 damages, with costs.

The defendants then brought the case here on a writ of error.

The record of the case covers over 1,000 printed pages. It would be difficult to give here any adequate idea of its contents, and no attempt is made to do so, as the case sufficiently appears in the opinion of the court.

Messrs. *James T. Brady*, *Chas. O'Connor* and *Samuel Ames*, for plaintiffs in error:

1. The agreement of May 23, 1850, was a valid executory agreement by Chaffee, to sell and convey to Goodyear the renewed patent when it should issue. Upon its issue, the equitable ownership vested in Goodyear.

(a) Such a future possibility may be effectually assigned, and when done fairly for a good consideration, is consistent with the patent laws.

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5 Stat. at L., 121, secs. 11, 18; Curtis on Patents, secs. 188, 189, 260; *Woodworth v. Sherman*, 3 Story, 171; *Wilson v. Rousseau*, 4 How. 678, 680, 690, 691, 693, 694, 702, [4 Am. & Eng. 436].

(b) Chaffee had a right to demand the payment of the \$1,500 at the very time when the assignment was to be made.

Tompkins v. Elliott, 5 Wend. 498.

2. Chaffee having by the agreement of September 5, 1850, without notice to Goodyear, without his consent, and, as it would appear, against his will, made another deposition of the patent, and having thereby put it entirely out of his (Chaffee's) power to execute a formal assignment to Good-year, and thus entitle himself to the payment of the \$1,500 by Goodyear, which formed the only condition precedent to the complete investiture of Goodyear with at least the whole equitable ownership of the patent, he, Chaffee, and Day, his assignee, are precluded from availing themselves of such non-payment by Goodyear, as an objection to the use of the patented invention by Goodyear and his licensees.

Hochster v. De La Tour, 2 El. & B. 688, and cases cited.

(a) This proposition is not in any way affected by the circumstances that the agreement of September 5, 1850, recites an agreement between Chaffee and Goodyear, different from that which is contained in the instrument of May 23, 1850.

(b) Neither is the proposition above stated affected by the circumstances of Judson's connection with the agency for Goodyear and his licensee, or by Judson's defects in performing any engagement into which he entered, by the instrument of September 5, 1850.

3. The agreement between Chaffee and Judson, dated September 5, 1850, construed by itself alone or in connection with the supplement thereto, dated November 12, 1851, and whether read in the light of surrounding and attending circumstances or without such aid (*Smith v. Bell*, 6 Pet. 68), was, on the part of Chaffee, an executed contract. No further act of any kind was to be performed on his part; and as it contained no condition subsequent or

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any clause of cessor, nor any reservation of power to rescind for any cause, the interest vested by it in Judson and his *cestuis que trust*, could not be divested by Judson's omission to make prompt and punctual payments of the annuity.

Brooks v. Stolley, 3 McLean, 526; *Woodworth v. Weed*, 1 Blatchf. 165.

(a) The defense rested on the title claimed under an executed contract, and consequently the decisions, touching the performance of a condition precedent, required to be averred and proved in actions at common law to enforce the performance of executory contracts, have no application. But if the principle of those decisions were applied, it would not justify the rescission attempted in the case.

Cunningham v. Morrell, 10 Johns. 338; *Tompkins v. Elliot*, 5 Wend. 498; *Philadelphia, &c., R. R. v. How.*, 13 How. 339.

(b) The most familiar principles of law were violated by the instruction that Chaffee had a right to rescind this transfer, in case Mr. Judson and the licensees had not lived up to the agreement, by regularly paying the installments of Chaffee's annuities.

Boone v. Eyre, 1 H. Bl. 273, *no'e*; *Chanter v. Leese*, 5 Mees & W. 698 [3 Am. & Eng. 41].

4. Although it is not deemed material whether the interest acquired by Judson, under the agreements between him and Chaffee, was of an equitable or legal character, it is submitted that the whole legal title to the patent was thereby vested in Judson, subject to the license reserved to Chaffee, to use the invention in his own business.

No particular form of words being required to constitute a legal assignment of a patent, and as Judson was constituted a "trustee to hold said patent and have control of it," it seems clear that the ownership was transferred to him.

Tiernan v. Jackson, 5 Pet. 580; *Rogers v. Lindsey*, 13 How. 444; *Hunt v. Rousmanier*, 8 Wheat. 174.

5. If the grant or agreement of September 5, 1850, is to be regarded as having been authenticated by the seal of

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Chaffee, and the actual execution by him, when of sound mind, full age, and with knowledge of its contents was established, neither Chaffee nor Day, the plaintiff, who was his assignee and privy in estate, could be permitted to allege or prove in a court of common law, for the purpose of defeating such grant or agreement, or for the purpose of varying its effect, that Chaffee was induced to execute it by threats of a lawsuit or of hostility, or by false, deceitful, or fraudulent representations.

(a) This proposition is consistent with those decisions which allow a party to a deed to show that his agent, attorney, or trustee by whom it was executed, or the agent of the law for that purpose, transcended or did not pursue his authority, and it is also consistent with the decisions which allow a stranger to a transaction to impeach it for fraud upon him.

Jackson v. Crafts, 18 Johns. 113; *Rhoades v. Selin* 4 Wash. C. C. 721; *Swayze v. Burke*, 12 Pet. 23; *Gregg v. Sayre*, 8 Pet. 244; *Rogers v. Brent*, 5 Gill. 579; *Krider v. Lafferty*, 1 Whart. 314; (*Muzzy v. Whitney*), 10 Johns. 229; (*Evans v. Wells*), 22 Wend. 345; (*Woodman v. Eastman*), 10 N. H. 365.

(b) It is also consistent with the cases which allow the consideration clause of a conveyance by deed to be contradicted, explained, or varied by parol proof.

McCrea v. Purmort 16 Wend. 473; *Wilkinson v. Scott*, 17 Mass. 257.

(c) It is consistent with the cases allowing a party to a contract, who had been deceived, to elect that such contract should stand, and maintain an independent action against the deceiver for fraud.

Allaire v. Whitney, 1 Hill, 486; (*Whitney v. Allaire*), 1 N. Y. 308; *Lome v. Tucker*, 4 C. & P. 15.

(d) It is well established that such evidence is not admissible for such a purpose in a court of common law.

Legh v. Legh, Bos. & B. 447; (*Alner v. George*), 1 Camp. N. P. 393; *Mason v. Ditchbourne*, 1 Moo. & R. 460; *Edwards v. Brown*, 1 Tyrw. 182, 196; *Van Valkenburg v. Rouk*, 12 Johns. 338; *Vrooman v Phelps*, 2 Johns. 179;

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Dorr *v.* Munsell, 13 Johns. 431; Parker *v.* Parmele, 20 Johns. 134; Franchot *v.* Leach, 5 Cow. 507; Stevens *v.* Judson, 4 Wend. 473; Dale *v.* Roosevelt, 9 Cow. 311; Slocum *v.* Despard, 8 Wend. 619; (Whitney *v.* Allaire), 1 N. Y. 310; Fay *v.* Richards, 21 Wend. 627.

6. The court below erred in admitting the evidence of Woodman and Chaffee touching the alleged fraudulent representations, and also in submitting the allegation of fraud to the jury, notwithstanding Woodman's professed non-recollection that the instrument bore a seal when executed, and his asserted but groundless disbelief of that fact.

Deed, or not, was the only question for the jury.

Winchell *v.* Latham, 6 Cow. 689; Curtis *v.* Hall, 1 South. (N. J.) 148; Pocock *v.* Hendricks, 8 G. & J. 427.

The admission in the agreement of Nov. 12, 1851, was conclusive evidence that Chaffee's transfer of Sept. 5, 1850, was under seal.

Carver *v.* Astor, 4 Pet. 83; Crane *v.* Morris, 6 Pet. 609; Sprigg *v.* Bank, 10 Pet. 265; Denn *v.* Brewer, Coxe, N. J. 172; Lainson *v.* Tremere, 1 Ad. & E. 792; Hosier *v.* Searle, 2 Bos. & P. 302; Bowman *v.* Taylor, 2 Ad. & E. 278 [2 Am. & Eng. 60]; (Brooks *v.* Stolly), 3 McLean 526; (Parker *v.* Parmele), 20 Johns. 134; Cutler *v.* Bower, 11 Ad. & E., N. S. 985.

7. Independently of the positions assumed in the preceding fifth and sixth points, the court erred in submitting it to the jury, to find that the instrument of Sept. 5, 1850, was obtained by fraud, because there was no legal evidence in the case to support that allegation.

The party alleging the fraud admitted on his examination that he was not misled or deceived. It was immaterial whether Judson's representations were true or not.

Story's Eq., sec. 203.

Eighth point. The third and fourth pleas were good.

Ninth point. The judgment on the demurrer to the third and fourth pleas should be reversed, and the verdict set aside.

Messrs. N. Richardson, T. A. Jenckes, F. P. Stanton,
and R. H. Gillet, for the defendant in error:

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The counsel, after discussing the validity of the patent, the claim of infringement, of damages, and the rulings upon the evidence, proceeded as follows:

1. The paper on the 5th of September, 1850, supposing it to have been untainted with fraud, conveyed no interest in the extended patent to Judson, or to Goodyear and his licensees. There is no word of grant or conveyance in it. It does not purport to give a license directly to Goodyear or his licensees. It gives Judson no power to grant licenses to any one.

The facts disclosed by the instrument, and with reference to which it was made, are:

First. That Chaffee had procured an extension of his patent.

Second. That previous to the extension, the patent had stood in the name of Charles Goodyear, who held it for the benefit of himself and his licensees.

Third. That Goodyear for himself, and the previous licensees of the Chaffee patent under Goodyear, had agreed to be at the expense of applying for the extension, and to pay an allowance for the use of the patent, if extended.

Fourth. That Goodyear and these licensees have failed to perform this contract, and that William Judson, who had been the managing agent for Chaffee in procuring the extension, had intervened and paid individually, or become liable to pay, the expenses of procuring the extension.

Fifth. That Chaffee was liable to pay these expenses to Judson, the amount of which had been large, and was then uncertain.

The object of the paper was twofold :

First. To provide means to pay Judson for his outlay and services

Second. To provide that Goodyear and the former licensees under Goodyear should have the benefit of the agreement recited, upon their coming in and performing the conditions required of them. With this view Chaffee appointed Judson his attorney and trustee, to hold and to have control of the patent, so that these objects might be effected.

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Chaffee agreed that he would not license any others than the former licensees without Judson's consent.

This contract was entirely executory, and subject to rescission at any time for the failure to comply with its provisions.

2. The paper of Sept. 5, 1850, offered a license to no person, except those who had a right to use the Chaffee patent at the time of its extension. Hartshorn had no license to use the inventions of either Goodyear or Chaffee, during the original term of the Chaffee patent. His license to use Goodyear's inventions was given on the 1st of February, 1851.

3. The legal title of the patent remained in Chaffee, and any action at law for an infringement must have been brought in his name before his assignment to the defendant in error.

4. The instrument bearing date Nov. 12, 1851, being between the same parties, and having relation to the same subject matter, and purporting to be made for the purpose of correcting errors and omissions in the instrument of Sept. 5, 1850, the two must be taken together as one instrument, and be so construed.

5. This instrument makes clear what was of doubtful construction in the former paper, and defines and limits the power of Judson, and the rights and interests which Goodyear and his licensees were to receive, and sets forth the conditions on which they were to receive them.

Judson is, for the first time, empowered to grant licenses as Chaffee's attorney, and Goodyear and his licensees are to have licenses through Judson, solely upon the condition of their severally contributing their share of the amount due Judson for services and expenses.

Mr. Judson was not empowered to license any others but the Goodyear licensees.

With respect to all other persons, the power to license was annexed to the legal title which remained in Chaffee. Judson was authorized to sue infringers, but he was not required to do so. If the Goodyear licensees should not comply with the condition on which they were to receive

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the license to use the Chaffee patent, they might be sued as infringers, and Judson could reimburse himself out of the damages, or by compromising the suit by giving them a license on the terms required. Chaffee had a right to impose this or any other condition, and he was interested in having this condition performed, as he would thereby be relieved from his debt to Judson.

6. So far as regards the rights of Chaffee, Goodyear and his licensees, and Judson, this instrument is a substitute for the provisions respecting the same subject matter in that of September 5, 1850.

These parties are bound by the facts recited in it, or which are necessarily to be inferred from it.

First. That Chaffee was the owner of the extended patent, and had agreed to continue to hold it for the benefit of Judson and of Goodyear and of his licensees, on certain terms.

Second. That the Goodyear licensees had not come in under the previous instrument and paid their respective portions of the expenses in procuring the extension, and consequently Judson's debt was unpaid, and Chaffee was not discharged from it.

Third. That Judson was without power to license any one under the previous agreement, and had not assumed such power, and that Chaffee had retained that power, subject to Judson's approval as to other parties than the Goodyear licensees.

Fourth. That Chaffee was still willing that the Goodyear licensees should obtain a license to use his patent upon the terms of the original agreement, notwithstanding they had broken that agreement, and had neglected or refused to perform that part of it for so long a period.

Fifth. That no license had, in fact, been given to any one.

7. Neither of these instruments gives Judson any interest in the patent itself, or in the profits of the patent, nor do they give him a right to use it, or to license others to use it, except upon conditions precedent, clearly and distinctly specified. Chaffee intended to give him security for the

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debt due him, and pointed out the fund from which the debt was to be paid, if the parties named should keep their agreement, and Judson took for his security a mere power to collect his dues out of this fund, by selling licenses or by suing for damages. The only interest which Judson took was in the money which might be produced by licenses or by suit, and to the extent of his claim for money advanced for services and expenses.

8. This instrument of Nov. 12, 1851, was also executory, and is governed by the rules of law, applicable to contracts executory in their nature and to powers.

So far as the licenses are concerned, Chaffee was the contracting party on the one part, and Goodyear and his licensees on the other. The contract was not executed until the licensees had complied with the conditions under which they were to have a license, and Chaffee parted with nothing until such performance by them. If they neglected or refused to comply, his right of rescission was perfect.

So far as Judson was concerned, he held merely a power, from the proceeds of the execution of which he was to be paid, and to that extent the power operated as a security, and such power was revocable at any time upon payment of the amount of the debt.

Power to sell on mortgages are declared to be revocable in terms, but the deed and power together are cancelled by payment of the mortgage debt.

A power taken for security is revocable by the death of the grantor of the power.

Hunt v. Rousmaniere's Ex'rs, 8 Wheat. 174.

It is also revocable by the party giving it.

Mansfield v. Mansfield, 6 Conn. 559.

In this case the principles of the former case are adopted and carried out to their legitimate conclusions.

A power is irrevocable only when there is an express stipulation that it shall be irrevocable, and when the agent has an interest in its execution. Both of these circumstances must concur.

Story on Agency, sec. 476.

The interest ceased when Judson was offered the money

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for all his disbursements and services. There is no stipulation in the power of Nov. 12, 1851, that it shall be irrevocable.

9. If the paper of Sept. 15, 1850, be construed to give a license directly to Goodyear and his licensees upon their paying the expenses and annuity, then such license is revocable if the conditions be not performed. The instrument contains no word of grant or conveyance known to the common law. There are no covenants which would create an estoppel. The Goodyear licensees obtained nothing more than a license not connected with any grant or made part of any grant.

Such a license is revocable at common law.

Thomas v. Sorrell, Vaughn 351.

"A dispensation or license properly passeth no interest, nor alters nor transfers property in anything, but only makes an action lawful, which, without it, would have been unlawful."

Wood v. Leadbitter, 13 Mees. & W. 843.

"A license is in its nature revocable."

In this case, the whole subject of license is thoroughly examined. Licenses to use patented inventions are governed by the rules and analogies of the common law respecting licenses for the use of the subjects of the property.

Brooks v. Byam, 2 Story 525; Curtis on Pat. sec. 198; Brooks v. Stolley, 3 McLean 523; Woodworth v. Weed, 1 Blatchf. 165.

10. Hartshorn & Co. were not within the class of persons described in the paper of Sept. 5, 1850, nor in the class to whom Judson was authorized to give licenses, by the paper of Nov. 12, 1851.

They were not licensees under the Chaffee patent in connection with the Goodyear patent, before the extension of the Chaffee patent.

11. The question of the performance of the condition of the papers of Sept. 5, 1850, and Nov. 12, 1851, after the papers had been construed by the court, was a question of fact for the jury; and under the instructions given them in the charge, the jury have found that there was a failure on

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the part of Judson and of Goodyear and his licensees to perform their part of the agreement of Sept. 5, 1850, under which their beneficial interest is alleged to have accrued; that the annuity stipulated for by the agreement of Nov. 12, 1851, had not been paid; that the Shoe Associates knew of the non-payment; that Judson was the agent of Goodyear and his licensees in making the paper on Nov. 12, 1851, and of the Shoe Associates in all matters relating to the Chaffee patent since its extension, and that there had been an offer in good faith to repay Judson all that had been expended by himself or advanced by the Shoe Associates on account of this extended patent.

12. Upon these facts, the revocation of the powers given to Judson, and the rescission of those contracts was proper on the part of Chaffee.

13. The title did not pass from Chaffee by the contracts of May 23, 1850, Sept. 5, 1850, and Nov. 12, 1851 in connection with the instrument executed between Goodyear and his licensees dated July 1, 1848, in consideration of Judson's agreement in the paper of Sept. 5, 1850.

First. The paper of May 23, 1850, was an executory agreement between Chaffee and Goodyear. So far as the extension of the Chaffee patent was concerned, the subject matter was in expectancy; no title passed from Chaffee by this paper.

Second. The paper of Sept. 5, 1850, is between different parties from those of the paper of May 23, 1850.

Its recitals show that the agreement of May 23, 1850, had been abandoned, and no title passed by this paper.

Third. The paper of Nov. 12 1851, purports to be nothing more than a mere power, and no title passed by that.

Fourth. The paper of July 1, 1848, is between other parties, and cannot operate upon the extension of the Chaffee patent, unless Goodyear has acquired a title to it. This he would not have done by either of the above papers nor by anything proved in the cause.

14 One test of the right of rescission or revocation, is to inquire whether the contract is one that a court of equity would specifically enforce under the circumstances existing

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at the time the rescission or revocation is sought to be made.

"The rules of law relating to specific performance, and those applied to the rescission of contracts, although not identically the same, have a near affinity to each other."

Boyce's Executors v. Grundy, 3 Pet. 210, 216.

The plaintiff in error sets forth no contract under which he claims a license. He is not within the class of persons to whom Judson was authorized to grant licenses by the paper of Nov. 12, 1851. There is nothing in the case to show that he could state a contract upon which a court of equity could have compelled Chaffee to grant him a license. He offered no evidence tending to prove that he had ever paid anything for such a license, or on account of such a license.

Mr. Justice NELSON delivered the opinion of the court: This is a writ of error to the judgment of the Circuit Court of the United States, holden by the District Judge, in and for the District of Rhode Island.

The action was brought by Day against the defendants below for an alleged infringement of a patent for the preparation and application of India rubber to cloths, granted to E. M. Chaffee, August 31, 1836, and renewed for seven years from the 31st August, 1850. The plaintiff claimed to be the assignee of the patent from Chaffee. The defendants sought to protect themselves under a license derived from Charles Goodyear, whom they insisted was the owner, and not Day, of the renewed patent. Goodyear became the owner of the unexpired term of the original patent on the 28th July, 1844, and on the same day granted to certain persons, called "The Shoe Associates," the exclusive use of all his improvements in the manufacture of India rubber, patented, or to be patented, during the term of any patents or renewals which he might own, or in which he might be interested, "so far as the same are, or may be, applicable to the manufacture of boots and shoes."

The defendants claimed a license under the Shoe Associates.

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Chaffee, the original patentee, made application to the Commissioner of Patents, the 22d May, 1850, for the renewal of his patent, in which he states that the then present owners were willing and desirous that it should be renewed, and in that event that they ought to make him further compensation for the invention. And on the next day, 23d May, 1850, he entered into an agreement with Goodyear, in which he stipulated to convey to him the patent, on its renewal for the extended term, in consideration of \$3,000.

There seems to have been some agreement or understanding that the then owners of the patent and their licensees should be at the expense of the renewal.

William Judson had become interested in one-eighth of the patent in 1846, by an assignment from Goodyear; and in 1848, he, in conjunction with Seth P. Staples, was appointed by Goodyear his attorney and agent, in taking out, renewing, extending, and defending his patents; and a fund was provided by Goodyear for defraying the expenses of these proceedings, and placed in the hands of Judson. By the consent of Goodyear, Judson, subsequently became his sole agent and trustee of the fund for the purposes mentioned.

The patent was renewed in pursuance of the application, on the 30th August, 1850. Soon after this renewal, to wit: on the 5th September, 1850, an agreement was entered into between Chaffee and Judson, which recites the renewal, and that the expenses were large, and also, that at the time of the renewal the patent was held by Goodyear for the benefit of himself and his licensees; and further, that he had agreed with Chaffee, for himself and those using the patent under him, that they would be at the expense of the extension, and make an allowance to him, Chaffee, of \$1,200 per annum, payable quarterly, during the period of the extension; and reciting also, that Judson had had the management of the application for the renewal, and had paid, and became liable to pay, the expenses thereof, and had agreed to guarantee the payment of the annuity of \$1,200; and the agreement then provided as follows:

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"Now, I (Chaffee) do hereby, in consideration of the premises, and to place my patent so that in case of my death, or other accident or event, it may inure to the benefit of said Charles Goodyear, and those who hold a right to the use of said patent, under and in connection with his licensees, according to the understanding of the parties interested, nominate, constitute, and appoint said William Judson my trustee and attorney, irrevocable, to hold said patent, and have the control thereof, so as no one shall have a license to use said patent or invention, or the improvements secured thereby, other than those who had a right to use the same when said patent was extended, without the written consent of said Judson first had and obtained."

At the close of the agreement, Judson stipulates with Chaffee to pay all the expenses of the renewal, and also the annuity of \$1,200; and also to be at all the expense of sustaining and defending the patent; and Chaffee reserves to himself the right to use the improvement in his own business.

This contract was entered into without the privity of Goodyear, and changed materially the terms and conditions of that made by him with Chaffee on the 23d May. He was at first dissatisfied with the change when it came to his notice, but afterwards acquiesced.

The contract continued in operation down to the 12th November, 1851, when a modification of the same took place.

This last contract recites that there was an omission in that of 6th September, in not stating that if the said licensees continued to use the improvements, they should pay their just proportion of the expenses and services in obtaining the renewal, which it was intended they should pay to Judson; and recites also that there was no stipulation on the part of Judson to pay Chaffee \$1,500 per annum, as claimed by him; and it is then agreed that the licensees shall pay their share of the expenses to Judson, as a condition to the granting of a license by him to them; and that on the payment of such share of the expenses, a license shall be granted to them. And it was further agreed, that

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Judson should pay Chaffee the \$1,500 per annum; and also, that Judson might use Chaffee's name in the prosecution of infringements of the patent or for any other purpose in relation to the use of it, he holding Chaffee harmless from all costs, &c., and he, Judson, to have all the benefits to be derived from said suits.

It will be perceived that the only provision in this agreement differing from that of 6th September, in which Chaffee has any interest, is the one providing for an annuity of \$1,500 instead of \$1,200. All the other provisions are for the benefit of Judson. This annuity was paid down to the 1st December, 1852, when some difficulty arose between Judson and Chaffee, and the payment ceased.

And on the 1st July thereafter, Chaffee undertook, in consequence of this default, to revoke and annul the power and control of Judson over the patent, and to forbid his acting in any way or manner under the agreements of the 6th September and of the 12th November, above referred to. And on the same day, for the consideration of \$11,000, assigned the renewed patent to Day, the plaintiff in this suit. Day, on the 2d July, 1853, gave notice to Judson of the assignment, offering to pay, at the same time, all sums there might be due him, if any there were, for moneys advanced in procuring the extension of the patent, or in any other way paid for Chaffee on account of said patent. The above is the substance of the case, as appears from the written agreements of the parties in the record. The questions involved turn essentially upon the points:

1. As to the operation and effect to be given to the three agreements which have been referred to, and especially of that of the 6th September, 1850, between Chaffee and Judson; and,

2. The force and effect of the attempted rescindment of these agreements by Chaffee, on the 1st July, 1853, on account of the neglect or refusal of Judson to pay the annuity of \$1,500.

1. It is not important to examine particularly the agreement between Goodyear and Chaffee of 23d May, as that was in effect superseded by the one entered into with

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Judson, the 6th of September, to which Goodyear afterwards assented.

It is important only as leading to the latter agreement, and may therefore assist in explaining its provisions.

By this first agreement, Chaffee bound himself to assign to Goodyear the renewed patent as soon as it was obtained, for the consideration of \$3,000. Goodyear became thus equitably entitled to the entire interest in the patent during the extended term, and could have invested himself with the legal title on the payment, or offer to pay, the \$3,000, had he not subsequently acquiesced in the modification of it with Judson. Judson was the owner, jointly with Goodyear, of one-eighth of the patent. He was also the agent and attorney of Goodyear, generally, in his applications for patents, in obtaining renewals, and in the litigation growing out of the business; and was the trustee of a fund provided by Goodyear to meet the expenses. It was, doubtless, on account of this interest of Judson in the improvement, and his general authority from Goodyear in the management of his patent concerns, that led him to enter into the new arrangement with Chaffee, of the 6th September, in the absence of his principal. Goodyear might have repudiated it and insisted upon the fulfillment of the first agreement. He thought fit, however, after a full knowledge of the facts, to acquiesce; and his rights, therefore, and those claiming under him, must depend upon this second agreement.

In respect to this agreement, whether the title which passed from Chaffee, in the renewed patent to Judson, was legal or equitable, the court is of opinion that the entire interest and ownership in the same passed to him for the benefit of Goodyear, and those holding rights and licenses under him. The instrument is very inartificially drawn, but the intent and object of it cannot be mistaken. Chaffee, in consideration of the premises, which included the annuity of \$1,200, "and (in his own language) to place my (his) patent so that in case of death, or other accident or event, it (the patent) may inure to the benefit of said Charles Goodyear, and those who hold a right to the use of said patent, under and in connection with his licensees,"

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&c., nominates and appoints, "said William Judson, my trustee and attorney irrevocable, to hold said patent, and have the control thereof, so that no one shall have a license, &c., other than those who had a right to use the same when said patent was extended, without the written consent of said Judson;" and at the close of the agreement, he reserves the right to use the improvement in his own business. At this time, as we have seen, Judson was the owner of one-eighth of the patent, and was the general agent and attorney of Goodyear in all his patent business transactions. It is apparent that the only interest in the patent, left in Chaffee, was the right reserved for his own personal use. The annuity and indemnity against the expenses of the renewal were the compensation received by him for parting with the improvement. The contract of the 12th November has no material bearing upon this part of the case. Most of the provisions were for the benefit of Judson, in relation to the licensees under Goodyear. The only provision important to Chaffee, is the stipulation for the increased annuity of \$1,500.

2. Then, as to the attempted rescindment of the contracts. The agreement of 6th September had been in force from its date down to the 1st July, 1853, a period of two years and nearly ten months. During all this time the licensees of Goodyear, at the date of the renewal of the patent, and those whom Judson may have granted a license to since the renewal, had a right to use the improvement, and especially the Shoe Associates, referred to in their agreement with Goodyear, 1st July, 1848. Besides this stipulation with Goodyear, their right was expressly recognized by Chaffee himself, in the agreement with Judson of 6th of September.

The effect of the rescindment as claimed, and which would be necessary to enable the plaintiff to succeed in his action against the defendants, would be to break up the business of these licensees, by divesting them of their rights under this agreement—rights acquired under it from all parties connected with or concerned in the patent, and especially from Chaffee, the patentee, who placed it in the hands of Judson, for the benefit of Goodyear and those

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holding under him. The effect would also be to deprive Goodyear or Judson, or whichever of them had paid the expenses of obtaining the renewal, of the equivalent for those expenses, except as they might have a personal remedy against Chaffee. To the extent above stated, the agreement of the 6th September was already executed, and, in respect to parties concerned, the abrogation would work the most serious consequences.

As we have already said, the ground upon which the right to put an end to the agreement is the refusal to pay the annuity of \$1,500 after December, 1852. Judson proposed to Chaffee to resume the payment in June, 1853; which was declined: but we attach no importance to this fact, especially as we are in a court of law. But in looking into the agreement of the 6th of September, and also the one of the 12th of November, the court is of opinion that the payment of the annuity was not a condition to the vesting of the interest in the patent in Judson, and of course that the omission or refusal to pay did not give to Chaffee a right to rescind the contract, nor have the effect to remit him to his interest as patentee. The right to the annuity rested in covenant, under the agreement of the 12th of November. One of the objects of that agreement was to obtain from Judson this covenant. From the terms and intent of the agreement, the remedy for the breach could rest only upon the personal obligation of Judson, as, by the previous one of the 6th of September, the interest in the patent had passed to Goodyear and his licensees, and no default or act of Judson could affect them. Chaffee chose to be satisfied with the covenant of Judson, without stipulation or condition as it respected the other parties, and he must be content with it.

The cases of *Brooks v. Stolly*, 3 McLean 526, and *Woodworth v. Weed*, 1 Blatchf. 165, have no application to this case.

The attempt to rescind the contracts, being thus wholly inoperative and void, in the opinion of the court, of course no interest in the patent passed to Day, under the assignment of the 1st July, 1853.

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Evidence was given on the trial in the court below, for the purpose of proving that the agreement of the 6th of September was procured from Chaffee by the fraudulent representations of Judson, which was objected to, but admitted.

The general rule is, that in an action upon a sealed instrument in a court of law, failure of consideration, or fraud in the consideration, for the purpose of avoiding the obligation, is not admissible as between parties and privies to the deed; and more especially where there has been a part execution of the contract. The difficulties are in adjusting the rights and equities of the parties in a court of law; and hence, in the States where the two systems of jurisprudence prevail, of equity and the common law, a court of law refuses to open the question of fraud in the consideration or in the transaction out of which the consideration arises, in a suit upon the sealed instrument, but turns the party over to a court of equity, where the instrument can be set aside upon such terms as, under all the circumstances, may be equitable and just between the parties. A court of law can hold no middle course; the question is limited to the validity or invalidity of the deed.

Fraud in the execution of the instrument has always been admitted in a court of law, as where it has been misread, or some other fraud or imposition has been practiced upon the party in procuring his signature and seal. The fraud in this aspect goes to the question whether or not the instrument ever had any legal existence.

(*Vrooman v. Phelps*) 2 Johns. 177; (*Dorr v. Munsell*) 13 Johns. 430; (*Welch v. Hicks*) 5 Cow. 506; (*Smith v. Smith*) 4 Wend. 471; (*Taylor v. King*) 6 Munf. 358; (*Wyche v. Macklin*) 2 Rand. 426; (*Stoever v. Weir*) 10 S. & R. 25; (*Hisa, admxr, v. Lucas*) 14 S. & R. 208; (*Mordcaï v. Yankersley*) 1 Ala. 100; (*Burrows v. Alter*) 7 Mo. 424; (*Donaldson v. Benton*) 4 Dev. & Bat. 436; C. & H., Notes, part 2, p. 615, Note 306, ed. Gould & Banks, 1850.

It is said that fraud vitiates all contracts, and even records, which is doubtless true in a general sense. But it must be reached in some regular and authoritative mode; and this

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may depend upon the forum in which it is presented, and also upon the parties to the litigation. A record of judgment may be avoided for fraud, but not between the parties or privies in a court of law.

The case in hand illustrates the impropriety and injustice of admitting evidence of fraud to defeat agreements of the character in question in a court of law. We have a record before us of 1,055 closely printed pages of evidence submitted to the jury, and a trial of the duration of some six weeks. Goodyear and his licensees had acquired vested and valuable rights under the agreements in this patent, and who were in no way privy to, or connected with, the alleged fraud, nor parties to this suit; and yet it is assumed, and without the assumption the fraud would be immaterial, that the effect of avoiding the agreements would be to abrogate these rights. They had been in the enjoyment of them for nearly three years, and may have invested large amounts of capital in the confidence of their validity. They were derived from Chaffee himself, the patentee of the improvement. A court of equity, on an application by him to set aside the agreements on the ground of fraud, would have required that these third parties in interest should have been made parties to the suit, and would have protected their rights, or secured them against loss, if it interfered at all, upon the commonest principles of equity jurisprudence.

Some slight evidence was given in the court below, upon the question whether the agreement of the 6th of September was sealed at the time of the execution. But the instrument produced was sealed, and is recited in the subsequent agreement of the 12th November, as an agreement signed and sealed by the parties.

A question was also made, as to the authority of the Shoe Associates to grant a license to the defendants. But they held under Goodyear the right to the exclusive use of the improvement for the manufacture of boots and shoes. They were competent, therefore, to confer the right upon the defendants. Besides, the point is not material in the view the court have taken of the case, as upon that view

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no interest in the patent vested in the plaintiff under the assignment from Chaffee.

It will be seen, by a reference to the bill of exceptions, that upon our conclusions in respect to several points raised in the case, *the rulings in the court below were erroneous, and consequently the judgment must be reversed, and a venire de novo awarded.*

Patent in suit:

No. 16. Chaffee, E. M., Aug. 13, 1836. India Rubber.

OTHER SUITS ON SAME PATENT:

Day v. Chandee, 1853. 3 Fish. 9.

Day v. Boston Belting Co., 1853. 16 Law Rep. 329.

Day v. New England Car-Spring Co., 1854. 3 Blatchf. 154.

Day v. New England Car-Spring Co., 1854. 3 Blatchf. 179.

Day v. Hartshorn, 1855. 3 Fish. 32.

Day v. Union India Rubber Co., 1856. 3 Blatchf. 488.

Day v. Union India Rubber Co., 1857. 20 How. 216; 1 Whit. 1062 [p. *post*].

Chaffee v. Boston Belting Co., 1859. 22 How. 217; 1 Whit. 1124
[p. *post*].

Cited:**IN SUPREME COURT OF UNITED STATES:**

Day v. Rubber Co., 1858. 20 How. 216; Bk. 15, L. ed. 883 [p. *post*].

Railroad Co. v. Trimble, 1870. 10 Wall. 367; Bk. 19, L. ed. 948.

Notes and Citations.**IN CIRCUIT COURTS:**

- Goodyear *v.* Union Rubber Co., June, 1857. 4 Blatch. 63.
Day *v.* Stellman, July 1859. 1 Fish. 487.
Newell *v.* West, August, 1875. 18 Blatch. 114; 2 Ban. & Ard. 113.
Newell *v.* West, June, 1876. 9 O. G. 1110.
Prime *v.* Brandon Mfng. Co., July, 1879. 16 Blatch. 453; 4 Ban. & Ard. 879.
White *v.* Lee, July, 1880, 5 Ban. & Ard., 572; 3 Fed. Rep. 222.
Mackaye *v.* Mallory, May, 1882. 12 Fed. Rep. 828; 22 O. G. 945.
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IN STATE COURTS:

- Union Mfng Co. *v.* Lounsbury, December, 1869. 41 N. Y. 363.
Consolidated Fruit Jar Co. *v.* Mason, February, 1877. 7 Daly 64.
Maurice *v.* Devol, December, 1888. 23 W. Va. Rep. 247.
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IN TEXT-BOOKS:

- Walker on Pats., 1883, p. 199.
Curtis on Pats., 4th ed., §§ 194, 203*n*, 284, 438*a*.
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Syllabus.**ISAAC BROWN, APPELLANT, v. JOSEPH P.
SHANNON, et. al.****20 How. 55-58. Dec., 1857.**

[Bk. 15, L. ed. 826; 1 Whit. 1044.]

Jurisdiction. Contract. Value of matter in controversy. Penalty bond.

1. Where complainants sought the aid of the court to prevent the fraudulent violation of certain contracts, and asked for an injunction, *held* that it was a proceeding founded on a contract, and the matter in controversy being less than \$2,000 in value, the court had no appellate power (p. 357).
2. The value of the matter in controversy cannot be estimated from the penalty of the bond, when the injunction was granted in order to confer jurisdiction on appeal, where it would otherwise be less than \$2,000 (p. 358).

The bill in this case was filed in the Circuit Court of the United States for the District of Maryland, by the appellees, to restrain the defendant by injunction from using a certain patented invention.

The court below entered a decree granting the injunction prayed for. From that decree this appeal was taken.

A further statement of the case appears in the opinion of the court.

Mr. William Schley, for appellant:

The bill is multifarious. The complainants, according to the statement of the bill, have several, but separate rights. They cannot unite their complaints in one suit, unless it be a rule of equity pleading, that parties who have several and distinct rights, can unite in one bill, when the act of another party violates at the same time several and separate rights of all the complainants. There is no such rule of pleading in equity.

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Story Eq. Pl., sec. 271, 279, 530; *Harrison v. Hogg*, 2 Ves., Jr. 323; *Campbell v. Mackay*, 1 Myl. & C. 618; *Boyd v. Hoyt*, 5 Paige 65; *Yeaton v. Lennox*, 8 Pet. 123.

Messrs. Charles J. M. Gwinn and John H. B. Latrobe,
for appellees.

Mr. Chief Justice TANEY delivered the opinion of the court:

This is an appeal from the decree of the Circuit Court for the District of Maryland.

The bill was filed by Joseph P. Shannon & Co., Gelston & Matthews, Lapouraille & Maughlin, and Griffiss & Cate, who composed four different partnership firms in the City of Baltimore, separately engaged in the business of planing, who all joined in the bill of complaint against Brown, the appellant, praying that he might be enjoined from the use of certain planing machines, mentioned in the bill, in the City of Baltimore. Upon the hearing, a perpetual injunction was granted accordingly, and from that decree this appeal was taken.

From the manner in which the bill is framed, there is some difficulty in determining whether the complainants are seeking the aid of this court to prohibit the infringement of a patent-right assigned to them, or to enforce the specific execution of two contracts with the appellant, exhibited with the bill, for the right claimed under the patent and the right claimed under the contracts are so mingled together in the statements and allegations of the complainants, as to leave some doubt upon that point. And the first question, therefore, for this court to determine, is upon which of these two grounds does the bill seek for relief? The jurisdiction of the Circuit Court in the one case is materially different from its jurisdiction in the other; and while this court can exercise no appellate power in a case arising under contracts like those exhibited, unless the amount or value of the matter in controversy exceeds \$2,000, and it may yet lawfully exercise its appellate jurisdiction when a far less amount is in dispute, if the party is proceeding

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either at law or in equity for the infringement of a patent-right to which he claims to be entitled. Upon looking, however, carefully into the bill, we think it must be regarded and treated as a proceeding to enforce the specific execution of the contracts referred to, and not as one to protect the complainants in the exclusive enjoyment of a patent-right. It states that three of the partnership firms named as complainants—that is to say, Joseph P. Shannon & Co., Gelston & Matthews, and Lapouraille & Maughlin, were, by regular assignments, entitled to the exclusive use of Woodworth's planing machine in the State of Maryland, east of the Blue Ridge. That the appellant had used these machines in the City of Baltimore, without any right derived from the patentee, and that in consequence of this infringement of their rights, various suits and controversies had taken place between them and Brown, who claimed the right to use the machines in question, as the assignee of a patent of Emmons. The bill then proceeds to state, that, in order to put an end to these controversies and suits, these appellees and the appellant entered into the contract of the 19th of January, 1853, which is exhibited with the bill.

By this contract the portion of the appellees of which we are now speaking and the appellant, agreed that each of the said three partnership firms and the appellant should have the right to use the Woodworth patent at one establishment, anywhere within the territorial limits above mentioned, not exceeding five machines at such establishment; and that each of the said parties should also have the right to use the Emmons patent.

There are other stipulations in this agreement which it is not material to state for the purposes of this opinion.

The bill further states that Brown afterwards, on the 15th of June, 1853, assigned to Griffiss & Cate, the other complainant, all his right to use the Woodworth patent, which right he had derived from the contract before mentioned; and also the right to use the Emmons patent, the right to which he had derived from the administrator of Emmons. This contract states that the assignment was made in con-

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sideration of \$1,500, paid the appellant by Griffiss & Cate. And the complainants allege that after this assignment Brown continued to use the said five machines in his establishment in Baltimore, although he had no right to do so, as they were all Woodworth's planing machines, and that he is not only a wrong doer in using a patented invention without a license, and as such liable to be restrained by a court of equity, but that such use is a fraud upon the parties to each of the two contracts into which he had entered, as above stated. That the object of the contract of January 19, 1853, was to restrain the use of the Woodworth machine and the Emmons machine, so far as that right was to be used, to four establishments in the City of Baltimore, with the limited number of machines in each, and that the use of them by Brown after he had substituted Griffiss & Cate in his place was a fraud upon this contract, from the binding operation of which he could not withdraw himself, and a fraud also upon his contract with Griffiss & Cate. And the *gravamen* of the bill and the ground upon which relief is sought is summed up in the paragraph immediately preceding the prayer for relief, in the following words:

"And your orators are further advised, that the misconduct of the said Brown in the premises is a fraud upon the parties to the agreement of the 19th of January, 1853, as well as upon the parties to the agreement of the 15th of June, 1853, which it is the peculiar province of a court of equity to restrain."

It is to prevent the fraudulent violation of these contracts, therefore, that the complainants seek the aid of the court, and ask for an injunction; and it being a proceeding founded on a contract between the parties, this court has no appellate power, unless the matter in controversy is of the value of more than \$2,000. Now, the matter in controversy is the right of the appellants to use these five machines while the Woodworth patent continued—that is, until the 29th of December, 1856.

But it appears by the record that Brown sold this right to Griffiss & Cate for \$1,500. He admits, in his answer, that he sold and assigned it for that sum; nor does he sug-

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gest that it was worth more. The establishment of Griffiss & Cate, like that of the appellant, was in the City of Baltimore. And if \$1,500 was the just value of the right in controversy on the 15th of June, 1853, there is no reason for supposing that it was more on the 10th of October in that year, when this bill was filed, or at any time since; on the contrary, the period for the duration of the right under the contract was daily diminishing as the termination of the patent was approaching, and a diminution on the value of the right would be a natural and necessary consequence. It is evident, therefore, that the value of the matter in controversy is not sufficient to give appellate jurisdiction to this court.

It has, however, been suggested in the argument at the bar, that the value may be estimated by referring to the penalty of the bond taken by the Circuit Court when the injunction was granted. But this rule would be entirely too vague and uncertain for judicial purposes. It is the practice of all courts, in taking bonds of this description, to prescribe a penalty more than enough to cover all possible damages which the respondent may sustain by reason of the injunction. There was nothing before the Circuit Court when the penalty in this case was prescribed, but the bill of the complainants. And although the bill disclosed a controversy where the matter in dispute was worth in the market but \$1,500, yet, when the answer came in, and testimony was taken, it might show that the matter in dispute was of far greater value. The court could not foresee whether this would be the case or not, and hence the necessity and propriety of prescribing a penalty that would cover all possible contingencies. The respondent, however, as we have said, admits that he sold the privilege now in dispute for the sum mentioned in the bill, and does not say it was worth more, or was of greater value in his hands than in those of Griffiss & Cate. The sum mentioned in the bill, and for which the privilege in question was sold by the appellant, must, therefore, be taken as the true value of the matter in controversy, and, being less than \$2,000, whatever errors may be apparent in the proceedings and decree of

Notes and Citations.

the court below, we have yet no power under the Act of Congress to revise and correct them, *and the appeal must be dismissed for want of jurisdiction in this court.*

Notes :**1. Contract, jurisdiction.**

- Wilson *v.* Sanford, 10 How. 99 [5 Am. & Eng. 122].
Albright *v.* Teas, 106 U. S. 618.
Tile Mfg. Co. *v.* Hyatt, 125 U. S. 46.
Felix *v.* Scharnweber, 125 U. S. 54, and see
Hogg *v.* Emerson, 6 How. 437 [5 Am. & Eng. 1].
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Patent in suit:

No. . . Woodworth, W. Dec. 27, 1828. Planing
Mill. Reissue No. 71, July 8, 1845.

OTHER SUITS ON SAME PATENT:

See Brooks *v.* Fiske [p. 64 *ante*].

Cited :**IN SUPREME COURT OF UNITED STATES:**

Dale Tile Mfg. Co. *v.* Hyatt, 1888, 125 U. S. 46. Bk. L. ed.

IN TEXT-BOOKS:

2 Abb. Pat. Law, 1886, pp. 278, 279.
Walker on Pats., 1888, p. 281.

Syllabus.

WILLIAM B. DEAN, APPELLANT, v. NATHAN MASON, et. al.

20 How. 198-204. December, 1857.

[Bk. 15, L. ed. 876; 1 Whit. 1048.]

Exclusive territorial assignees. Rule of damages. Motion to amend after default. Decree pro confesso. Motion to dismiss for parting with interest in subject matter of suit.

1. Where plaintiffs were exclusive territorial assignees, the rule of damages for the user complained of was the amount of profits received by the unlawful use of the machines, and not the amount defendant might have made by reasonable diligence (p. 367).
2. A motion to amend or file an answer after default is generally addressed to the discretion of the court, and is not subject to the revision of this court (p. 367).
3. Where motion to file an answer was not made until three years after the decree *pro confesso* had been entered, and a reference made to a master for an account, *held* that on such grounds the decree could not be reversed (p. 368).
4. Motion to dismiss complainants' bill upon proof that they had parted with their interest in the subject matter of the suit, *held* properly overruled, where the transfer was subsequent to the date to which the account of profits had been brought down (p. 368).

[Citations in the opinion of the court:

Bloomer v. McQuenan, 14 How. 539 [5 Am. & Eng. 434], p. 367.

Livingston v. Woodworth, 15 How. 546 [p. 167 *ante*], p. 366.

APPEAL from the Circuit Court of the United States for the District of Rhode Island.

The bill in this case was filed in the Circuit Court of the United States for the District of Rhode Island, by the appellees, to recover damages for the infringement of a certain patent.

Argument of counsel.

A decree *pro confesso* was entered against the defendant, and he was perpetually enjoined. The court, on the report of a master, fixed the damages at \$2,566.46, "the amount of profits which the defendant, by reasonable diligence, might have derived from the use made by him of such patented machines, and the sales of the products thereof" during the period covered by the suit. The defendant brought the case here on appeal.

A further statement appears in the opinion of the court.

Mr. T. A. Jenckes, for appellant:

1. The rule laid down by the court for the computation of profits, is erroneous. The rule should have been, to take an account of the actual gains and profits of the appellant during the time his machines were in operation.

"In a suit of equity for an injunction and account of profits of a patented machine, the defendant is accountable only for what profits he actually made, and not for what, by diligence and skill, he might have received."

Livingston v. Woodworth, 15 How. 546 [p. 167, *ante*].

2. The court below was in error in refusing leave to the defendant to answer, on the motion made at the June Term, 1853.

The 32d rule of the court contains no limitation of time within which such motion should be made. In a case of this kind, as in all cases when an account is required to be taken, it is obvious that the decree ordering the account, whether it be after hearing or *pro confesso*, is an interlocutory decree.

Perkins v. Fourniquet, 6 How. 206; [*Fourniquet v. Perkins*] 16 How. 82.

In the present case, the law had been settled by this court in favor of the defendant below, and before the cause had reached a final decree, he asked leave to make the facts appear which would entitle him to the benefit of the law, as established by this court, overruling what had been the law of the court below. The refusal of the motion amounted to a denial of justice. The rules prescribed by this court were never intended to work injustice, and the Circuit

Argument of counsel.

Courts should construe them liberally for the purpose of doing justice.

Poultney v. City of Lafayette, 12 Pet. 472; *R. I. v. Mass.* 14 Pet. 210.

The general principle that an answer will be received after a decree *pro confesso*, under the general orders in English chancery practice, notwithstanding said orders is sustained by the following authorities:

Smith v. Turner, 1 Vern. 274; *Kemp v. Squire*, 1 Ves. 205; *Ogilvie v. Herne*, 13 Ves. 563; *Hamilton v. Houghton*, 2 Bligh. 170; *Taylor v. Salmon*, 3 Myl. & C. 109; *Daley v. Duggan*, 1 Ir. Eq. 311; *Cruise v. Shiel*, 6 Ir. Eq. 132; *Murray v. Byrne*, 11 Ir. Eq. 125.

The court below misconstrued the rules prescribed by this court, and specially the 19th and 32d rules. The 19th rule contains no limitation on the 32d rule, and is besides applicable only to final decrees.

Again, the decree which was thus adjudged to have become absolute, was not regularly entered under the 19th rule of the court.

3. The interest of the complainants in this suit was thus terminated before final decree, and no such decree should have been rendered in their favor.

4. The court below was in error in refusing leave for the filing of a supplemental bill in favor of Baker & Smith.

The proposed parties complainant, Baker & Smith, were entitled to the benefit of what had been done on the title which they had acquired.

Story Eq. Pl., secs, 339, 349, 351; *Calv. Part.*, pp. 99, 100.

The fact that an interlocutory decree had been entered upon Mason's title, did not bar his grantee who had purchased that title. A supplemental bill may be filed as well after as before a decree.

Story Eq. Pl., sec. 338.

The hearing upon the decree prayed for, would have necessarily led to an inquiry into the propriety of the decree sought to be enforced; and the court below could then have followed the decision of this court in *Bloomer v.*

Argument of counsel.

McQuewan, 14 How. 539 [5 Am. & Eng. 434], and dismissed the bill, as the Circuit Court in the case of *Perkins v. Fourniquet*, 6 How. 206, reversed its interlocutory decree after the adverse decision of this court in a similar case.

See Barb. Ch. 3, 63, *et seq.*

5. These questions are all proper to be discussed on appeal.

An appeal in equity brings up all the questions decided in the court below to the prejudice of the appellant.

Buckingham v. McLean, 13 How. 150.

For these reasons the appellant prays that the decree against him in the court below may be reversed.

Messrs. A. Payne and B. R. Curtis, for the appellees:

As to the motion for leave to answer:

The bill having been filed at the November Term, 1850, and subpoena served November 18th, returnable January 6th, and the defendant having failed to plead answer or demur, as required by the rules of the court, it was properly ordered to be taken for confessed; and upon such confession a decree for an injunction and an account was properly made at the June Term, 1851. After four terms had elapsed, and voluminous and extended proceedings had been had before the master in taking the account, the defendant, for the first time, asked the court to open the decree and allow him to file an answer. We respectfully submit:

I. The decision of the motion to open the decree and allow an answer to be filed, even when made at the proper term, rests in the sound discretion of the Circuit Court, and is not subject to re-examination here.

Wylie v. Coxe, 14 How. 1; *The Marine Ins. Co. v. Hodgson*, 6 Cranch, 206; *U. S. v. Evans*, 5 Cranch. 280; *Welch v. Mandeville*, 7 Cranch. 153.

A reference to the 19th rule for the practice of the Circuit Courts in equity, will show how entirely the allowance or refusal of this motion, if made in time, rests in the discretion of the Circuit Court.

II. If this court could review this decision of the Circuit Court, that decision was clearly right.

Argument of counsel.

The 19th rule expressly declares that "when the bill is taken *pro confesso*, the court may proceed to a decree at the next ensuing term thereof, and such decree rendered shall be deemed absolute, unless the court shall at the same term set aside the same, or enlarge the time for filing the answer upon cause shown upon motion and affidavit of the defendant."

Instead of moving at the term when the decree was entered, the motion was not made until the fourth term thereafter. The court had no power then to grant it.

The motion to dismiss the bill based upon facts *dehors* the record, was wholly irregular and could not be allowed.

A transfer of the title by each of the plaintiffs, *pendente lite*, cannot affect the rights of the defendant.

Eades v. Harris, 1 You. & Coll. Ch. 230.

Certainly it could not do so in this case; for the allegation is that Mason parted with his title in April, 1852, and the account of the profits comes down only to August 29, 1851.

See pp. 56, 101.

In addition to this, if the copy of the agreement of Mason, annexed to the motion and found on pp. 123-125, were admitted to be regularly in the case, it did not devest Mason of his interest; for it was only a conditional license to run ten machines in the City of Providence.

As to the exceptions to the master's report, the first was a general assignment of error in the balance, without specifying any item in the account as erroneous.

Such an exception cannot be sustained.

Story v. Livingston, 13 Pet. 359; *Dexter v. Arnold*, 2 Sumn. 108; *Wilkes v. Rogers*, 6 Johns. 566.

The appellant may also attempt to assign error in the interlocutory decree, by which the cause was referred to the master to take an account.

We submit that the appellant cannot now take an objection to that decree.

The 19th rule expressly provides, that a decree founded upon an order taking a bill confessed, shall be absolute at the close of the term at which the decree is entered,

Opinion of the court.

In *McMicken v. Perin*, 18 How. 507, where a bill was taken *pro confesso*, and, at the same term, a decree of reference was made, it was objected that the master had not allowed to the appellant the amount admitted by the bill to be due to him. But as no exception had been taken to the master's report, this court refused to reverse the decree.

Mr. Justice McLEAN delivered the opinion of the court:
This is an appeal from the Circuit Court for the District of Rhode Island.

A bill was filed in this case by Mason *et al.*, claiming to be owners of a territorial right to the exclusive use of the Woodworth patent for planing boards, charging the defendant with using three of the machines in the City of Providence, in violation of the complainants' right. The suit was commenced the first year of the extension of that patent by Congress, and the three machines which were sought to be enjoined were those used during the first extended term of the patent, under a license from its owners. A preliminary injunction was granted.

At the June Term, 1851, of the Circuit Court, a decree *pro confesso* was entered against the defendant, and he was perpetually enjoined. The case was referred to a master, to take an account of the profits or income derived by the defendant, or which, by reasonable diligence, might have been realized by him, from the use made of the three machines.

Exceptions were taken to the first report of the master, and it was referred to him again under the same instructions.

Before the second report of the master, a motion was submitted to the court by the defendant to set aside the decree *pro confesso*, and for leave to answer the bill on the ground that the Supreme Court in the case of *Bloomer v. McQuewan, et. al.*, 14 How. 539 [5 Am. & Eng. 434], had held, in a case similar to this, that the licensee's privilege continued under the extension of patent by Congress, the same as under prior extensions; but the court refused the motion; consequently, the appeal does not bring before us any question under the last extension of the patent.

Opinion of the court.

At the November Term, 1854, the master made his second and final report, in which he stated the sum of \$2,566.46 as the amount of profits which the defendant, by reasonable diligence, might have derived from the use made by him of such patented machines, and the sales of the products thereof, during the period covered by the suit.

The decree was entered on the report of the master, for the estimated amount of profits which the defendant, with reasonable diligence, might have realized; not what, in fact, he did realize. This instruction was erroneous. The rule in such a case, is the amount of profits received by the unlawful use of the machines, as this, in general, is the damage done to the owner of the patent. It takes away the motive of the infringer of patented rights, by requiring him to pay the profits of his labor to the owner of the patent. Generally, this is sufficient to protect the rights of the owner; but where the wrong has been done under aggravated circumstances, the court has the power, under the statute, to punish it adequately, by an increase of the damages.

The injury done is measured by the supply of planed boards thrown upon the market, which lessens so much the demand. But, if the liability of an infringer is to be increased by an estimate of the work he might do, with great diligence, he will be more likely to exceed the estimate than fall below it. This policy would increase the evil of the wrong doer, without benefit to any one. In *Livingston et al. v. Woodworth, et al.*, 15 How. 546 [p. 167 *ante*], the true rules of damages in such cases is laid down.

It is contended the court erred in refusing leave to the defendant to answer, on the motion made at June Term, 1853.

A motion to amend, or file an answer after default, is generally addressed to the discretion of the court. Under some circumstances, the court, for the purposes of justice, will go great lengths in opening a default and allowing a plea to be filed. But this is done or refused by the court, in the exercise of its discretion, which is not subject to the revision of this court.

In the case before us, the motion to file an answer was

Opinion of the court.

not made until after the decree *pro confesso* had been entered, and a reference made to a master for an account. This was more than three years after the bill was filed. Whether the Circuit Court refused the motion on the ground of delay, or a want of merits in the cause assigned, does not appear; but it is sufficient to say, that on such grounds the decree cannot be reversed.

The motion to dismiss the complainant's bill, upon proof that they had parted with all their interest in the subject matter of the suit, was properly overruled. The allegation is, that Mason parted with his title in April, 1852, and the account of the profits is brought down only to the 29th August, 1851. The right asserted in this action was not affected by the conveyance of Mason to Baker & Smith.

The refusal of the Circuit Court to permit a supplemental bill to be filed by Baker & Smith was, under the circumstances, a matter of discretion in the court; and it affords no ground for the reversal of the decree. It is not perceived what interest these assignees could have in a suit for an infringement of the patent, before their right accrued; and any attempt to make them parties, with the view to benefit the defendants in the pending suit, was unsustainable.

For the reasons assigned, the decree for damages must be reversed, at the costs of the defendants in error, as founded on an erroneous estimate; and the cause is remanded to the Circuit Court, with instructions to enter a decree for the amount of the profits realized by the defendant from the wrongful use of the patent.

Notes:**1. Measure of damages when actual gains and profits.**

Woodworth *v.* Livingston, 15 How. 546 [p. 167 *ante*].

Burdell *v.* Denig, 92 U. S. 716.

Birdsall *v.* Coolidge, 93 U. S. 64.

Marsh *v.* Seymour, 97 U. S. 348.

Root *v.* Railroad, 105 U. S. 189.

Yale Lock Co. *v.* Sargent 117 U. S. 536.

Dec., 1857.]

DEAN *v.* MA

Notes and Citati

Patent in suit:

No. . Woodworth, W., De
Reissue No. 71, July 8, 18

OTHER SUITS ON SAME PATENT

See *Brooks v. Fiske* [p. 64 *ante*].

Cited:

IN SUPREME COURT OF UNITED STATES

Moore v. Marsh, 1868. 7 Wall. 515; *Rubber Co. v. Goodyear*, 1869. 9 Wall. 553; *Birdsall v. Coolidge*, 1876. 93 U. S. 1; *Root v. Railroad Co.*, 1882. 105 U. S. 1; *Tilghman v. Proctor*, 1888. 125 U. S. 1

IN CIRCUIT COURTS:

Livingston v. Jones, November, 1861.
207; 2 Pitts. Rep. 68.
Perry v. Corning, May, 1868. 6 Blatch. 1; *Everest v. Buffalo Lubricating Oil Co.*, 742.

IN DECISIONS OF COMMISSIONER OF PATENTS

Singer, November, 1870. C. D. 1870,

Notes and Citations.

IN TEXT BOOKS:

2 Abb. Pat. Law, 1886, pp. 370, 397.

Walker on Pats., 1883, pp. 447, 485.

Curtis on Pats., 4th ed., §§ 338, 436*n.*

EDWIN M. CHAFFEE, TRUS
DAY, PLAINTIFF IN ER
HAYWARD; AND HORAC
TIFF IN ERROR *v.* NATH

20 How. 208-216. 1

[Bk. 15, L. ed., 851; 1 V

Waiver of irregularity in citation.
Waiver of jurisdiction.

1. Where, during a subsequent term, a party, having been served with a case on the ground of irregularity in the appearance of the party in the first term, has filed a motion to dismiss during the first term, because of irregularity in the citation, and a writ of attachment has been issued before he received notice to appear to the writ.
2. The absence of one or of all the counsel for the plaintiff in the cause, in pursuit of other business, furnishes no sufficient reason for waiving service of a case in this court, without the consent of the parties (p. 374).
3. Section 11 of Judiciary Act 1789, conferring jurisdiction over the person of a defendant, who is a citizen of another State, can only be obtained by serving a writ of process on his person within the State where he is situated; and that no jurisdiction can be obtained over his property of a non-resident defendant by serving a writ of attachment in the State where he resides, in accordance with the law (p. 379).
4. The 11th section of the Judiciary Act of 1789, which gives jurisdiction over the person of a defendant, and stands unaffected by the subsequent acts of Congress, and which conferring jurisdiction on Circuit Courts, and which applies in its terms to *all* civil suits.

[Citations in the opinion of the Court:]
Toland *v.* Sprague, 12 Pet. 327, p. 380.
Le Roy *v.* Fitzpatrick, 15 Pet. 171, p. 380.
Herndon *v.* Ridgway, 17 How. 424, p. 380.

Statement of the case.

THESE suits were brought in the Circuit court of the United States for the District of Rhode Island, by the plaintiff in error, for the recovery of damages for the alleged infringement of a certain patent. The defendant pleaded to the jurisdiction of the court, that he was not a resident of the District of Rhode Island, and that he was not served with process within the said district. The plaintiff demurred, and the court overruled the demurrer, and dismissed the case for want of jurisdiction. The plaintiff thereupon sued out this writ of error.

EDWIN M. CHAFFEE, TRUSTEE OF HORACE H. DAY, PLAINTIFF IN ERROR, v. NATHANIEL HAYWARD. HORACE H. DAY, PLAINTIFF IN ERROR, v. NATHANIEL HAYWARD.

Early in the term, *Mr. Pitman*, counsel for the defendant in error, moved to dismiss the writs of error upon the ground stated in the following affidavit, which he filed in support of the motion:

Supreme Court of the United States.

[No. 51. December Term, 1857.]

EDWIN M. CHAFFEE, (Trustee of Horace H. Day),
Plaintiff in Error.
v.
NATHANIEL HAYWARD.

The defendant in error in this cause moves that this cause be dismissed, the citation herein having been signed by the clerk of the Circuit Court, and not by the judge, as required by law. By his attorney.

JOSEPH S. PITMAN.

I, Joseph S. Pitman, of the City and County of Providence, and State of Rhode Island, &c., attorney at law, on oath say, that I am and have been associated with Charles S. Bradley, Esq., in the defense of the above cause; that he is the junior counsel in said cause; that he left the City of Providence for Europe on the 1st or 2d day of December,

Statement of the case.

1856; that we had no consultation respecting the management of said cause before his departure, Mr. Bradley expecting to return by the first of March, 1857; that after his departure I caused an appearance to be entered in said cause, and did not file a motion for the dismissal of said cause at the last term, because I did not wish to decide on the expediency of that motion without consultation with him; that I expected he would return in season for such consultation, either before the court adjourned, or that I should have opportunity to make that motion after consultation with him at an adjourned term of this court, which I supposed would be held as at the December Term, 1856; that, to my surprise, this court adjourned about the 7th day of March, and the opportunity was lost, as Mr. Bradley did not return to this country until the 24th of March, 1857.

JOSEPH S. PITMAN.

*Rhode Island District,
Clerk's Office, Circuit Court of the United States.* } ss.

On this 19th day of December, A. D. 1857, came the above-named Joseph S. Pitman, and made oath that the foregoing statements are true. Before me.

Witness my hand and official seal, at Providence.

[SEAL.]

HENRY PITMAN,
Clerk Circuit Court U. S R. I. District.

Upon which Mr. Chief Justice TANEY delivered the opinion of the court.

In this case a judgment in favor of the defendant in error was rendered in the Circuit Court of the United States for the District of Rhode Island, at its June Term, 1856. The plaintiff sued out a writ of Error on the 27th of October, 1856, returnable to the December Term of this court then next following; but the citation to the defendant was signed by the clerk of the court, and not by the judge who allowed the writ of error.

In pursuance of this writ of error, the record was filed here and the case docketed on the 24th of November, 1856;

Opinion of the court.

and on the 4th of December the defendant appeared by counsel in this court.

A motion has been made at the present term to dismiss the case, because the citation is signed by the clerk, and not by the judge.

The citation is undoubtedly irregular in this respect, and the defendant in error was not bound to appear under it. And if a motion had been made at the last term, within a reasonable time, to dismiss the case upon this ground, it would have been dismissed. But the appearance of the party in this court, without making a motion to dismiss during the first term, is a waiver of any irregularity in the citation, and is an admission that he has received notice to appear to the writ of error. This point was decided in the case of *McDonogh v. Millaudon*, 3 How. 693; *United States v. Yulee*, 6 How. 605; and *Buckingham et al. v. McLean et al.*, 13 How. 150. And these cases have been recognized and affirmed in the case of *Carroll et al. v. Dorsey et al.*, decided at the present term (20 How. 204).

Indeed, any other rule would be unjust to a plaintiff in error, and is not required for the protection of the defendant. The latter is not bound to appear, unless he is legally cited, except for the purpose of moving to dismiss. He knows, or must be presumed to know, whether the notice which the law requires has been served on him or not. And if the objection is made at the first term, the plaintiff, by a new writ and proper citation, might bring up the case to the succeeding term. But if the defendant does not, by motion at the first term, apprise him of the irregularity of his proceeding in this respect, and of his intention to take advantage of it, the plaintiff is put off his guard by the defendant's appearance; and if the motion is permitted at the second term, he will be delayed an entire year in the prosecution of his suit, whenever it is the interest of a defendant in error to delay and harrass his adversary.

An affidavit has been filed by one of the counsel for the defendant in error, stating that he is the junior counsel in the case, and that he did not make the motion at the last term, because the senior counsel was absent in Europe, and

Argument of counsel.

the deponent did not wish to decide on the expediency of the motion to dismiss without consulting him; that he expected him to return before the term ended, but the court adjourned sooner than he anticipated, and the senior counsel did not return until the court had finally adjourned to the next term.

The facts stated in this affidavit cannot influence the decision of the motion. The absence of one or of all the counsel employed by one party, in pursuit of other business, furnishes no ground for delaying a case in this court, without the consent of the adverse party.

The motion comes too late, and is therefore overruled.

DAY
v.
HAYWARD. } No. 52.

The motion to dismiss in this case stands on the same ground with that of Chaffee, trustee of Day *v.* Hayward, just disposed of, and must, for the reasons assigned in that case, be also overruled.

When the case came up for argument, it was submitted on printed argument by *Mr. Jenckes*, for the plaintiff in error, and argued orally by *Mr. Bradley* and *Mr. Pitman*, for the defendant.

Messrs T. A. Jenckes and R. H. Gillet, for plaintiff in error:

The Circuit Courts have jurisdiction over the subject matter of these suits, without reference to the residence of the parties. The question, therefore, is whether the defendant was rightfully brought within the jurisdiction of the Circuit Court for the District of Rhode Island, by the attachment of his real and personal estate in that district, without personal service of the process upon him.

1. The Circuit Court for the District of Rhode Island having jurisdiction of the subject matter, may issue its process in the same form, and the process itself may be served

Argument of counsel.

in the same manner as process issuing from the Supreme Court of that State for any cause of action within its common law jurisdiction.

Process Act of May 8, 1792, sec. 2, Stat. at L. 1, 276.

The form of the writs in these cases and the mode or proceedings to bring the defendant before the court, were strictly in accordance with the law of Rhode Island.

Public Laws of R. I., Dig. 1844, pp. 110-113, 115.

The statute law of Rhode Island regulating attachments on original writ, was the same in 1789 as in 1855.

See Dig. 1767, p. 12; Dig. 1798, p. 201.

In all the statutes authorizing attachments of personal property, the same provision is found which is contained in the Dig. 1844, p. 113, sec. 3: "When an attachment is made in manner aforesaid, the same shall be sufficient to bring the cause to trial." Neither in the case of attachment of personal property, nor of real estate (p. 115, sec. 11) is there any provision made for personal service on the defendant. In the case of personal estate, a copy of the writ must be left at the defendant's usual place of abode (p. 113, sec. 3), and in the case of real estate, with the person in possession of the land, and with the clerk of the town where the land lies (p. 115, sec. 11). Such service (sec. 3, p. 113) is expressly declared sufficient to bring the cause to trial. In case of real estate, the execution runs against the property attached (sec. 11, p. 115).

2. The 11th section of the Judiciary Act of 1789 does not prohibit the taking of jurisdiction over this cause.

Picquet v. Swan, 5 Mas. 561; *Richmond v. Dreyfous*, 1 Sumn. 131; *Toland v. Sprague*, 12 Pet. 300.

The case of *Day v. The Newark India Rubber Manufacturing Co.*, 1 Blatchf. 628, was rightfully decided, inasmuch as the mode of proceeding adopted in the commencement of that suit had not been adopted by the Circuit Court of New York.

It is submitted that the Circuit Court in Rhode Island takes jurisdiction of cases under the Patent Laws, in the manner that the Supreme Court of that State takes jurisdiction of any transitory action.

Argument of counsel.

An objection to this view taken by Mr. Justice STORY in *Picquet v. Swan*, 5 Mas. 561, is that the Process Act was not intended to enlarge the jurisdiction of the Circuit Courts as defined by the Judiciary Act. This objection is not tenable in a patent cause, because the jurisdiction of the court is enlarged by the Patent Laws, and the Process Acts are to be applied for the purpose of carrying into effect the jurisdiction so conferred, as well as that founded on citizenship.

3. This is a case of attachment of specific property, real and personal, which, by the Rhode Island Statute, at the date of the Process Act, is made a sufficient service to bring the cause to trial, and therein differs from all the cases decided under the 11th section of the Judiciary Act, which were cases of foreign attachment. In *Picquet v. Swan*, 5 Mas. 561, there was an attempt to attach the real estate of the defendant, but this attempted service was declared by Judge STORY "defective and nugatory." The Statute of Rhode Island, in effect, declares that a defendant is to be found in that State for the purposes of the jurisdiction of its courts by his visible, personal, and real property, which can be seized and levied on by the sheriff. The decisions of the courts of the United States, in cases where the jurisdiction rests exclusively on citizenship, declare that a defendant is not "found" in a district where one of his debtors resides. There is no conflict in maintaining both propositions.

Messrs. Charles S. Bradley and Joseph S. Pitman, for defendants in error.

The defendant in error contends that the judgment of the Circuit Court of Rhode Island was correct, and should be affirmed, relying upon the following points:

1. No civil suit can be brought in the Circuit Court against the defendant in any district whereof he is not an inhabitant, or is not found at the date of the alleged service of the writ.

Judiciary Act of 1789, sec. 11, Stat. at L., Vol. 1, p. 79; *Hollingsworth v. Adams*, 2 Dall. 396; *Pollard v. Dwight*,

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4 Cranch 424; *Picquet v. Swan*, 5 Mason 35-48, 50; *Richmond v. Dreyfous*, 1 Sumn. 131, 2; *Harrison v. Rowan et ux.*, 1 Pet. C. C. 489; *Toland v. Sprague*, 12 Pet. 300, 328, 330; *Com. and R. R. B'k of Vicksburg v. Slocomb*, 14 Pet. 60; *Levy v. Fitzpatrick*, 15 Pet. 171; *Louisville R. R. Co. v. Letson*, 2 How. 556; *Herndon v. Ridgway*, 17 How. 424; *Sadlier v. Fallon*, 2 Curt. 579, 581.

The law has been equally well settled in relation to service of process in patent suits.

Horace H. Day v. The Newark India Rubber Manufacturing Co., 1 Blatchf. 629; *Saddler v. Hudson*, 2 Curt. 6.

2. But irrespective of the plea, there is apparent on the record itself, in the writ and the return of the Marshal thereon, sufficient ground to warrant the court below in dismissing this case. It was not necessary that the marshal should have made return that the defendant had no known place of abode in this district; yet, having done so, and also made return that the body of the defendant could not be found in the district, the parties are bound by the return and the facts it sets forth.

Lessee of Walden v. Craig's Heirs, 14 Pet. 152; *Cutler v. Rae*, 7 How. 731; *Scott v. Sandford*, 19 How. 401.

Mr. Justice CATRON delivered the opinion of the court:

The question of law decided below, and which we are called on to revise, arises on the following facts: On the 22d day of October, 1855, the plaintiff in error sued out a writ in the Circuit Court of the United States for the Rhode Island District, against Nathaniel Hayward, styling him as "of Colchester, in the State of Connecticut, commorant of Providence, in the State of Rhode Island," for the recovery of damages alleged to have been sustained by the plaintiff in error, by reason of an alleged infringement of a patent right claimed by said plaintiff.

On the same day the Marshal of Rhode Island district made return on the writ, that "for want of the body of the within defendant to be by me found within my district, I have attached," &c. (enumerating certain real estate lying in the City of Providence, in the State of Rhode Island),

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and a still further return of having made further service of the writ, by attaching all the personal estate of the defendant in the India rubber factory of Hartshorn & Co., and in the store or warehouse No. 7, Dorrance street stores, &c., and "have left true and attested copies of this writ, with my doings thereon with the City Clerk of the City of Providence, and with John Sweet and William E. Himes, they being in possession of the premises, the defendant having no known place of abode within my district."

At the November Term of the court, a declaration was filed containing the allegations of citizenship of the plaintiff and defendant, and that the defendant was commorant of Providence, as in the writ; and at the same term the defendant, in his own proper person, pleaded to the jurisdiction of the court that he was, at the time of the pretended service of the writ, and is, an inhabitant of the District of Connecticut, and not an inhabitant of the District of Rhode Island, nor was he, at the time of the pretended service of the writ, within the District of Rhode Island; praying the judgment of the court, whether it can or will take cognizance of the action against him.

To this plea the plaintiff, by his attorney, filed a general demurrer, on which the cause was heard, and at the June Term the court overruled the demurrer, and dismissed the case for want of jurisdiction; upon which the plaintiff sued out a writ of error.

By the 11th section of the Judiciary Act of 1789, it is provided: "That no civil suit in a circuit or district court shall be brought against an inhabitant of the United States by any original process in any other district than that whereof he is an inhabitant, or in which he shall be found at the time of serving the writ."

It has been several times held by this court as the true construction of the foregoing section, that jurisdiction of the person of a defendant (who is an inhabitant of another State), can only be obtained, in a civil action, by service of process on his person, within the district where the suit is instituted; and that no jurisdiction can be acquired by attaching property of a non-resident defendant, pursuant to

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a State attachment law. The doctrine announced to this effect, in the case of *Toland v. Sprague*, in 1838 (12 Pet. 327), has been uniformly followed since, both by this court and at the circuits.

Le Roy v. Fitzpatrick, 15 Pet. 171; *Herndon v. Ridgway*, 17 How. 424.

It is insisted, however, for the plaintiff, that these rulings were had in cases arising where the jurisdiction depended on citizenship; whereas, here the suit is founded on an Act of Congress conferring jurisdiction on the Circuit Courts of the United States in suits by inventors against those who infringe their letters patent, including all cases, both at law and in equity, arising under the patent laws, without regard to citizenship of the parties or the amount in controversy, and therefore the 11th section of the Judiciary Act does not apply, but the Process Acts of the State where the suit is brought must govern; and that the Act of Congress of May 8, 1792, so declares.

The 2d section of that act provides that the forms and modes of proceeding in suits at common law shall be the same as are now used in the Federal courts respectively, pursuant to the Act of 1789, ch. 21, known as the Process Act of that year.

This Act (sec. 2) declares, that until further provision shall be made, and except where by this act "*or other statutes of the United States is otherwise provided*," the forms of writs and executions, and modes of process in suits at common law, shall be the same in each State, respectively, as are now used or allowed in the Supreme Court of the same. This was to be the mode of process, unless provision had been made by Congress; and to the extent that Congress had provided, the State laws should not operate.

Now, the only statute of the United States then existing regulating practice, was the Judiciary Act of 1789 (ch. 20), which is above recited. The 11th section is excepted out of and stands unaffected by the subsequent Process Acts, and is as applicable in this case as it was to those where jurisdiction depended on citizenship. It applies in its terms

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to all civil suits; it makes no exception, nor can the courts of justice make any.

The judicial power extends to all cases in law and equity arising under the Constitution and laws of the United States, and it is pursuant to this clause of the Constitution that the United States Courts are vested with power to execute the laws respecting inventors and patented inventions; but where suits are to be brought is left to the general law, to wit: to the 11th sec. of the Judiciary Act, which requires personal service of process within the district where the suit is brought, if the defendant be an inhabitant of another State.

This case, and that of Day against Hayward, depend on the same grounds of jurisdiction, and were both correctly decided in the Circuit Court; and the judgment in each is affirmed.

Patent in suit:

No. 16. Chaffee, E. M., August 13, 1836. India Rubber.

Cited:**IN SUPREME COURT OF UNITED STATES :**

Habich v. Folger, 1873. 20 Wall. 1; Bk. 22, L. ed. 307.

Tioga R. R. v. Blossburg & Corning R. R., 1873. 20 Wall. 187;
Bk. 22, L. ed. 381.

IN CIRCUIT COURTS:

United States v. Am. Bell Telephone Co., Nov., 1886. 29 Fed.
Rep. 17.

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IN TEXT-BOOKS:

Curtis on Pats., 4th ed., § 497.

2 Abb. Pat. Law, 1886, p. 274.

Statement of the case.

HORACE H. DAY, APPELLANT, v. THE UNION INDIA RUBBER COMPANY.**20 How. 216—218. Dec., 1857.**

[Bk. 15, L. ed. 883; 1 Whit. 1062.]

Particular agreement construed. Fraud.

1. Licenses, and rights of licensees thereunder, construed in conformity with the decision in *Hartshorn v. Day*, 19 How. 211 [p. 380 *ante*], (p. 384).
2. Where it was alleged that a certain instrument was procured by fraud from C, *held*, that it was too late to set up any such ground of defense after C himself had carried the agreement into execution and acted under it, receiving its benefits for three years (p. 386).

[Citation in the opinion of the court:]

Hartshorn v. Day, 19 How. 211 [p. 380 *ante*], p. 385.

THE bill in this case was filed in the Circuit Court of the United States for the Southern District of New York, by the appellant, as the assignee of Edwin M. Chaffee, against the defendant, for the alleged infringement of a certain patent.

The court below dismissed the bill, and the complainant took an appeal to this court.

A further statement of the case appears in the opinion of the court.

See, also, *Hartshorn v. Day*, 19 How. 211 [p. 380 *ante*.]

Messrs. Thomas Jenckes and Clarence A. Seward, for the appellants.

Messrs. William Curtis Noyes, George A. Goddard, and Seth C. Staples, for the appellees.

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Mr. Justice NELSON delivered the opinion of the court: This is an appeal from a decree of the Circuit Court of the United States for the Southern District of New York.

The bill was filed in the court below by Day, as assignee of the patent of Edwin M. Chaffee, for a new improvement in preparing and applying India rubber to cloth, &c., dated the 31st August, 1836, and renewed for seven years from the 31st August, 1850, against the defendants, for an alleged infringement during the running of the renewed term.

The questions involved in the case are substantially the same as those presented and decided in the case of Hartshorn *et al. v. Day*, at the last term, and reported in 19 How. p. 211 [p. 330 *ante*]. That was an action at law, brought by the same plaintiff, upon this patent, against the defendants, who were licensees under Charles Goodyear, for the manufacture of India rubber boots and shoes. The defendants, in the present case, are licensees under Goodyear for the manufacture of India rubber cloth for various purposes. In both cases the right to manufacture the article rested upon the authority of Goodyear to grant the license, as derived from Chaffee, the patentee.

The court held, in the case of Hartshorn *et al. v. Day*, that under the agreement of the 5th September, 1850, between Chaffee, the patentee, and William Judson, the entire ownership in the patent, legal and equitable, passed to Judson for the benefit of Goodyear and those holding rights under him, and on that ground decided in favor of the licensees.

Now, in this case, the licenses under Goodyear to manufacture cloth of the description claimed are as broad and ample as were those to the defendants in the case just mentioned. Goodyear became the sole owner of the patent of Chaffee as early as 28th June, 1844, and on the 18th July following gave a license to the Naugatuck India Rubber Company to manufacture cloths, with certain exceptions, under all his patents—those in which he was then interested, or in which he might thereafter be interested, issued, or to be issued—and also, in all renewals of patents. He also gave a like extensive license, on the 28th of March, 1847,

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to W. E. & John Rider, for manufacturing of ships' letter and mail bags; and in February of the same year, a similar license to manufacture wearing apparel, &c., to Jonathan Trotter; and on the 1st July, 1848, one to Trotter and W. Rider & Brother, for the manufacture of army and navy equipments, sheet rubber, &c. All these various licenses afterwards became consolidated in the Union India Rubber Company, the defendants in this suit, and present, therefore, a complete defense to the suit, if Goodyear was the true owner of the Chaffee renewed patent. And this, as we have seen, has already been held in the case of Hartshorn *v.* Day [19 How. 211, p. 330 *ante*].

Besides, in the agreement of the 5th September, 1850, between Chaffee and Judson, it is expressly stated that the patent was conveyed to the latter to secure it for the benefit of Goodyear and those holding rights to use it under and in connection with his licenses; and Judson was also directed to hold it for their benefit.

The license of the defendants, therefore, in this case, stands upon two grounds, either of which would seem to constitute a sufficient defense to the suit for infringement: First, authority from Goodyear, the owner of the renewed term of the patent; and second, the express recognition of Chaffee, the patentee, of the right of these parties as licensees of Goodyear to use the improvement. And we may add to these grounds of defense, that upon the interpretation of the court in the case of Hartshorn *v.* Day, of the several agreements relating to this patent, and especially that of 5th September, 1850, Day took no interest in it under the assignment of Chaffee of 1st July, 1853, he having previous to that time parted with all his interest for the benefit of Goodyear and his licensees.

Some evidence has been given in the case for the purpose of showing that the agreement of 5th September was not sealed at the time of its execution, and that the seal must have been annexed afterwards without any authority. But it is too slight and uncertain to be entitled to any weight.

It has also been insisted that this instrument was pro-

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cured by fraud from Chaffee, through the contrivance of Judson. But the evidence relied on is very general and unsatisfactory; and besides, it is too late to set up any such ground of defense after Chaffee himself has carried the agreement into execution, and acted under it, receiving its benefits for some three years. And what is remarkable on this point, he is the chief witness to make out the alleged fraud.

It has also been urged that the licensees have not contributed to the fund for paying the expenses of the renewal of the patent. But this is a matter in which Chaffee had no interest. He has taken the indemnity of Judson against these expenses. The licensees were never liable to him for them.

Without pursuing the examination further, we are entirely satisfied, for the reasons above stated, that the decree below is right and should be affirmed.

Patent in suit:

No. 16. Chaffee, E. M., Aug. 13, 1836. India Rubber.

OTHER SUITS ON SAME PATENT:

Day v. Boston Belting Co., 1853. 16 Law Rep., 329.

Day v. Candee, 1853. 3 Fish. 9.

Day v. New England Car Spring Co., 1854. 3 Blatchf. 179.

Day v. New England Car Spring Co., 1854. 3 Blatchf. 154.

Day v. Hartshorn, 1855. 3 Fish. 32.

Day v. Union India Rubber Co., 1856. 3 Blatchf. 488.

Hartshorn v. Day, 1856. 19 How. 211; 1 Whit. 1031 [p. 330
ante].

Chaffee v. Boston Belting Co., 1859. 22 How. 217; 1 Whit. 1124.

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Cited :

IN CIRCUIT COURTS:

Day v. Stellman, July, 1859. 1 Fish. 487.

Wetherill v. Passaic Zinc Co., Oct. 1872. 6 Fish. 50; 9 Phila. 385; 2 O. G. 471.

IN TEXT-BOOKS:

2 Abb. Pat. Law, 1886, p. 138.

Walker on Pats., 1883, p. 372.

Curtis on Pats., 4th ed., § 203, note.

Statement of the case.

HORACE C. SILSBY, WASHBURN RACE, ABEL DOWNS, HENRY HENION, AND EDWARD MYNDERSE, APPELLANTS, *v.* ELISHA FOOTE.

20 How. 290-296. Dec., 1857.

[Bk. 15, L. ed., 822; 1 Whit. 1065.]

Appeal. Supersedeas.

1. By the 23d section of the Judiciary Act, as modified by section 2, Act 1803, the appeal is a *supersedeas*, and stays execution when taken within ten days (Sundays excepted) after *rendering* the judgment or *passing* the decree complained of (p. 389).
2. The time of rendering the decision or of passing the decree stated (p. 390).

[Citations in the opinion of the court:]

3 Dan. Pr. 131, p. 390.

APPEAL from the Circuit Court of the United States for the Northern District of New York.

On motion by appellee to dismiss this appeal on the ground that the same matters are appealed from in a prior case (No. 54), now pending on the docket of this court.

The case is stated by the court.

For the history and facts of the case and the opinion of this court on the merits, see (*Silsby v. Foote*) 20 How. 378 [p. *post*].

Messrs. Charles M. Keller, Samuel Blatchford and William Sackett, for appellants.

Mr. Elisha Foote, in person, and Mr. R. H. Gillet, for appellee.

— *Mr. Gillet* in favor of the motion cited § 22, Judiciary Act, 1789, Bouvier vol. 1, 467; Curt. Com. 234; *Roy v. Law*, 3 Cranch 179; *Whiting v. Bank of U. S.*, 13 Pet. 6, 15; *Michond v. Girod*, 4 How. 503; *Forgay v. Conrad*, 6

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How. 201, 203; Bank of U. S. *v.* Daniel, 12 Pet. 32, 52; Corning *v.* Troy Iron & Nail Factory, 15 How. 451, 459, 465, 466 [p. 144 *ante*].

Mr. Blatchford against the motion cited 1 Barb. Ch. Pr. 342; 2 Dan'l (Perkins ed. of 1846), 1220, 1221; 3 Dan'l, 131; Catlett *v.* Brodie, 9 Wheat. 553; Forgay *v.* Conrad, 6 How. 204.

Mr. Justice NELSON delivered the opinion of the court:

This is a motion to dismiss an appeal docketed as No. 106, on the ground that a previous appeal, docketed No. 54, had been taken by the same parties, and from the same portions of the decree below. The final decision had been made by the court, between the parties, on the coming in of the Master's report on the 28th August, 1856, and an appeal duly taken on the 4th September following. The decree was special in its terms, and was not settled or signed by the judge till the 11th December, 1856, on which day the second appeal was taken. As the appellant desired to appeal within the ten days, so as to stay execution, the second appeal was taken for abundant caution, as there might be a doubt from which period the ten days should be counted. namely: the time of the final decision of the court, or of the signing and filing of the special decree in form.

By the 22d section of the Judiciary Act, modified by the 2d section of the Act of March 3, 1803, an appeal from a final decree must be taken within five years after the rendering or passing of the judgment or decree complained of. And by the 23d section, as modified above, the appeal is a *superseideas*, and stays execution in cases only where it is taken and a copy lodged for the adverse party within ten days (Sundays exclusive) after *rendering* the judgment or *passing* the decree complained of. The time to be taken as when the judgment or decree may be said to be rendered or passed may admit of some latitude, and may depend somewhat upon the usage and practice of the particular court. In the case of a simple judgment or decree, such as an affirmance or reversal, and the like, there would seem to

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be no difficulty in taking the appeal at any time within the ten days after the decision on the case was pronounced. But where the decree is special, and its terms to be settled, there is a propriety in waiting for its settlement before taking the appeal. Whether taken or not, may sometimes depend upon the decree as settled. In the second circuit, with the practice of which I am most familiar, it is supposed by many of the profession that the proper time for taking the appeal in such a case is after the settlement of the decree. As this court, however, has always held, that if an appeal is taken in court at the time of rendering the decision, or during the term, no citation is necessary; and as appeals are, perhaps, more frequently taken within the ten days after the decision is pronounced and entered on the minutes by the clerk, it may be admitted when thus taken it is regular, and stays execution in the court below. And we are also of opinion, that if taken within ten days after the decree is settled and signed by the judge, and filed with the clerk, that it is in time to stay the proceedings. The recognition of the two periods from which the ten days may be counted becomes necessary, on account of the difference in the modes of proceeding and practice in the different courts. This question cannot arise in England, as the time for appeal runs two years from the enrollment of the decree. 3 Dan. Pr., 131. The time of enrollment cannot well be adopted by this court, as in many of the circuits it is understood, according to the practice, no enrollment of the decree takes place.

As, upon our view of the case presented on the motion, the first appeal was regular, the one taken and standing on the docket No. 106 should be dismissed.

Patent in suit:

No. 2636. Foote, E., May 26, 1842. Cooking Stove.

Cited:

IN SUPREME COURT OF UNITED STATES:

Wheeler v. Harris, 1871. 18 Wall. 51. Bk. 20, L. ed. 531.

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Telegraph Co. v. Eyser, 1873, 19 Wall. 419. Bk. 22, L. ed. 43.
Board of Coms. v. Gorman, 1874. 19 Wall. 661. Bk. 22, L. ed. 226.

Vznaga v. Harrison, 1876, 93 U. S. 233, Bk. 23, L. ed. 892.

IN CIRCUIT COURTS:

United States v. Garcia, November, 1870. 1 Sawy. 383.

Harris v. Wheeler, December, 1870. 8 Blatch. 81.

In re Place & Sparkman, January, 1872. 9 Blatch. 369.

IN TEXT-BOOKS:

Walker on Pats., 1883, pp. 364, 446.

Syllabus.

HORACE C. SILSBY, WASHBURN RACE, ABEL DOWNS, HENRY HENION, AND EDWARD MYNDERSE, APPELLANTS, *v.* ELISHA FOOTE.

20 How., 878-898. Dec., 1857.

[Bk. 15, L. ed., 953; 1 Whit. 1071.]

Modifying, *Foote v. Silsby*, 2 Blatch. 260.

Particular patent sustained in part. Delay in filing disclaimer.

1. Decree as to amount of damages, but with interest disallowed, affirmed by a divided court (p. 398).
2. Claim 2 of letters patent No. 2636, Foote, E., May 26, 1842, cooking stove disproved by prior construction and use of Saxon stove; otherwise sustained (p. 398).
3. Under Act 1837, § 9, notwithstanding that patentee claims too much, the patent is good for what is truly his, and he is entitled to maintain a suit at law for its infringement (p. 398).
4. Where the alleged anticipating device had been produced after suit had been commenced, and its relevancy had been questioned from thence to the present time, and disclaimer thereto was not yet entered, *held* there was no unreasonable delay in entering it (p. 399).

[Citations in dissenting opinion of the court:]

O'Reilly v. Morse, 15 How. 62 [5 Am. & Eng. 483], p. 400.

Silsby v. Foote, 14 How. 218 [5 Am. & Eng. 411], p. 404.

McCormick v. Manny, 6 McLean 539, p. 404.

Seymour v. McCormick, 16 How. 480, p. 406.

APPEAL from the Circuit Court of the United States for the Northern District of New York.

The bill in this case was filed in the court below on the 9th of October, 1848, by Elisha Foote, against defendants, claiming damages for the infringement of a certain patent. On February 22, 1849, the defendants filed a joint and several answer to the bill.

On March 2, 1849, a replication was filed. July 12, 1850, complainants filed a supplemental bill of complaint.

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January 14, 1851, the defendants filed a joint and several answer to the supplemental bill.

January 28, 1851, a replication to said last named answer was filed.

April 13, 1851, an interlocutory order was made, that the feigned issues allowed by a former order be made up and tried.

Upon the trial of the feigned issue, the jury returned an answer in the negative to the following questions:

First. Was the plaintiff the original and first inventor of the application of the expansive and contracting power of a metallic rod by different degrees of heat, to open and close a damper which governs the admission of air into a stove in which it may be used, by which a more perfect control over the heat is obtained, than can be by a damper in the flue?

Second. Was plaintiff the original and first inventor of the combination described in his patent, by which the regulation of heat of a stove in which it may be used is effected?

Subsequently, on August 29, 1853, the said cause having been previously brought to a hearing, an interlocutory order was entered, in which the court held that the complainant was the first and original inventor of the application of the expansion and contraction of the inflexible metallic rod to the regulation of the heat of stoves, as described and claimed in his patent; that the defendants had infringed the said patent in making and vending the regulators of stoves, as charged in the bill of complaint; and that the complainant was entitled to have a perpetual injunction against said defendants, their agents, servants, and all claiming or holding under or through them, from making, vending, or using, or in any manner disposing of any regulator or regulators of stoves embracing the invention or improvements described in said letters patent.

"And it is further adjudged and decreed that the cause be referred to Augustus A. Boyce, the clerk of this court, to ascertain and report the number of regulators for stoves embracing the principles aforesaid that have been made, and also the number sold by the said defendants or either of

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them, since the 23d day of March, 1847, and the damages complainant has sustained, or use and profits the defendants, or either of them, have derived by such infringements since the time last aforesaid.

"And upon the coming in and confirmation of the said report, that said complainant have a decree and execution for the amount found due to him, and also for the costs in this suit to be taxed."

On June 17th, 1854, the report of said Boyce was filed. Both parties filed exceptions, some of which were sustained by the court, and a further examination of the evidence taken before the Master was made by the court, and a final decree was entered against the defendants for \$23,644.20, with costs. The decree also made provision as to the joint and several liability of said defendants.

From this decree the defendants took an appeal to this court.

A further statement of the case appears in the opinion of the court, and in the dissenting opinion of Mr. Justice GRIER.

Messrs. Charles M. Keller, Samuel Blatchford and William A. Sackett, for appellants:

The answer insists that the first claim of the plaintiff's patent is void, because it is a claim to the application of an abstract principle or natural property of metals to certain purposes, and is not a claim for the invention of any mechanical structure or process by which such principle may be applied, and is not a fit subject for a patent. It is impossible to distinguish the first claim of the plaintiff's patent from the eighth claim of Morse's reissued patent of 1848, which was adjudged by this court in *O'Reilly v. Morse*, 15 How. 62, 112, 120 [5 Am. & Eng. 483], to be void.

This objection strikes at the very foundation of the interlocutory decree, and, if that cannot be maintained, the reference and all proceedings thereon, and the final decree, must fail.

The counsel then reviewed the case of *O'Reilly v. Morse*, and attempted to show that the present case was parallel.

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2. The answer insists that the said alleged disclaimer is insufficient, invalid, and void in law as a disclaimer, because the part of the claim of the specification, which is not intended to be disclaimed, is not capable of being distinguished from the part of the claim which is intended to be disclaimed.

And also that the first claim is void, for the reason that it is immaterial whether the expansive and contracting properties of a metallic rod be applied to open and close a damper that regulates the admission of air into a stove, or to open and close a damper in the flue. The substitution of the one for the other does not involve invention. In his disclaimer, the plaintiff admits the want of novelty in the application of the device claimed by him to regulate the defect in structures other than the stove, and to govern the admission of air into other than stoves, instead of regulating the damper in the flue; and the claim of the plaintiff, as limited by the disclaimer, admits that such a device had been used to govern the damper in the flue.

3. If the alleged disclaimer be regarded as a valid disclaimer, then it is submitted that the specification must be construed and limited by the terms of such disclaimer. The disclaimer must be considered in two aspects: 1st. As affecting all the claims of the patent, which was the view taken by the court below, as shown by the manner in which it presented the issues of the first and third claims to the jury. 2d. As affecting the first claim only. The disclaimer either affects all the claims of the patent, or the patent is void on its face for multiplicity of invention. One part of the patent would be for an improvement in stoves only, and the other parts for improvements in stoves and other structures. On the assumption, however, that the disclaimer applies to all the claims of the patent, then it is contended by the defendants that the admissions of the disclaimer avoid the patent in judgment of law, for want of invention. In substance the disclaimer imports that, prior to plaintiff's invention the expansive and contracting power of an inflexible metallic rod had been applied to operate the damper which governs the admission of air into a structure not a stove,

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and all he can claim as new is the mere application of this to a structure called a stove. If, therefore, the disclaimer applies to all the claims, it is contended that in view of such limitation of the claims, the patent is void on its face, as being merely for the double use of a known invention, or what is termed the application of a known thing to another and an analogous use, which, in judgment of law, is not the subject matter of letters patent.

Winans v. R. R. Co., 2 Story 412; *Bean v. Smallwood*, 2 Story 408; *Howe v. Abbott*, 2 Story 190; *Losh v. Hague*, Web. Pat. Cas. 207 [2 Am. & Eng. 501]; *Corning v. Burden*, 15 How. 252, 270 [p. 69 *ante*]; *Curtis on Patents*, secs. 4, 26, 27, 86-88.

The purpose for which an invention is used or to which it is applied, makes no part of the invention. It is a necessary consequence that if the varying heat will expand and contract a metallic rod to open and close a damper which governs the admission of air to the fire in any structure, it will do so in a stove; and that if this mode of regulating the admission of air to the fire in any structure will regulate heat, it will do so in a stove.

Hotchkiss v. Greenwood, 11 How. 248 [5 Am. & Eng. 240].

The counsel then reviewed the evidence in reference to the novelty of the plaintiff's invention, and also the exceptions to the Master's report.

Mr. Elisha Foote, in person, and *Mr. R. H. Gillet*, for appellee.

The argument for the appellee being confined to the facts and evidence concerning the invention, is not here given.

Mr. Justice NELSON delivered the opinion of the court:

This is an appeal from a decree of the Circuit Court of the United States for the Northern District of New York.

The bill was filed in the court below by Foote against the defendants for an alleged infringement of a patent for an improvement in regulating the draught or heat of stoves.

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The bill, among other things, set out a trial at law between the parties upon the patent, and a verdict for the plaintiff; that the defendants, since the trial and verdict, continued their infringement, and have even increased the business of making and vending the complainant's stove regulators.

The complainant prayed for an account, and that the defendants be restrained by injunction from further infringements.

The defendants put in an answer to which there was a replication. Afterwards feigned issues were ordered by the court, to try the questions whether or not the patentee was the first and original inventor of the application of the expansive and contracting power of the metallic rod, by different degrees of heat, to open and close the damper which governs the admission of air into a stove; and also, whether or not he was the first and original inventor of the combination described in his patent, by which the regulation of the heat of a stove in which it might be used was effected.

The jury, after hearing the proofs upon these issues, returned a verdict in the negative. Afterwards the cause came before the court upon the pleadings and proofs, and the case made upon the trial of the feigned issues; and after hearing the arguments of counsel for the respective parties, held that the patent was valid, notwithstanding the verdict of the jury on the feigned issues, and also that the defendants had been guilty of an infringement, and referred the cause to a master, to ascertain and report the profits which the defendants had derived by reason of said infringement. A most voluminous record of testimony was taken before the Master, and on the 17th June, 1854, he reported profits made by the defendants to the amount of \$2,650. Thirty exceptions were filed to the report by the counsel for the complainant, and eighteen by the defendants, and were argued before the court. The view the court has taken of the case here, renders it unimportant to refer particularly or specially to the decision of the court below, upon each of these exceptions. After disposing of them, the court, agreeably to an earnest request of the counsel that the cause

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should not be again sent down to the Master, but that the court, upon the evidence before it, should ascertain the amount of profits to which the complainant was entitled, entered upon the inquiry, and, after a laborious and minute examination of a record of some six hundred closely printed octavo pages of proofs, found an aggregate of profits to the amount of \$17,980.40, and an aggregate of interest averaged of \$5,663.82, making a total of \$23,644.22. And on the 28th of August. 1856, a final decree was entered for the complainant against the defendants for this amount with the costs to be taxed.

The cause is now before this court on appeal.

The difference of opinion among the judges of this court in respect to the amount of profits that should be allowed to the complainant, precludes the delivery of any written opinion on this branch of the case. The decree of the court below as to the amount, with the exception of the interest, is affirmed by a divided court. A majority of the court are of opinion that there was error in the allowance of interest on the profits found for the complainant. That amount, therefore, which is \$5,663.82, must be deducted.

This court is also of opinion that the court below erred in awarding costs of the complainant against the defendants.

The first claim of the patentee in his patent was disproved by the prior construction and use of what is called in the case the Saxton stove, and no disclaimer was entered according to the requirements of the Act of Congress 3d March, 1837. By the 9th section of that act it is provided, that when a patentee by mistake shall have claimed to be the inventor of more than he is entitled to, the patent shall still be good for what shall be truly and *bona fide* his own, and he shall be entitled to maintain a suit in law or equity for an infringement of this part of the invention, notwithstanding the specification claims too much. But in such case, if judgment or decree be rendered for the plaintiff, he shall not recover costs against the defendant, unless he shall have entered a disclaimer in the Patent office of the thing patented, to which he has no right, prior to the commencement of the suit. There is also another condition, namely: that

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the plaintiff shall not be entitled to the benefits of the section if he has unreasonably neglected or delayed to enter the disclaimer.

The Saxton stove was produced on the trial of the feigned issues, after this suit had been commenced, and the question has been in controversy from thence to the present time, whether or not the arrangement, construction, and use of that stove had the effect to disprove the first claim in the complainant's patent. It would be going too far, therefore, under these circumstances, to hold that the delay in entering the disclaimer was unreasonable within the meaning of the statute. A majority of the court is of opinion the delay has not been unreasonable within the meaning of the Act, so as to defeat the recovery.

According to our conclusions, the decree of the court below is reversed as to the \$5,663.82 interest, and also as to the costs allowed the complainant, and affirmed as to the residue, without costs to either party in this court; and that the case be remitted to the court below to enter a decree for the complainant against the defendants in conformity to this opinion, and proceed to the execution of the same.

Mr. Justice GRIER, dissenting:

Although I may occasionally differ in opinion with the majority of my brethren, my usual custom has been to submit to their better judgment without remark. But in this case I feel constrained to protest against a decree which, in my opinion, does great and manifest injustice to the appellants. In doing so it is proper that I thus state my reasons as briefly as possible, without an attempt at their full vindication by a tedious argument.

1. I believe the patent of complainant to be void on its face.

The first claim is for the application of the "expansive and contracting power of a metallic rod by different degrees of heat, to open and close a damper which governs the admission of air into a stove."

Now, this claim is false in fact. The patentee was not

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the first to make this application of the different degrees of expansion of metals to open and close a damper to a stove. The evidence is clear, explicit, and uncontradicted. Moreover, the jury has so found in an issue ordered in this case, and which verdict does not appear to have been set aside, although it was disregarded in the decision of the case.

This claim, even if it were true in fact, is clearly void in law, unless we agree to reverse the doctrine laid down by this court in the case of *O'Reilly v. Morse* [15 How. 62; 5 Am. & Eng. 483], with regard to the eighth claim of Morse's patent. Besides, at the trial at law, the Circuit Court decided, in 1848, that this first claim could not be sustained. Yet, with ten years' judicial notice of this defect in his patent, the patentee has never amended it, entered a disclaimer, or attempted to avail himself of the privilege offered to him by the Statute to rescue it from this charge, so destructive to its validity.

At common law, a patent having this infirmity was absolutely void. The Patent Act of 1836, sec. 13, provides a remedy: "where a patent is inoperative and void, by reason of a patentee's claiming in his specification as his invention more than he had a right to claim, and when the error has arisen through inadvertence or mistake."

In such a case the patentee is permitted to surrender his patent, and, on payment of a further sum, have his patent reissued as corrected. But he was not permitted to recover any damage for infringement which occurred before the date of the reissued patent.

The Patent Act of 1837, sec. 7, gives a further privilege to the patentee of escaping the consequences of such a defect, "where his patent is too broad," by permitting him to enter a disclaimer, to be taken and considered as part of the original specification. It does not subject him to the costs of a new patent, nor to the forfeiture of antecedent damages, where the disclaimer is made during the pendency of a suit, but gives the defendant a right to object to its validity on account of unreasonable neglect and delay in filing it.

The 9th section of the same Act provides for the case

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where "the patentee, in his specification, has claimed to be the inventor of any material or substantial part of the thing patented, of which he was not the first inventor, and provided it be distinguishable from other parts claimed in his patent. He is permitted to sustain his action for such part as is *bona fide* his own invention, forfeiting his right to costs where he has not filed a disclaimer before suit brought. But no person, bringing any such suit, shall be entitled to the benefits of this section, who shall have unreasonably neglected or delayed to enter at the Patent Office a disclaimer, as aforesaid."

Now, the first claim of this patent does not come within the category of the 9th section. It is not for "a material and substantial part of the thing, distinguishable from other parts," but it is the case embraced in the 7th section, where the claim is void, because it is too broad.

Here the claim is for a monopoly of the expansive power of metals when applied to a stove, and this expansive power is a necessary agent in every claim for a combination in the patent.

The seventh section gives the patentee no right to recover at all, unless a disclaimer has been filed before trial or judgment. But, assuming that the privilege given by the 9th section be available to the patentee in this case, has he brought himself within the proviso? He has refused to avail himself of the privilege tendered to him by the law, and stands upon his patent. Notwithstanding the decision of the Circuit Court against this claim in 1848; notwithstanding the decision of this court in *O'Reilly v. Morse*; notwithstanding the verdict in 1853, declaring this claim false, no disclaimer has ever been entered. The pendency of the suit could be no reason, for the Acts contemplate a pending suit. I cannot consent to say that this is not a case not only of unreasonable delay, but of stubborn rejection of the privilege offered by the law.

The case of *O'Reilly v. Morse* cannot be quoted as a precedent for this. There, Morse was admitted to be the original inventor of the application of an element of nature in his eighth claim; but the court decided that it was void,

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because it was too broad. Until that decision was read in court, the patentee had not the least reason to suspect his claim to be invalid. The decision was a surprise not only to him, but many others more learned in the law, who had carefully examined this claim, and advised the patentee that it was valid. In the present case, the patentee disregarded the judgment of a circuit court, a verdict of a jury, and judgment of this court, all of which warned him of the necessity of a disclaimer many years before final judgment.

I cannot consent to annul the statute altogether, and allow its benefits to a patentee who has stubbornly refused to submit to the conditions on which they are tendered.

II. The interlocutory decree of the court below does not condemn the defendants for infringing the third claim of the complainant's patent, on which alone it was decided on the trial at law the defendant was liable, and on which it is now attempted to justify this decree. What that decree is, must be judged by the record, and not by any parol explanations or contradictions of it.

The decree affirms—

1st. That the plaintiff was the first inventor of the *application* of the expansion and contraction of the inflexible metallic rod to the regulation of the heat of stoves.

2d. That any regulator in which the expansive and contracting power of an inflexible metallic rod, which expansion and contraction is produced by changes in the heat of the stove regulated, is *applied* to the damper to regulate the heat of the stove, is embraced within the principle of the invention claimed in the patent.

3d. That the defendants have made and sold regulators embracing that principle.

4th. That they must account for all regulators made and sold by them which embrace that principle.

This decree charges the defendant with the infringement of the first claim of the patent, and is in conformity with the doctrines advanced in the charge of the court, on the issue tried before them, where the court thus define the claim of the patent:

"Now, in this case, as I understand the claim of the

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patentee, he claims the application of expansion and contraction in a metal rod regulating the heat of a stove. To which he claims to have struck out an abstract conception would not have been matter of a patent, yet, when it is by any means, old or new, resulting from a patent, independently of the application, it is made."

Again, speaking of the first claim:

"That claim is not for any mode of applying the expansion and contraction of a rod to regulate the heat of the stove, but is for the idea itself."

The interlocutory decree says, that the defendants sold brass rod regulators, which the defendants answers they made and sold, are in conflict with tiff's patent, because they embrace the application of the expansive and contractible metallic rod to the damper of a stove, which is directed to take an account of the heat within the principle specified, no mechanical structure is, or how they may do, of which the plaintiff gives a description, and no matter whether they embrace the plaintiff claims in either his fourth or fifth claim. The plaintiff and defendants effect, that they do not care for any claim of the patent but the first is, that the defendants have been guilty of applying the expanding and contracting power of an inflexible rod to regulate and close the damper of a stove in such a manner that the heat of the stove produce the expansion, and they must respond for all instances.

The defendants are found guilty of the claim of the patent alone. No testimony was given to show that the Race patent was not valid, and this fact was emphatically denied. Nor was the verdict and judgment

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And if it had been, it is no estoppel in equity to the defendants' putting the truth of that charge of the bill in issue in his answer. That verdict and judgment is put into the bill, as laying a proper ground for the granting of the preliminary injunction. Nor is it true, as now asserted, that this court has decided the question in the case of *Silsby v. Foote*, 14 How. 218 [5 Am. & Eng. 411].

On that trial the court below had instructed the jury, "that the defendants had not infringed the plaintiff's patent unless they had used all the parts embraced in the plaintiff's combination," and submitted the question to the jury whether there had been such infringement.

This instruction was adjudged by this court to be correct. The question whether the verdict was correct was not before this court, and could not have been decided.

The third claim which is *now* alleged to be infringed is as follows:

"I also claim the combination *above described*, by which the regulation of the heat of a stove or other structure, in which it may be used, is effected."

The law requires that a patent should "particularly specify and point out the part, improvement, or combination which the patentee claims as his own invention."

This claim does not specify the combination claimed, otherwise than by reference to the body of the specification where two distinct and complex combinations of numerous parts and devices are set forth.

After a full and fair trial the jury have found, on an issue directed for that purpose, that the complainant was not the first and original inventor of the combinations set forth in this claim. But assuming that the court may disregard this verdict, and, without setting it aside or ordering a new trial of the issue, treat it as a nullity; and assuming, that without any testimony whatever being offered in the case, the court may, on view of the models, declare that the defendants' patent infringes that of complainant; and assuming the doctrine affirmed by this court in *Silsby v. Foote*, and *McCormick v. Manny* [6 McLean, 539], to be correct, "that defendant has not infringed plaintiff's patent

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unless he has used all the parts embraced in plaintiff's combination." I think it is clear to ocular demonstration that the defendants have not infringed either of the combinations claimed, unless we assert that all other combinations which produce the same result are equivalents for the first—a sophism which has just been rejected by this court in the case of *McCormick v. Manny*. A vindication or demonstration of the correctness of this conclusion could not be made intelligible unless by a long recital from the specification and an exhibition of models or diagrams. The decree of the court below very properly does not assert or adjudge that defendants have used the complex combination of complainant's specification in any of its numerous parts save one—the expanding rod. On this point, therefore, my objection to the affirmance of any portion of this decree is, because it is founded on a claim admitted to be void in law, and is sustained by presuming, contrary to the record, that it was founded on a claim found by verdict in the case to be void in fact, and without any proof of infringement save ocular demonstration of the contrary.

III. But, assuming the verdict of 1848 between the present complainant and some of the defendants to be conclusive as an estoppel on all of them, notwithstanding the denial of the answer and the evidence of our senses, yet that verdict was between the complainant's patent and the Race patent, which is called the "brass rod regulator," then used by the defendants. It had no reference whatever to the "expander patent," afterwards used by defendants. There is no charge in the bill that the combination of this last patent infringes the complainant's patent. There was no evidence offered to prove such to be the fact. The master's report declares it not to be an infringement of the combination of the third claim—it is patent to the eyes of any one who will examine the models that it does not; yet, because it used the expansive power of metals, the defendants are mulcted in the sum of \$7,033 damages, not for invading the complainant's rights, but for evading his patent by a patented invention for a different combination. I forbear to make any further remarks on this enormity, because it is affirmed by the

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division of the court, and their opinion has, happily, not been compelled to defend it by argument. As it is without precedent, so neither can it be cited as such hereafter.

IV. Lastly, after a very long and laborious investigation, the Master has found that the profit of making and vending the machine charged as an infringement, is ten cents on each regulator. This finding of the report was excepted to by the complainant. The court overruled the exception and confirmed the report on this point; and, nevertheless, assess the damage at *tenfold the amount*. By what process of reasoning or arithmetic, on what facts or what principle of law, this astonishing and ruinous decree is founded, it does not undertake to explain. I can conceive of no other ground than that the court have calculated the whole profit of the stove, as was done in the case of *Seymour v. McCormick* [16 How. 480; p. 200 *ante*] and overruled by this court.

Believing, therefore, that the decree of this court, so far as it affirms any portion of the decree of the Circuit Court, is not only unsustained by evidence, but contrary to the law as heretofore established by this court, I cannot give my assent to it.

Mr. Justice DANIEL, dissenting.

[I concur entirely in the views expressed by my brother GRIER in this cause. I have always regarded the patent of the complainant void upon its face. I, moreover, consider the decree of the Circuit Court inconsistent with the claim of the complainant, unwarranted by any evidence in the cause, and most unjust and oppressive in its operation.]

Notes:**1. Allowance of interest on damages and profits.**

Mowry v. Whitney, 14 Wall. 620.

Littlefield v. Perry, 21 Wall. 205.

Parks v. Booth, 102 U. S. 96.

Railroad Co. v. Turrill, 26 O. G. 914.

Railroad v. Root, 105 U. S. 189.

Notes and Citations.

Yale Lock Mfg. Co. v. Sargent, 117 U. S. 536.
Tilghman v. Proctor, 125 U. S. 136.

3. Act 1837, § 9; Act 1870, § 60; R. S., § 4922.

4. Delay in filing disclaimer.

O'Reilly v. Morse, 15 How. 62 [5 Am. & Eng. 483].
Seymour v. McCormick, 19 How. 96 [p. 282 *ante*].
Smith v. Nichols, 21 Wall. 112.
Dunbar v. Myers, 94 U. S. 187.
Gage v. Herring, 107 U. S. 640.
Yale Lock Co. v. Sargent, 117 U. S. 536.

Patent in suit:

No. 2636, Foote, E., May 26, 1842. Cooking Stove.

OTHER SUITS ON SAME PATENT:

Foote v. Silsby, 1849. 1 Blatchf. 445; Fish. Pat. Rep. 268.
Foote v. Silsby, 1850. 1 Blatchf. 542; Fish. Pat. Rep. 391.
Foote v. Silsby, 1850. 1 Blatchf. 545; Fish. Pat. Rep. 357.
Foote v. Silsby, 1851. 2 Blatchf. 260.
Silsby v. Foote, 1852. 14 How. 218; 1 Whit. 717 [5 Am. & Eng. 411.
Foote v. Silsby, 1856. 8 Blatchf. 507.

Notes and Citations.

Cited :**IN SUPREME COURT OF UNITED STATES:**

- The Merrimack, 1872. 14 Wall. 199. Bk. 20, L. ed. 873.
Parks *v.* Booth, 1880. 102 U. S. 96. Bk. 26, L. ed. 54.
Root *v.* M. S. & L. S. Ry. Co., 1881. 105 U. S. 189. Bk. 26,
L. ed. 975.
Yale Lock Co. *v.* Sargent, 1886. 117 U. S. 536. Bk. 29, L. ed.
954.
Tilghman *v.* Proctor, 1888. 125 U. S. 136.
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IN CIRCUIT COURTS:

- Goodyear *v.* Providence Rubber Co., November, 1864. 2 Cliff.
351; 2 Fish. 499.
Brady *v.* Atlantic Works. October, 1878. 3 Ban. & Ard. 577;
15 O. G. 965.
Steam Stone Cutter Co. *v.* Windsor Mfg. Co. August, 1879. 17
Blatchf. 24; 4 Ban. & Ard. 445.
Barker *v.* Stowe, January, 1882. 20 Blatchf. 185; 11 Fed. Rep.
303; 22 O. G. 259.
New Process Fermentation Co. *v.* Maus., June, 1884. 20 Fed.
Rep. 725.
Matthews *v.* Flower, October, 1885. 25 Fed. Rep. 830; 33 O. G.
887.
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IN TEXT-BOOKS:

- Merwin on Pat. Invt., 1883, p. 571.
Walker on Pats., 1883, p. 501.
Curtis on Pats., 4th ed., §§ 150, 242, 379, 436.
2 Abb. Pat. Laws, 1886, pp. 43, 212, 377.
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Dec., 1857.]

SILSBY v. FOOTE.

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Syllabus.

CYRUS H. McCORMICK, APPELLANT, *v.* WAITE TALCOTT, RALPH EMMERSON, JESSE BLINN, AND SYLVESTER TALCOTT, SURVIVORS OF JOHN H. MANNY.

20 How. 402-412. Dec., 1857.

[Bk. 15, L. ed. 930; 1 Whit. 1085.]

Affirming, McCormick *v.* Manny, 6 McLean, 539.

Inventor first in the art. Inventor of mere improvement. Doctrine of equivalent. Particular improvement patents construed, limited and not infringed.

1. The original inventor of a device or machine will have a right to treat as infringers all who make machines operating on the same principle and performing the same functions by analogous means or equivalent combinations, even though the infringing machine may be an improvement of the original and patentable as such (p. 426).
2. But if the invention be an improvement on a known machine by a mere change of form or combination of parts, the patentee cannot treat another as an infringer who has improved the original machine by the use of a different form or combination performing the same functions (p. 426).
3. A claim for a combination of mechanical devices or parts is not infringed by one who uses a part of the combination (p. 426).
4. Claim 4 of letters patent No. 3895, McCormick, C. H., January 21, 1845, Harvester, construed to be for a novel form or combination, constituting an improvement on prior machines, and therefore the doctrine of equivalents cannot be invoked to treat as an infringement defendant's machine differing in combination, because it performs the same functions as well or better. 5th claim is not infringed (p. 428).
5. Claim 2 of re-issue, letters patent No. 239, McCormick, C. H., May 24, 1853, Harvester, construed and limited in order to be sustained, to the location of one of its elements, a combination of the reel with a seat "arranged and located as described," and not infringed by device differing in form, principle and combination (p. 428).

Statement of the case.

APPEAL from the Circuit Court of the United States for the Northern District of Illinois.

The bill in this case filed in the court below, by the appellant, charges the appellees with the infringement of certain patents, and prays for an injunction and an accounting.

The court below having entered a decree dismissing the bill, the complainants took an appeal to this court.

McCormick's patent had been twice before this court. The fourth and fifth claims of patent No. 3895, of 1845, were involved in *Seymour v. McCormick*, 19 How. 96, [p. 282 *ante*], which see, and the claim to the seat of the raker under the original patent, No. 5335, of 1847, now up under a re-issue in *Seymour v. McCormick*, 16 How. 480 [p. 200 *ante*]. The original and re-issued patents were as follows:

UNITED STATES PATENT OFFICE. C. H. McCORMICK, OF STEELE'S TAVERN, VIRGINIA. IMPROVEMENT IN REAPING-MACHINES.* SPECIFICATION FORMING PART OF LETTERS PATENT No. 5,335, DATED OCTOBER 23, 1847.

To all whom it may concern:

Be it known that I, CYRUS H. McCORMICK, of Steele's Tavern, in the County of Rockbridge and State of Virginia, have invented new and useful improvements in the reaping-machine formerly patented by me; and I do hereby declare that the following is a full, clear, and exact description of the principle or character which distinguishes them from all other things before known, and of the manner of making, constructing, and using the same. reference being had to the accompanying drawings, making part of this specification, in which—

Figure 1 is a perspective view, fig. 2 a plan, and fig. 3 a side elevation.

The same letters indicate like parts in all the figures.

The reaping-machines heretofore made are defective in the following particulars: The driving-wheel is placed for-

* The drawings of this patent are identical with those of the re-issue, No. 239, in which they are merely enlarged.

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ward of the mechanism that operates the vibrating sickle, and so far forward as to leave too much of the weight of the machine back of the driving-wheel, and therefore tending to strain the horses as well as the frame of the machine, and the gearing which communicates motion to the crank is placed back of the driving-wheel, which is therefore subject to be clogged by sand, dirt, straw, &c., and in consequence of the relative position of the various parts the attendant is obliged to walk on the ground, by the side of the machine, to rake the cut grain from the platform as it is delivered and laid thereon by the reel. These defects, which have so much retarded the introduction into practical and general use of reaping-machines, I have remedied by my improvements, the nature of which consists in placing the driving-wheel farther back than heretofore, and back of the gearing which communicates motion to the sickle, which is placed on a line back of the axis of the driving-wheel, the connection being formed by means of a lever and connecting-rod, thus placing the cog-gearing which operates the crank forward of the driving-wheel, for the purposes described, and also bringing the driving-wheel sufficiently far back to balance the frame of the machine with the raker on it, and make room for him to sit or stand on the frame back of the driving-wheel and with his back to the horses, so that from this position and the placing of the reel farther forward than heretofore and making it shorter, together with the employment of a wheel board or guide, which prevents the grain from passing under the machine or into the gearing, thereby avoiding the necessity of a long reel, he can rake off the grain with a sweep of his rake (having the free use of his body and arms) in a curve of which his body is the centre, and thus lay the grain on the ground with the heads outward at right angles to the swath, which cannot be done if the raker walks on the ground by the side of the machine, as heretofore, for then the sweep which he makes with his rake relatively to the motion of the machine lays the grain on the ground with the heads oblique instead of at right angles with the swath, as with the improved mode.

Dec., 1857.] McCORMICK v.

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In the accompanying drawings (called the "finger-piece"), to each of which are secured the fingers of the machine heretofore patented by me, is arranged the vibrating sickle, in motion in manner to be hereinafter described. The piece is firmly attached at one end to the hounds C and D, which run to be bolted to the tongue A, the former through the breast-piece B. The tongue, hounds, and breast-piece are arranged in the manner. The axle of the driving wheel runs in the two hounds, so near the bearing as to leave room for the wheel to run back and to the outer end of the axle, where it carries attached a beveled master cog-wheel, E, in motion to a bevel-pinion, F, on the arbor, to the upper end of which is attached a wheel, G, which communicates motion to H, on a vertical crank-arbor, I, to connect it between the crank and pinion. The wheel, G, rests in bearings on the outside hound, and the inclined arbor has its upper end in a shift, J, and the lower end in a shiftable brace, K, which the pinion F can be thrown into. The master bevel-wheel, E, when moved, moves the machine without reaping. The shift, J, moves the machine from the crank extends horizontally, and carries a lever, L, which turns on a fulcrum in the inside hound, and thence runs back with the end of the sickle, M, by means of a ring-rod, N. By this arrangement the machine is placed forward of the driving-wheel, and is elevated from thence to the sickle, driving-wheel, by the vibrating action of the driving and supporting wheel back far enough to balance the weight of the machine. A seat or raker is placed on a seat finger-piece. This seat is attached

Statement of the case.

rises from the outside hound, and to the oblique brace, *h*, and is braced also by the diagonal wheel-brace *N'*, which runs down from the post to the finger-bar *M*, near to its junction with the inside hound. From this position, as represented in fig. 1 of the drawings, the raker can get at the grain back of the wheel, and by a natural sweep of his arms deliver it on to the ground at right angles to the swath, as shown in the figure. To give free scope to the arms of the raker, the reel, *W*, is made shorter than usual at that end, instead of overlapping or extending beyond the range of fingers, and to prevent the grain or straw from passing under the frame or into the gearing which operates the sickle there is what I denominate a "wheel-board," *w*—that is, a curved board the forward end of which is secured to the inside hound. The forward end is curved to force the grain inward toward the reel, and then it runs back to the platform, *Q*, parallel with the plane of motion of the end of the reel. At the other end of the finger-bar there is a separator, *T*, or long finger, which projects beyond the points of the fingers, *P*, to separate the grain that is to be cut, and to the point and top of this is attached a metal guide or support, *U*, which extends back of the sickle to support the grain while being cut. The outer edge of the separator runs out in a curved line to force out the grain that is not to be cut and effect a perfect separation of it from the cut grain. At this end of the platform there is a board, *S*, to prevent the cut grain from dropping out on that side, and at the back there is a cloth screen to prevent its dropping out at the rear. The reel, *W*, has its bearings at the outer end in the end of a horizontal beam, *V*, which is attached to the frame that supports the back screen, and further supported by braces, so as to avoid the use of a standard at that end, as heretofore, against which the grain strikes before it is separated, and the inner end of the reel has its bearing in a sliding box in a standard, *I*, attached to the outside hound and the diagonal brace, *h*, the sliding box having a tapped stem running up above the standard, with a screw-nut, *X*, by means of which may, with convenience, be tightened the belt that runs from the driving-

Statement of the case.

pulley, x' (on the axle of the driving-wheel), over the pulley, Y, on the axle of the reel.

What I claim as my invention, and desire to secure by Letters Patent as improvements on the reaping-machines secured to me by Letters Patent bearing date the 21st of June, 1834, and the 31st of January, 1845, is—

1. Placing the gearing and crank forward of the driving-wheel for protection from dirt, &c., and thus carrying the driving-wheel farther back than heretofore, and sufficiently so to balance the rear part of the frame and the raker thereon, when this position of the parts is combined with the sickle, back of the axis of motion of the driving-wheel, by means of the vibrating lever, substantially as herein described.

2. The arrangement of the seat of the raker over the end of the finger-piece, which projects beyond the range of fingers and just back of the driving-wheel, as described, in combination with and placed at the end of the reel, whereby the raker can sit with his back toward the team, and thus have free access to the cut grain laid on the platform and back of the reel, and rake it from thence on to the ground by a natural sweep of his body, and lay it in a range at right angles with the swath, as described, thereby avoiding unevenness and scattering in the discharge of the wheat, as well as accomplishing the same with a great saving of labor.

C. H. McCORMICK.

Witnesses:

A. P. BROWNE,
J. W. THAYER.

UNITED STATES PATENT OFFICE. CYRUS H. McCORMICK, OF CHICAGO, ILLINOIS. IMPROVEMENT IN REAPING-MACHINES, SPECIFICATION FORMING PART OF LETTERS PATENT No. 5,335, DATED OCTOBER 23, 1847; REISSUE No. 239. DATED MAY 24, 1853.

To all whom it may concern:

Be it known that I, CYRUS H. McCORMICK, of Chicago, Illinois, have invented new and useful improvements in the

Statement of the case.

reaping-machine formerly patented by me ; and I do hereby declare that the following is a full, clear, and exact description thereof, reference being had to the accompanying drawings, making part of this specification, in which—

Figure 1 is a perspective view ; fig. 2, a plan, and fig. 3 a side elevation.

The same letters indicate like parts in all the figures.

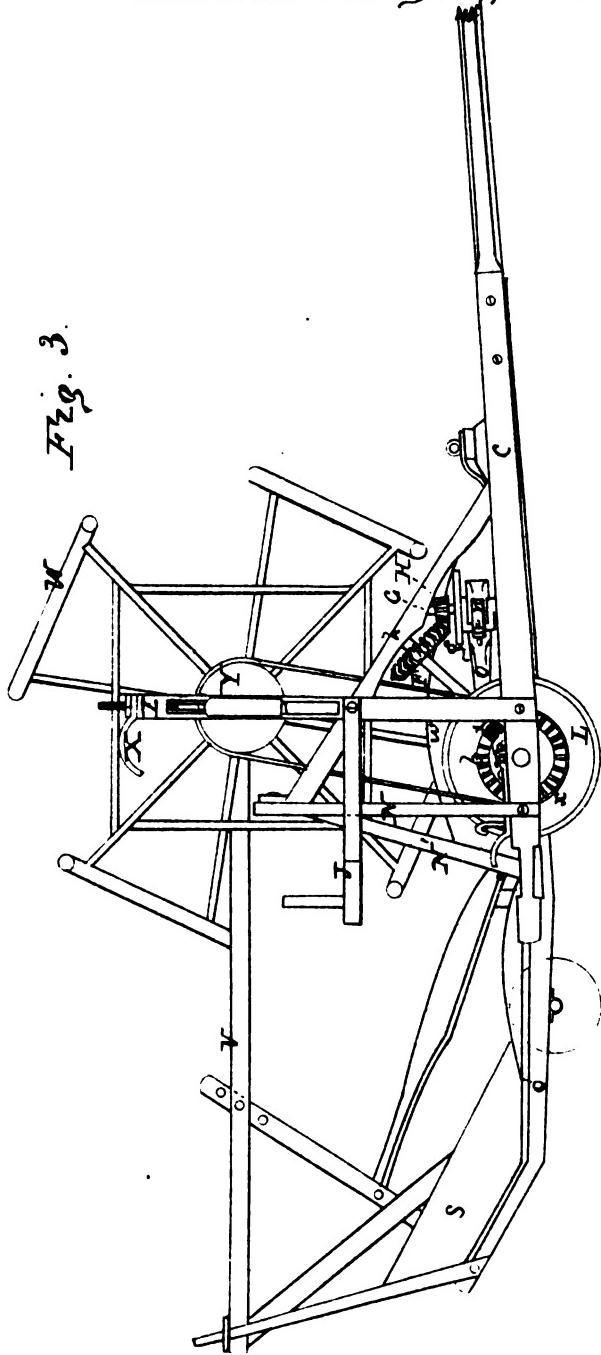
The reaping-machines heretofore made may be divided into two classes, the first class having a seat for a raker, who, with a hand-rake having a head equal in length to the width of the swath cut, performs the double office of gathering the grain to the cutting apparatus and on to the platform and then of discharging it from the platform on the ground behind the machine. This was defective, for the reason that the labor to the operator was very great, as he had to reach over to enter the head of the rake in the uncut grain to gather it to the cutting apparatus and then to push it off at the back of the machine, but principally because the grain was discharged behind in the wake of the machine, rendering it necessary to gather and remove the grain before the return of the machine to prevent it from being trodden down by the horses. The defects of this first class were remedied by the second class, in which a reel was employed to gather the grain to the cutting apparatus and deposit it on to a platform, from whence it is raked off by an attendant, who deposits the grain on the ground by the side of the machine, where it can lay as long as desired, the whole width of the swath being left unencumbered for the passage of the horses on the return of the machine to cut another swath ; but this latter class was still defective, for the reason that the reel, which performs in part the office of the raker in the other class, and in the performance of which office necessarily occupies the place which he occupied, left no place on the machine for the raker, so that it became necessary for the raker to walk on the ground by the side of the machine to perform the remaining duty of raking off the grain from the platform, which was attended with much labor and inconvenience—labor, because he must walk to keep up with the machine while he is operat-

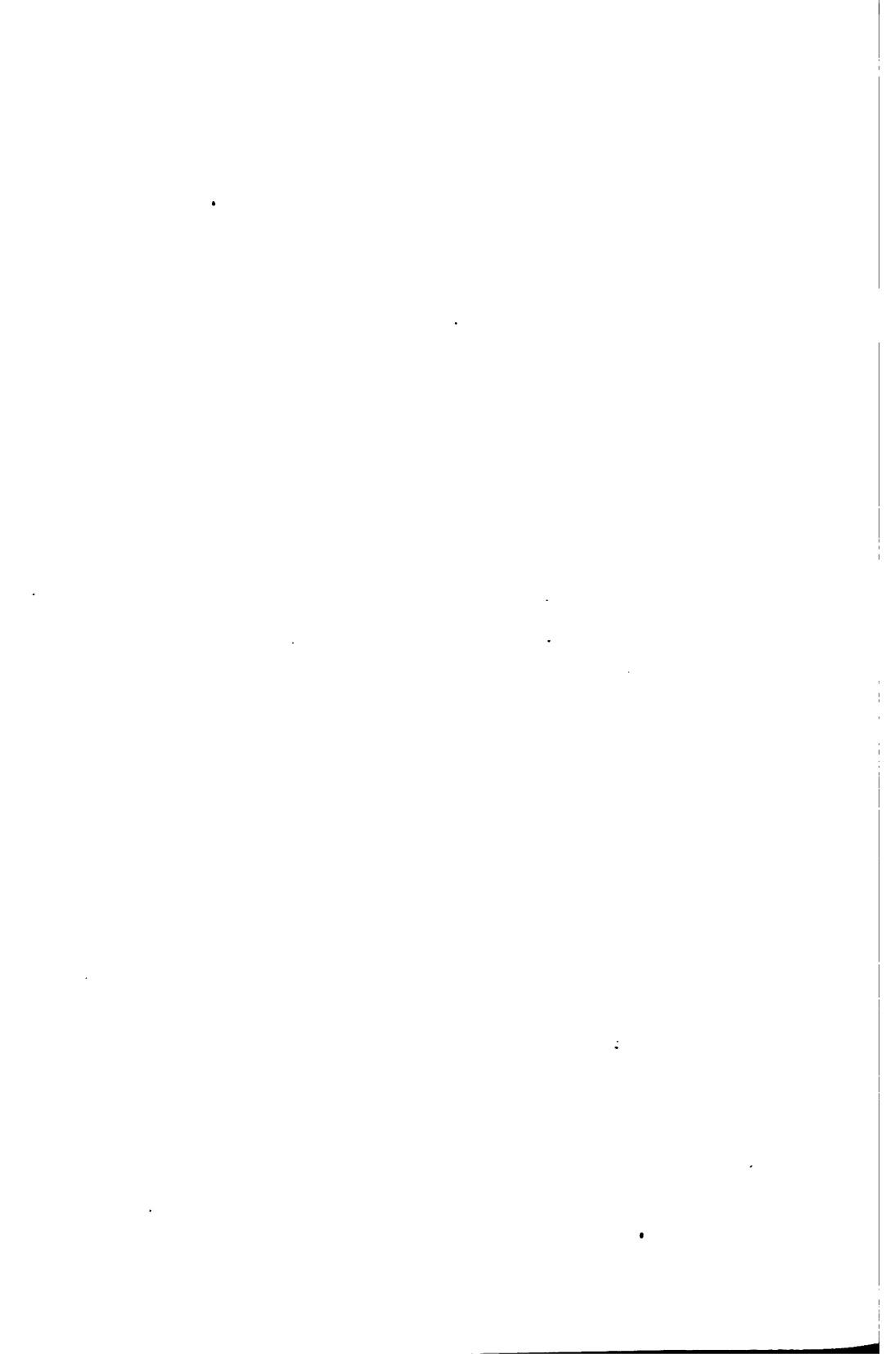
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C. H. McCormick.
Mower.

No
No 239

Patented Oct 28, 1847.
Reissued May 24, 1853





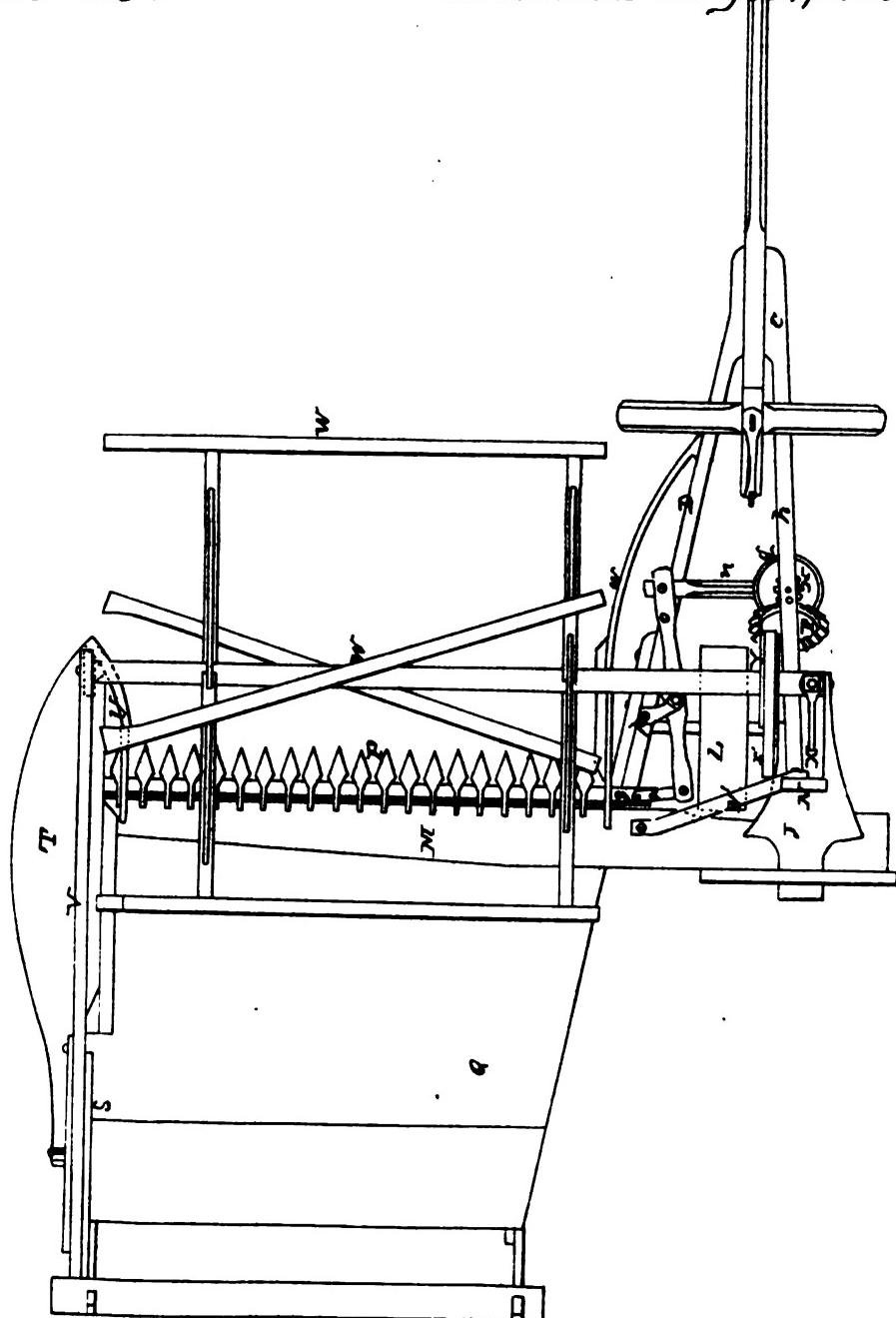
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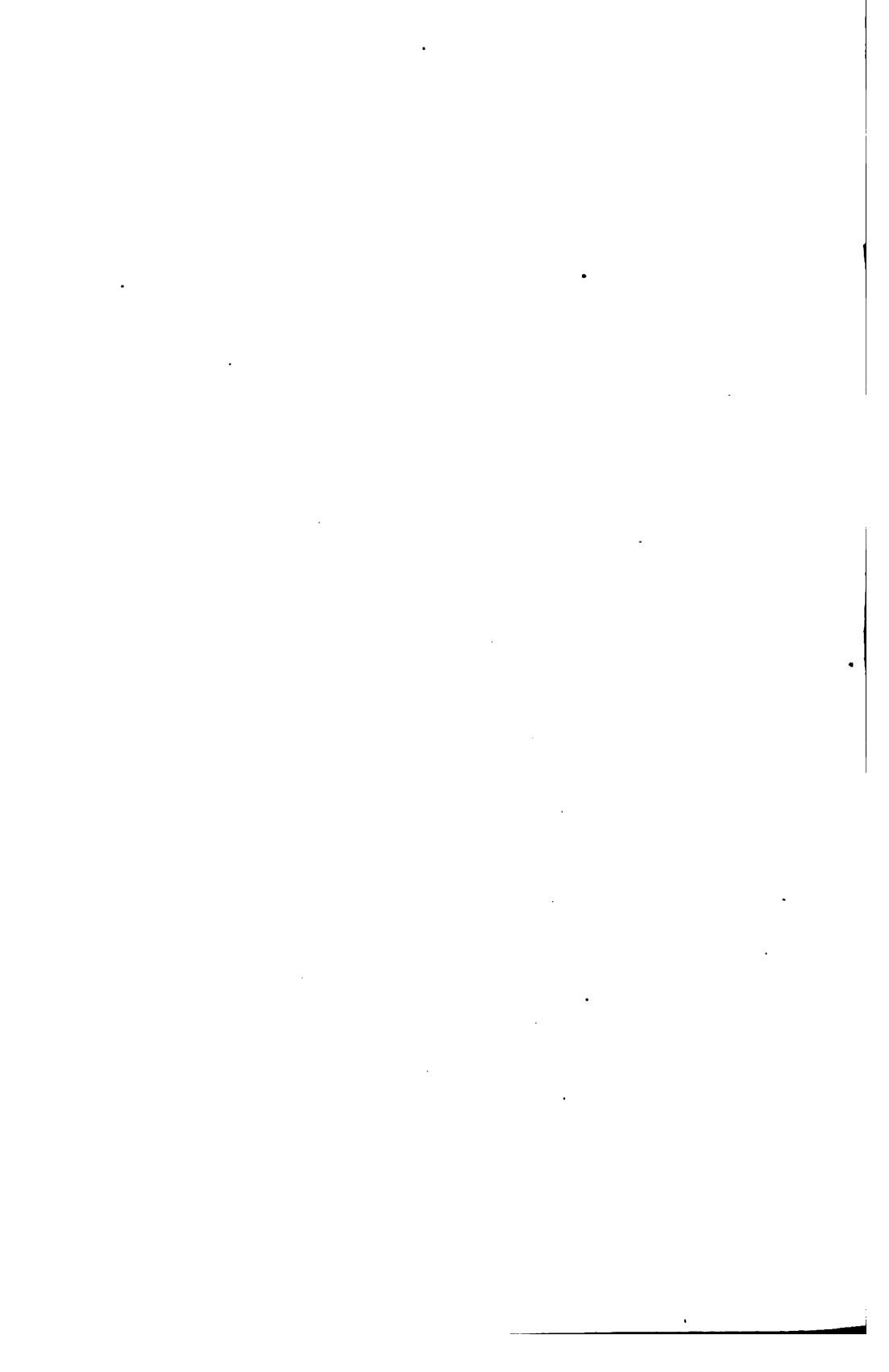
C. H. McCormick.

Mower.

No
No 239

Patented Oct. 23, 1847.
Reissued May 24, 1853.





Statement of the case.

ing the rake with his arms; and inconvenience, because, to enable him to get hold of the grain on the platform as the reel is revolving, he must stand in the very place where the grain should be deposited to be properly laid. This second class was defective in the following particulars: The driving-wheel is placed forward of the mechanism that operates the vibrating sickle, and so far forward as to leave too much of the weight of the machine back of the driving-wheel, and therefore tending to strain the horses, as well as the frame of the machine, and the gearing which communicates motion to the crank is placed back of the driving-wheel, which is therefore subject to be clogged by sand, dirt, straw, &c., and in consequence of the relative position of the various parts, the attendant is obliged to walk on the ground by the side of the machine to rake the cut grain from the platform as it is delivered and laid thereon by the reel. These defects, which have so much retarded the introduction into practical and general use of reaping machines, I have remedied by my improvements, which consist in placing the driving-wheel further back than heretofore and back of the gearing which communicates motion to the sickle, which is placed in a line back of the axis of the driving-wheel, the connection being formed by means of a lever and connecting-rod, thus placing the cog-gearing which operates the crank forward of the driving-wheel, for the purposes described, and bringing the driving-wheel sufficiently far back to balance the frame of the machine with the raker on it; and, also, in combining with the reel which deposits the grain on to the platform, a seat or position for the raker to sit or stand, and to give due support to the lower part of his body, that the upper part may be free to enable him to operate the rake with his arms, that he may have convenient access to the grain as the reel throws it down on the platform, and rake it off quickly with a free and natural sweep of his arms and deposit and lay it properly on the ground by the side of the machine in suitable quantities for being bound into sheaves.

In the accompanying drawings, M represents a flat beam, called the "finger-piece," to a part of the forward edge of

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which are secured the fingers, P, such as are used in the machine heretofore patented by me, and under these fingers is arranged the vibrating sickle, which receives its vibrating motion in manner to be hereinafter described. The finger-piece is firmly attached at one end to the two oblique hounds, C and D, which run toward each other and are bolted to the tongue, A, the forward end of which passes through the breast piece, B. The team is harnessed to the tongue, hounds, and breast-piece in the usual or any desired manner. The axle of the driving-wheel, L, has its bearings in the two hounds, so near the back end thereof as just to leave room for the wheel to run clear of the finger-piece, and to the outer end of the axle of the driving-wheel is attached a beveled master cog-wheel, l, which communicates motion to a bevel-pinion, l', on the lower end of an inclined arbor, to the upper end of which there is another beveled wheel, F, which communicates motion to the driver-pinion, H, on a vertical crank-arbor, G, that has a fly-wheel, g, on it between the crank and pinion. The crank-arbor has its bearings in the outside hound and the oblique brace, h, and the inclined arbor has its upper bearing in the oblique brace and its lower end in a shifting-lever, m, by means of which the pinion, l', can be thrown in and out of gear with the master bevel-wheel, l, when it is desired to reap or move the machine without reaping. A connecting-rod, n, from the crank extends horizontally to the forward end of the lever, o, which turns on a fulcrum-pin, p, attached to the inside hound, and thence runs back to form a connection with the end of the sickle, q, by means of a short connecting-rod, r. By this arrangement of parts the gearing is placed forward of the driving-wheel, and motion is communicated from thence to the sickle back of the axis of the driving-wheel by the vibrating lever, thus placing the driving and supporting wheel back of the gearing and far enough to balance the weight of the frame, and the attendant or raker is placed on a seat, J, over one end of the finger-piece. This seat is straddled by the raker, so that he can either sit on it or stand with his feet on the frame, and with the seat between his legs to steady him laterally.

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The seat, J, is attached to the from the outside hound, and to the braced also by the diagonal wire down from the post to the finger with the inside hound. On the bar or plate, against which the r which will thus give him ample ward to get at the grain without his body. From this position, a the drawings, the raker can get reel, and by a natural sweep of ground at right angles to the swa To give free scope to the arms of made shorter than usual at that end or extending beyond the range of the grain or straw from passing under the gearing which operates the sickle. Note a "wheel-board," w—that is, the forward end of which is secured to the forward end is curved to force the grain and then it runs back to the platform plane of motion of the end of the finger-bar there is a separator which projects beyond the points to separate the grain that is to be cut, of this is attached a metal guide which tends back to the sickle to support the cut. The outer edge of the separator line to force out the grain that is perfect separation of it from the straw. On the platform there is a board, s, to prevent dropping out on that side, & a cloth screen to prevent its dropping.

The reel, W, has its bearings a part of a horizontal beam, V, which that supports the back screen, a brace, so as to avoid the use of heretofore, against which the reel separated; and the inner end of

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a sliding box in a standard, I, attached to the outside hound and the diagonal brace, h , the sliding box having a tapped stem running up above the standard, with a screw-nut, X, by means of which may with convenience be tightened the belt that runs from the driving-pulley, x' (on the axle of the driving-wheel), over the pulley, y , on the axle of the reel.

What I claim as my invention, and desire to secure by Letters Patent, as improvements on the reaping-machine secured to me by Letters Patent bearing date the 21st of June, 1834, and the 31st of January, 1845, is—

1. Placing the gearing and crank forward of the driving-wheel for protection from dirt, etc., and thus carrying the driving-wheel farther back than heretofore, and sufficiently so as to balance the rear part of the frame and the raker thereon when this position of the parts is combined with the sickle back of the axis of motion of the driving-wheel by means of the vibrating lever, substantially as herein described.

2. The combination of the reel for gathering the grain to the cutting apparatus and depositing it on the platform with the seat or position for the raker arranged and located as described, or the equivalent thereof, to enable the raker to rake the grain from the platform, and deliver and lay it on the ground at the side of the machine, as described.

C. H. McCORMICK.

Witnesses:

Wm. H. BISHOP,
HIRAM CARPENTER.

(A further statement of the case appears in the opinion of the court.)

Messrs. Reverdy Johnson and E. N. Dickerson, for appellant.

Messrs. Edwin M. Stanton and George Harding, for defendants.

The elaborate arguments of counsel in this case being

almost entirely devoted to the facts here given.

Mr. Justice GRIER delivered the opinion.

The bill charges the defendant with infringing several patents granted to him in the machine known as "McCormick's reaper." The first of these patents bears date the 3d of April, 1845, and the other on the 24th of May, 1853. The second previous one, dated 23d of October, 1845, is directed to the arrangement of the machine so as to separate the grain from the chaff, and the third, dated 2d of April, 1853, is directed to the arrangement of the machine so as to separate the grain from the stalks. The bill further charges that the defendant has infringed the patent of 1845, and the second patent of 1853.

I. The first infringement charge is that the defendant has infringed the arrangement or apparatus for separating the grain from the stalks, or that part of the reaping machine which is to be left standing.

The claim is as follows: "4th. A platform, R, having a bow, L, and the dividing-iron, M, for separating the wheat in the way described."

The description referred to is as follows:

The divider, K, is an extension of the platform, say three feet long, and so constructed, as to serve the purpose, and so constructed, as to be able to cut the wheat to be cut from that to be separated whether tangled or not. E is a piece of wood, say two inches square, and two feet long, and three inches wide, which is fastened to the side of the platform, say three feet from the front end of the platform by two screw bolts, one at each end. F is a piece of tough wood, the other end of which is made fast to the side of the platform at R, about two and a half feet high at the front end, and about nine inches out from it, with a sharp edge. The dividing-iron, M, is an iron rod or bar, which is made fast to the point of the same piece of wood, E, by a screw bolt that holds the bow, L. The iron rod, M, rises towards the reel, S, at an angle, and when it reaches it, then it is bent so as to fit the back of the blade, and to fit the reel, S.

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From the bolt in the point aforesaid, the other end of this iron extends, say nine inches, along the inside of the piece, E, where it is held by another screw bolt, M, and where it has a groove (or slot) in it to admit the other ends being raised or lowered (turning on the point screw, K, as a pivot) to suit the height of the reel. By means of the bow to bear off the standing wheat, and the iron to throw the wheat to be cut within the powers of the reel, the required separation is made complete."

The answer denies that the arrangement of the divider used by the defendants for separating the grain to be cut from that to be left standing, is the same in construction or mode of operation as that claimed by complainant, or a colorable evasion of said claim, and avers that it is a different and distinct arrangement, invented by J. H. Manny, after several years' experiments.

It would be a difficult task to make intelligible to the uninitiated the construction of a very complex machine, without the aid of models or diagrams. But, for the purposes of the case, the divider, although a component part of the great complex machine called the "reaper," may be considered by itself as a machine, or combination of devices attached to the reaper to perform certain functions necessary to complete the whole operation. In order to ascertain whether the divider used by defendants infringes that of the complainant, we must first inquire whether McCormick was the first to invent the machine called a divider, performing the functions required, or has merely improved a known machine by some peculiar combination of mechanical devices which perform the same functions in a better manner.

If he be the original inventor of the device or machine called the "divider," he will have a right to treat as infringers all who make dividers operating on the same principle, and performing the same functions by analogous means or equivalent combinations, even though the infringing machine may be an improvement of the original, and patentable as such. But if the invention claimed be itself but an improvement on a known machine by a mere change of form or combination of parts, the patentee cannot treat

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another as an infringer who has improved the original machine by the use of a different form or combination performing the same functions. The inventor of the first improvement cannot invoke the doctrine of equivalents to suppress all other improvements which are not mere colorable invasions of the first.

That portion of a reaping-machine called the divider or separator may be described as a pointed, wedge-formed instrument, which is attached by its butt at that extremity of the cutting apparatus which runs in the grain, in such a manner that its point projects in advance of the cutting apparatus, and enters the standing grain. Its functions, where the grain stands erect, are to divide it into two portions, one of which is borne inwards by the inner side of the wedge-formed implement within the range of the cutting apparatus and of the reel, in case the machine is fitted with a reel; the other portion of the grain is borne outwards by the outer side of the divider, so as to be passed by that portion of the machine which lies behind the cutting apparatus. When grain is inclined outwards, the function of the divider is not only merely to divide the grain into portions, but also to raise up the inclined stalks of the grain, below which the divider passes. When the grain inclines inwards, the function of the divider is not only to divide the mass, but also tends to raise up the inclined stalks of grain beneath which the divider passes, and to bear them outwards without the range of the reel, if the machine has a reel, and of the cutting apparatus. When grain, in addition to being inclined, is also entangled, the divider not only separates and raises the stalks, but also tends to disentangle them. The lower face of a divider also performs the functions of a shoe or runner, to prevent the cutting apparatus from digging into the earth, when, by an accidental movement of the machine, it would otherwise do so. The divider also performs the function of limiting or regulating the width of the swath, by raising up and turning inwards those stalks of grain which, from their inclination outwards, would otherwise escape the action of the cutter; and by raising up and turning outwards those

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stalks of grain which, from their inclination inwards, would otherwise be within the range of the cutter. All dividers perform these functions in a greater or less degree. The English patent of Dobbs, in 1814, had dividers of wood or metal. The outer diverging rod rose as it extended back, and diverged laterally from the point, to raise the stalks of grain inclining inwards, and to turn them off from the other parts of the machine. The patent of Charles Phillips of 1841 had a divider shaped like a wedge, performing the same function, turning the grain aside on both sides of the machine, and raising it up. Ambler's machine had a triangular divider performing the same functions, as also the machines of Hussey, Schnebley, and that of McCormick, patented in 1834, which is now public property. The present claim is for the combination of this bow with a dividing iron of a certain form, and for nothing more. This dividing iron is but a new form or substitute for that side of the triangle or wedge which in other machines performed the function of separating the inside grain, and raising it to the cutters.

It is described in the patent as having these peculiarities to distinguish it from those that preceded it:

1. It rises at an angle of about thirty degrees till it reaches the reel.
2. It is curved under the reel.
3. It is made adjustable by means of a slot, so as to suit the different heights of the reel.

Its function is to raise and support the grain along the inner edge of the divider, at the maximum elevation consistent with the employment of the reel. As a form or combination of devices it is new, and no doubt an improvement, and therefore the proper subject of a patent. But as a claim for a combination of mechanical devices or parts, it is not infringed by one who uses a part of the combination. Nor can it challenge other improvements of the same machine, different in form or combination, as infringements, because they perform the same functions as well or better by calling them equivalents. The machine constructed under defendant's patent has a wooden projection, some-

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what in the form of a wedge, sickles some three feet, and ~~w~~ rises as it approaches the cu curve (not approaching to a as to raise the leaning grain. substitute or equivalent, poss of that instrument. It more before McCormick's patent of on former machines, it has so construction, but it does not ad plainant's patent. It is a dis inferior to McCormick's, but his claim.

II. The fifth claim of con which the bill charges the def follows:

"5. I claim setting the low behind the blade, curving it at top, thereby favoring the c brace it at top by the front br claim in combination with the

In the reaping machine of 1 of 1834, he had placed the reel This position of the post inter reel in drawing the grain to th ering tangled grain. In order own machine, he set the post f described.

Defendant does not support by McCormick. He uses the nected by a frame with the This device for supporting the many years before McCormic had no reel post situated as in none of the evils remedied by This attempt to treat the earlie defendant as an infringement o difficulty unknown to the fir doctrine of equivalents which

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III. The bill charges defendants with infringing the second claim of the reissued patent of 1853. This claim is as follows:

"2. And I also claim the combination of the reel for gathering the grain to the cutting apparatus, and depositing it on the platform, with the seat or position for the raker *arranged and located as described*, or the equivalent thereof to enable the raker to rake the grain from the platform, and deliver and lay it on the ground at the side of the machine, as described."

If this claim be construed to include all machines which have a reel and a raker's seat, it is void for want of novelty.

Hite, Woodward, Randall, and Schnebly had invented and publicly used reaping machines which had reels and a place for the raker on the machine. But the true construction of this claim, and the only one which will support its validity, is to treat it as a claim for a combination of the reel with a seat "arranged and located as described." And such was the construction given to it by the defendant himself, when the Commissioner had refused to grant him a patent claiming the mere combination of a reel and a raker's seat, "because such a combination was not patentable, the functions of each device having no necessary connection with the other."

This arrangement for the location of a raker's seat was made "by placing the gearing and crank forward of the driving wheel, and thus carrying the driving wheel further back than heretofore, and sufficiently so to balance the rear part of the frame and the raker thereon."

By this device he obtained a place for the raker over the finger bar, just back of the driving wheel, and at the end of the reel, where he could have free access to the grain, and rake it off the machine at right angles to the swath. It was by limiting his claim to this arrangement, location, and combination, that the complainant obtained his patent; and without this construction of it, the claim is neither patentable nor original.

The arrangement, combination, and location of the raker's seat, by defendants, has been patented to Manny as an in-

Dec., 1857.] McCORMICK

Dissenting

dependent contrivance and dis-
for the raker is obtained by a
platform, different from any
from the complainant's device
form and combination. The
part of the machine, where he
the balance of the machine, or
no modification of the reel. I
tion or modification of parts of
a place for the raker, which i
plainant's claim.

It is substantially different,
nation, from that claimed by the
quently no infringement of his

*Concurring, as we do, in the
court below on these several po
with costs.*

Mr. Justice DANIEL, dissenting

In the opinion of this court ju-
Protracted as the discussion by c
the real grounds for controver-
obvious, and comprised within
The unusual display of mechani-
ment upon its progress exhibi-
cause, whilst they evince great
afford entertainment to the curi-
a great degree irrelevant to an
inquiry which an adjustment of
either imposes or warrants. I
below, as well as in the argume-
conceded that the patent of the
This *concession* necessarily excl-
tion *concludes*, all inquiry as to
to the full benefit of his inventi-
a combination, and renders unn-
improper, any and every compar-
and previous claims to discovery.

Dissenting opinion.

in view the same results, and the same or merely equivalent modes of producing them. This *concession*, therefore, narrows down and confines the proper investigation before this court, as it should have restricted that before the Circuit Court, to the single question, whether the machine complained of as an infringement, either in theory, in construction, or in operation, was the same with the improvement invented by the appellant, for the benefit or the reward for which the law had given its guarantee. This was the proper inquiry before the court below, is the only regular inquiry here. All others connected with previous inventions were and must be irregular, and are excluded and forbidden by the concession that the patent of the appellant is legal and valid. To guide them in this, the only legitimate inquiry, this court has had before them a species of evidence of all others best calculated to conduct them to the truth—evidence superior to, and unaffected by, the interests or prejudices of partisans, or by the opinions (the reveries, they may often be called) of a class of men styled experts; men as often skillful and effective in producing obscurity and error, as in the elucidation of truth. No witnesses can testify so clearly and so impartially as do the subjects (though mute) concerning which a controversy about identity or dissimilarity is pending. These witnesses have been produced, and their testimony eagerly and keenly scrutinized; and that testimony establishes, in my judgment, with a force and certainty which no ingenuity can either withstand or evade, that the machine put in operation by the appellees is a palpable infringement of the rights of the appellants; that in theory or principle, in structure, in the modes of operation, and in the results proposed, it is essentially, and with some insignificant and merely apparent diversity, formally *identical*, at least in one important particular, with the invention secured by the government to the appellant, and admitted by the appellees, and by the court, to have been rightfully and legally guaranteed to him.

That portion of the machines put in operation by each of the parties to this controversy, and which constitutes the

Dec., 1857.] McCORMICK

Dissenting

most material subject of contro-
of what in the description and
patents is called a "divider."
of this divider are experience
wheat desired to be immediately
those which do not come within
operation, but which it is de-
future or succeeding action of
happens in fields of luxuriant
winds, heavy rains, and even fire
pressed down, and becomes in this
this condition, the stalks and
sides of a line described by them
become entangled, and incline
directions, accordingly as the
the natural position of the growth.
In such a condition of the whole
portion of the crop should be to
which it was intertwined, would
inasmuch as it would necessarily
in the position of the wheat no
of the regular track of the machine,
rapidly rending apart the tangle
waste the grain in each division
diminution in the yield or pro-
these mischiefs by disentangling
that designed to be immediately
for the succeeding action of the
the former and bringing it with
of the reel and the cutters, w
appendage to the reaper, called
importance of this appendage, be-
reaper and on account of its rea-
be with reason called in question
is sufficiently evinced by the ze-
and the extraordinary expense
incurred in this controversy.
may be thus substantially described
or structure, called by the paten-

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strong hard wood, confined in front, and projecting so far in advance of the cutters as to enter the wheat in time to effect its preparation for the approach of the cutters. This bow is extended in a curvilinear form on the outer side of the machine, next the grain to be separated from the cutters, and is gradually elevated from the point in front to a degree increasing towards the rear of the machine, sufficient to disentangle the straw, and place it in a position proper for the sweep or action of the returning machine. On the interior side of the machine, or that on which the grain is to be severed, the divider of McCormick is constructed of a bar of iron, confined at the same point with the wooden bow above mentioned as operating externally; and this iron bar is capable of being so adjusted as to disentangle and raise the wheat separated from that standing on the exterior of the machine; and by a lateral and angular direction given this adjustable bar, as well as by its vertical extension, it embraces and secures the wheat on the interior side of the machine, and presses it to the action of the reel and the cutters.

Such as has been just described, I hold to be McCormick's divider, and such, too, its operation and effects. Let us now compare them with the structure and operation of the structure complained of as an infringement, in order to ascertain how far the rival claims of the parties are identical or diverse. And this comparison will be most fairly and satisfactorily accomplished, and the results most clearly established, by a recurrence to that silent, but irresistible testimony already referred to, the testimony of the machines themselves.

On Manny's machine, the divider on the exterior side, or the side of the standing grain, is formed of a piece of timber which, according as fancy shall dictate, may be denominated a bow, or by any other appellation which may be preferred. This piece of timber, like the divider of McCormick's machine, is confined in front, and penetrates the standing grain in advance of the cutters. Like McCormick's divider, it rises obliquely from the stationary point in front, towards the rear of the machine, to a degree

Dissenting opinion.

intended to be sufficient to separate and support the straw, and in the same manner diverges in an angle supposed to be great enough to secure that separation, and to prevent the breaking down of any portion of the straw by being pressed to the earth, or by being torn away by the machine in its progress. On the interior side or section of Mann's divider, there is no adjustable iron bar or rod, as the part of the divider; but for this is substituted a piece of timber or a board, connected and confined in the front of the machine with the wooden fixture extended on the outside next the standing grain; and from that point of connection this substituted board is protracted in a diverging angle, and to a length corresponding exactly with those of McCormick's adjustable iron bar, and, like the latter, it is gradually carried to a vertical elevation intended to be great enough to separate and raise up the wheat designed to be immediately severed by the cutters from that reserved for farther action of the machine. The only differences between this fixture and the adjustable bar of McCormick (and they are merely pretended and deceptive) are these: that the former, instead of being of iron, is made of wood; that instead of being movable or adjustable, it is stationary; that it is broader on its lateral surface than is that of the iron portion of McCormick's divider, and on that lateral surface is somewhat curved. But these differences, correctly apprehended, are mere disguises, and were indispensable to shelter the possession of property evidently pirated from the rightful owner. Had the appellees openly taken McCormick's iron instrument, adjusted it so that it could be graduated in practice to the quality or height of the grain in which the machine was to operate, and placed it at an angle suited to the conducting of the grain within the action of the reel and cutters, there would, in so bold a piracy, have been left no ground, no pretext even for contest or cavil. Hence the effort at distinctions or differences attempted in this case. To my mind, it seems impossible not to perceive that they are entirely unfounded, and cannot for one instant conceal these truths, viz.: that the instrument or structure called a "divider," introduced and practiced by the appell-

Notes and Citations.

lees, is in theory or principle, in manner of its operation, in its effects or results, and it may almost be said in its minute constituent portions and formation, identical with the instrument invented by and patented to the appellant, and therefore an infringement of the rights guaranteed to him by the government.

Entertaining this opinion, I must dissent from the decision of the court in this cause, and declare it as my opinion that the decree of the Circuit Court should be reversed, and this cause remanded with instructions to reinstate the injunction formerly awarded by the Circuit Court, and to direct an account between the parties. The only legitimate inquiry for the court is this: Whether the improvement of McCormick called a "divider," and the instrument claimed and put in operation by Manny, are essentially the same, or are essentially or substantially different. All that has been said (and a great deal has been said) about the comparative superiority or inferiority of inventions or improvements previous to those patented to McCormick, is wholly irrelevant, and out of this cause; and is calculated only to confound and to divert the attention from the only proper subject of investigation here, which is the rightfulness of the claims advanced by the appellant and appellees in this cause, relatively to themselves and to no others.

Notes:

1. Mere improver cannot invoke doctrine of equivalents.

See *Burr v. Duryee*, 1 Wall. 581.

Particular improvement patent limited.

Bragg v. Fitch, 21 U. S. 478.

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3. Combination not infringed by use of part only.

Prouty v. Ruggles, 16 Pet. 336 [4 Am. & Eng. 351].

Stimpson v. Railroad Co., 10 How. 329 [5 Am. & Eng. 129].

Silsby v. Foote, 20 How. 378 [p. 392 *ante*].

Notes and Citations.

- Eames *v.* Godfrey, 1 Wall. 78.
Case *v.* Brown, 2 Wall. 230.
Gould *v.* Rees, 15 Wall. 187.
Garratt *v.* Seibert, Bk. 21, L. ed. 956.
Dunbar *v.* Myers, 94 U. S. 187.
Schumaker *v.* Cornell, 96 U. S. 549.
Water Meter Co. *v.* Desper, 101 U. S. 332.
Wicke *v.* Ostrum, 103 U. S. 461.
Gage *v.* Herring, 107 U. S., 640.
Rowell *v.* Lindsay, 113 U. S. 97.
Blake *v.* City of San Francisco, 113 U. S. 679.
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Patents in suit:

- No. 3895 McCormick, C. H. January 31, 1845.
Harvester.
No. 5335 McCormick, C. H. October 23, 1847.
Harvester.
Re-issue No. 239. May 24, 1853.

OTHER SUITS ON SAME PATENT:

- McCormick *v.* Seymour, 1851. 2 Blatchf. 240.
Seymour *v.* McCormick, 1858. 16 How. 480; 1 Whit. 944 [p. 200 *ante*].
McCormick *v.* Seymour, 1854. 3 Blatchf. 209.
McCormick *v.* Manny, 1855. 6 McL. 539.
Seymour *v.* McCormick, 1856. 19 How. 96; 1 Whit. 1004 [p. 282 *ante*].
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Cited:**IN SUPREME COURT OF UNITED STATES:**

- Burr *v.* Duryee, 1864. 1 Wall. 531. Bk. 17, L. ed. 650.
Case *v.* Brown, 1865. 2 Wall. 320. Bk. 17, L. ed. 817.
Electric Signal Co. *v.* Hall Signal Co., 1885. 114 U. S. 87. Bk. 29, L. ed. 96.

Notes and Citations.

IN CIRCUIT COURTS:

- Singer *v.* Walmsley, February, 1860. 1 Fish. 558.
Burden *v.* Corning, October, 1864. 2 Fish. 477.
Forbes *v.* Barstow Stove Co., November, 1864. 2 Cliff. 379.
Hale *v.* Stimpson, October, 1865. 2 Fish. 565.
Crompton *v.* Belknap Mills, May, 1869. 3 Fish. 536.
Seymour *v.* Osborne, May, 1869. 3 Fish. 555.
Sayles *v.* Chicago & Northwestern Railroad Co., June, 1871. 3
Biss. 52; 4 Fish. 584.
Taylor *v.* Garretson, September, 1871. 9 Blatch. 156; 5 Fish. 116.
Meyers *v.* Duker, October, 1874. 1 Ban. & Ard. 535.
Flint *v.* Roberts, March, 1879. 4 Ban. & Ard. 165.
Steam Gauge & Lantern Co. *v.* Miller, September, 1884. 21 Fed.
Rep. 514.
Morley Sewing Machine Co. *v.* Lancaster, March, 1885. 23 Fed.
Rep. 344.
Hill *v.* Sawyer, June, 1887. 31 Fed. Rep. 282.

IN DECISIONS OF COMMISSIONER OF PATENTS:

- Demming, March, 1884. 26 O. G. 1207.
Paige, August, 1887. 40 O. G. 807.

IN STATE COURTS:

- Jackson *v.* Allen, March, 1876. 120 Mass. 64.

Notes and Citations.

IN TEXT-BOOKS:

- 2 Abb. Pat. Law. 1886, pp. 250, 251.
Merwin on Pat. Invt., 1883, p. 558.
Walker on Pats., 1883, pp. 130, 262.
Curtis on Pats., 4th ed., § 308, note.

*Syllabus.***ROSS WINANS, PLAINTIFF IN ERROR v. THE NEW YORK AND ERIE RAILROAD COMPANY.****21 How. 88-108. Dec., 1858.**

[Bk. 16, L. ed. 68; 1 Whit. 1096.]

Affirming *Ibid.*, 1 Fish. 213.*Exceptions to admission of testimony. Expert evidence. Particular patent construed.*

1. Where exception was taken to the refusal of the court to reject a deposition taken on interrogatories before a commissioner it was overruled, because by the rules of practice in the Circuit Court of New York such an objection cannot be made on trial of a cause, when the party had full time and opportunity to move for a suppression of the deposition or a re-examination of the witness (p. 453).
2. And because the copy of a former deposition referred to by witness, but not annexed to his deposition, was not in his power, but in that of the commissioner (p. 454).
3. Experts may be examined to explain terms of art, and the state of the art at any given time. They may explain to the court the machines, works, or drawings exhibited; they may point out the difference or identity of the mechanical devices involved in their construction, but they cannot be received to prove to the court or jury what is the proper or legal construction of any instrument in writing. Expert evidence construing the patent held properly excluded (p. 454).
4. Letters patent granted Winans, R., October 1, 1834, Eight-Wheeled Car construed to be for an improvement consisting in the manner of arranging and connecting the eight wheels (p. 456).

IN error to the Circuit Court of the United States for the Northern District of New York.

The suit below was an action at law brought by Winans against the company for the infringement of letters patent. The patent was granted said Winans on Oct. 1, 1834, for an "improvement in the construction of cars or carriages intended to run upon railroads."

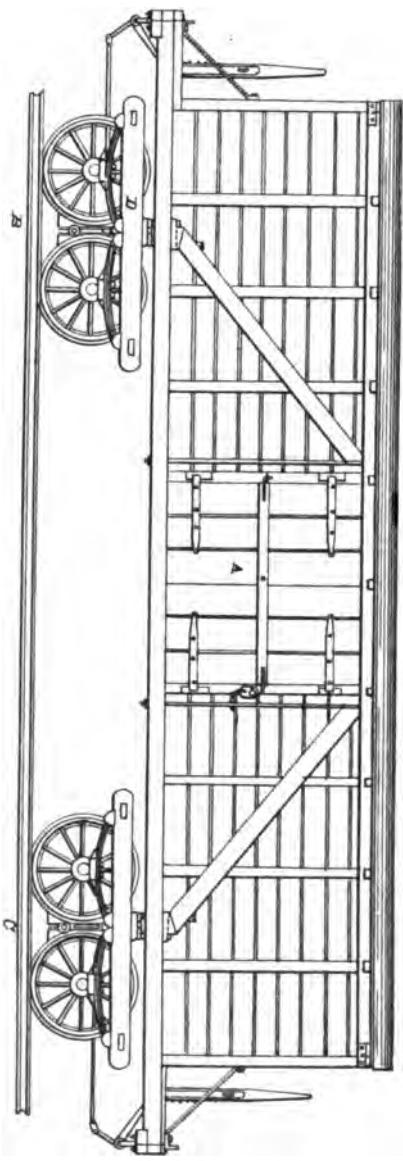


Fig. 1.

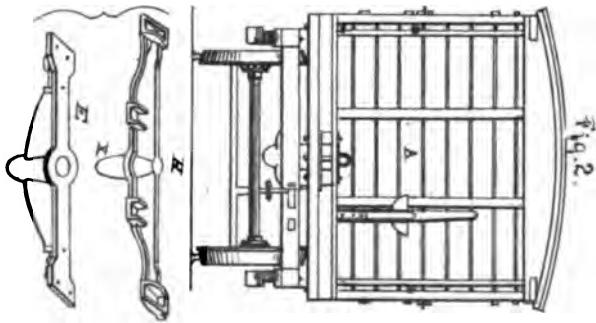
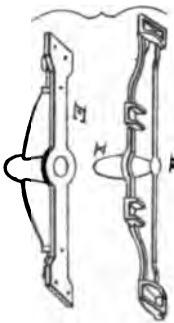
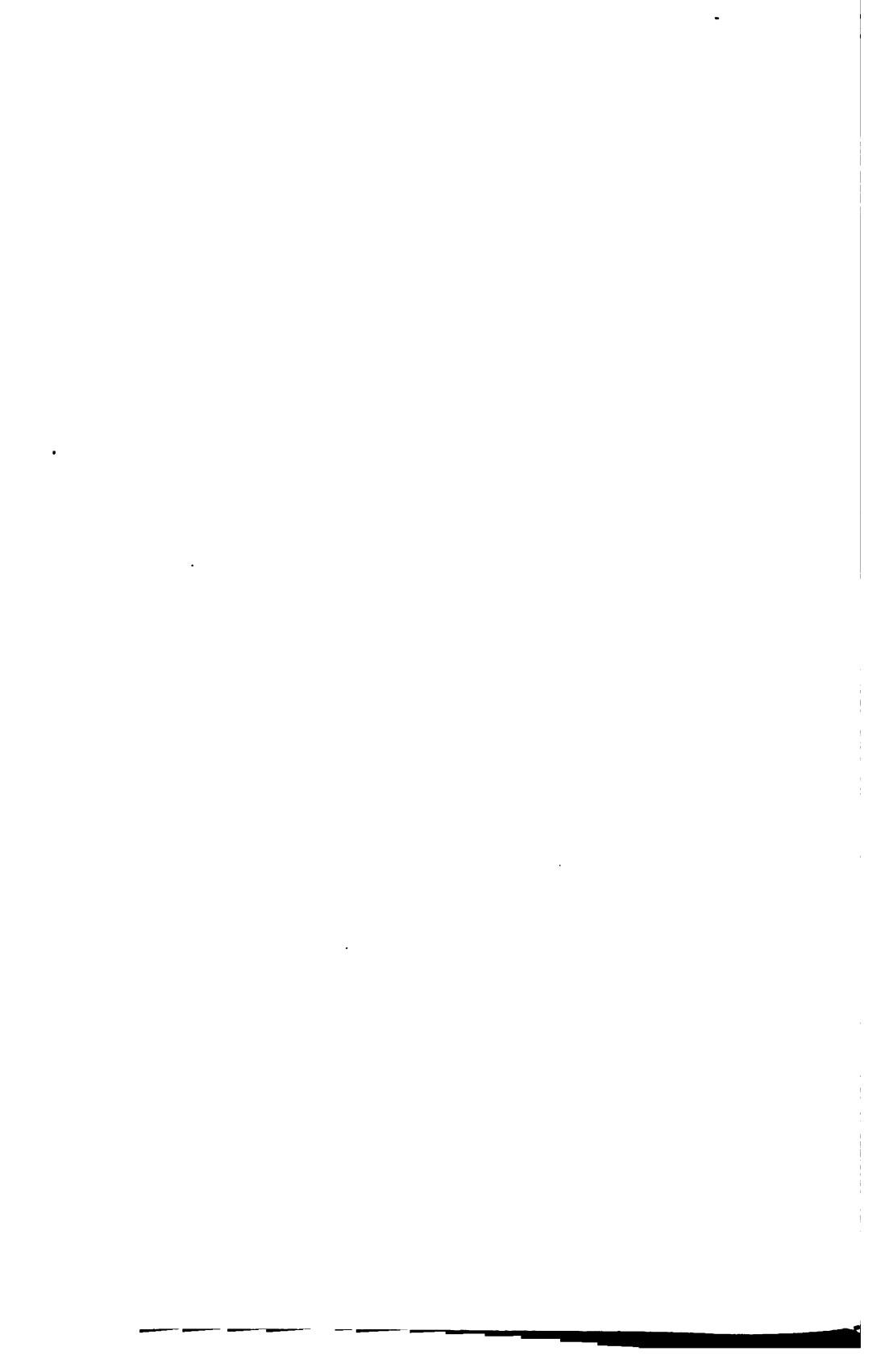


Fig. 2.

Fig. 3.





Statement of the case.

The defendants pleaded the general issue, and gave notice of special matters of defense.

Upon the trial there was a verdict for the defendants, and the plaintiff made a bill of exceptions.

The first exception arose as follows:

In the course of the trial, the defendants offered to read in evidence the deposition of one Conduce Gatch, taken under a commission. The deposition consisted of 106 direct interrogatories, and 103 cross interrogatories, and of the answers of the said Gatch thereto, and of three additional direct interrogatories, and the answers thereto.

The 100th cross interrogatory and the answer thereto, referred to a copy of answers of said Gatch in the case of *Winans v. The N. Y. and Harlem Railroad Co.*

This copy "was not, nor was any copy of such copy, annexed to such deposition, nor were there any answers by Gatch to any part of the 102d cross interrogatory, other than the said answer to the 100th cross interrogatory."

The plaintiff's attorneys objected to the reading in evidence of the whole of said deposition, on the ground that Gatch was called by said 102d cross interrogatory to annex to his said deposition a correct copy of the copy of the answers of said Gatch in the case of *Winans v. The N. Y. & Harlem Railroad Company*, and that Gatch had failed so to do. The Court, thereupon, overruled said objection.

The substance of the other numerous exceptions, with a further statement of the case, appears in the opinion of the court.

The following is the schedule referred to in the letters patent:

* "To all whom it may concern: Be it known that I, Ross Winans, civil engineer, of the City of Baltimore, in the State of Maryland, have invented a new and useful improvement in the construction of cars or carriages intended to travel upon railroads, which improvement is particularly adapted to passenger cars, as will more fully appear by an exposition of the difficulties heretofore experienced

* The annexed drawing is from the Supreme Court records, there being no drawing in the Patent Office.

Statement of the case.

in the running of such cars at high velocities, which exposition, I think, it best to give in this specification, for the purpose of exemplifying the more clearly the object of my said improvement.

"In the construction of all railroads in this country which extend to any considerable distance, it has been found necessary to admit of lateral curvatures, the radius of which is sometimes but a few hundred feet; and it becomes important, therefore, so to construct the cars as to enable them to overcome the difficulties presented by such curvatures, and to adapt them for running with the least friction practicable upon all parts of the road. The friction to which I now allude is that which arises from the contact between the flanches of the wheels and the rails, which, when it occurs, causes a great loss of power, and a rapid destruction of, or injury to, both the wheel and the rail, and is otherwise injurious. The high velocities attained by the improvements made in locomotive engines, and which are not only sanctioned, but demanded, by public opinion, render it necessary that certain points of construction and arrangement, both in the roads and wheels, which were not viewed as important at former rates of traveling, should now receive special attention. The greater momentum of the load, and the intensity of the shocks and concussions, which are unavoidable even under the best constructions, are among those circumstances which must not be neglected, as the liability to accident is thereby not only greatly increased, but the consequences to be apprehended much more serious. The passenger and other cars in general use upon railroads have four wheels, the axles of which are placed from three and a half to five feet apart; this distance being governed by the nature of the road upon which they run, and other considerations. When the cars are so constructed that the axles retain their parallelism, and are at a considerable distance apart, there is a necessary tendency in the flanches of the wheels to come into contact with the rails, especially on the curvatures of least radius, as the axles then vary more from the direction of the radii. From this consideration, when taken alone, it would appear

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the difference in length, the constant tendency to deviation being as constantly counteracted by this construction ; but at high velocities, the momentum of the body in motion tends so powerfully to carry it in a right line, as to cause the wheel on the longer rail to ascend considerably above that part of the cone which corresponds therewith. The consequence of this is a continued serpentine motion, principally, but not entirely, in a lateral direction; nor is this confined to the curved parts of the road, but it exists to an equal or greater extent upon those which are straight, especially when the axles are near to each other, the irregularities before spoken of constantly changing the direct course of the wheels, whilst there is no general curvature of the rails to counteract it. To avoid this effect, and the unpleasant motion and tendency to derangement consequent upon it, an additional motive is furnished for placing the axles at a considerable distance apart.

"The object of my invention is, among other things, to make such an adjustment or arrangement of the wheels and axles as shall cause the body of the car or carriage to pursue a more smooth, even, direct, and safe course than it does as cars are ordinarily constructed, both over the curved and straight parts of the road, by the before-mentioned desideratum of combining the advantages of the near and distant coupling of the axles and other means to be hereinafter described. For this purpose I construct two bearing carriages, each with four wheels, which are to sustain the body of the passenger or other car by placing one of them at or near each end of it, in a way to be presently described. The two wheels on either side of these carriages are to be placed very near to each other; the spaces between their flanches need be no greater than is necessary to prevent their contact with each other. These wheels I connect together by means of a very strong spring—say double the usual strength employed for ordinary cars—the ends of which spring are bolted, or otherwise secured, to the upper sides of the boxes, which rest on the journals of the axles, the longer leaves of the springs being placed downwards, and surmounted by the shorter leaves. Having thus connected

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two pairs of wheels together, I unite them into a four-wheel bearing carriage, by means of their axles, and a bolster of the proper length extending across, between the two pairs of wheels, from the center of one spring to that of the other, and securely fastened to the tops of them. This bolster must be of sufficient strength to bear a load upon its center of four or five tons. Upon this first bolster I place another of equal strength, and connect the two together by a center pin or bolt passing down through them, and thus allowing them to swivel or turn upon each other in the manner of the front bolster of a common road wagon. I prefer making these bolsters of wrought or cast iron ; wood, however, may be used. I prepare each of the bearing carriages in precisely the same way. The body of the passenger or other car I make of double the ordinary length of those which run on four wheels, and capable of carrying double their load. This body I place so as to rest its whole weight upon the two upper bolsters of the two before-mentioned bearing carriages or running gear. I sometimes place these bolsters so far within the ends of the body of the car as to bring all the wheels under it, and in this case less strength is necessary in the car body than when the bolster is situated at its extreme ends. In some cases, however, I place the bolster so far without the body of the car, at either end, as to allow the latter to hang down between the two sets of wheels or bearing carriages, and to run, if desired, within a foot of the rails.

" When this is done, a strong frame-work projects out from either end of the car or carriage body, and rests upon the upper bolsters of the two bearing carriages. This last arrangement, by which the body of the car is hung so low down, manifestly affords a great security to the passengers, exempting them in a great degree from those accidents to which they are liable when the load is raised. Several bodies may be connected, or rest on a common frame, and be supported on the bearing carriage, in a manner similar to that of a single body. When the bolsters of the bearing carriages are placed under the extreme ends of the body, the relief from shocks and concussions, and from lateral

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vibrations, is greater than it is when the bolsters are placed between the middle and the ends of the body, and this relief is not materially varied by increasing or diminishing the length of the body, while the extreme ends of it continue to rest on the bolsters of the bearing cars, the load supposed to be equally distributed over the entire length of the body.

"Although I prefer the use of a single spring to a pair of wheels as above described, instead of the ordinary spring to each wheel, and consider it as more simple, cheap, and convenient than any other arrangement, the end which I have in view may nevertheless be obtained by constructing the bearing carriages in any of the modes usually practiced, provided that the fore and hind wheels of each of them be placed very near together; because the closeness of the fore and hind wheels of each bearing carriage, taken in connection with the use of two bearing carriages coupled remotely from each other as can conveniently be done, for the support of one body, with a view to the objects and on the principles herein set forth, is considered by me as a most important feature of my invention; for, by the contiguity of the fore and hind wheels of each bearing carriage, while the two bearing carriages may be at any desirable distance apart, the lateral friction from the rubbing of the flanches against the rails is most effectually avoided, whilst at the same time all the advantages attendant upon placing the axles of a four-wheeled car far apart are thus obtained. The bearing of the load on the center of the bolster, which also is the center of each bearing carriage, likewise affords great relief from the shocks occasioned by the percussions of the wheels on protuberant parts of the rails or other objects, and from the vibrations consequent to the use of coned wheels; as the lateral and vertical movements of the body of the car resulting from the above causes are much diminished. The two wheels on either side of one of the bearing carriages may, from their proximity, be considered as acting like a single wheel, and as these two bearing carriages may be placed at any distance from each other, consistent with the required strength of the body of

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the car, it is evident that all the advantage is obtained which results from having the two axles of a four-wheeled car at a distance from each other, whilst its inconveniences are avoided. Another advantage of this car, compared with those in common use, and which is viewed by me as very important, is the increased safety afforded by it to passengers, not only from the diminished liability to breakage or derangement in the framework, but also from the less disastrous consequences to be apprehended from the breaking of a wheel, axle, or other part of the running gear, as the car body depends for its support and safety upon a greater number of wheels and bearing points on the road. I do not claim as my invention the running of cars or carriages upon eight wheels, this having been previously done; not, however, in the manner or for the purposes herein described, but merely with a view of distributing the weight, carried more evenly upon a rail or other road, and for objects distinct in character from those which I have had in view, as hereinbefore set forth. Nor have the wheels, when thus increased in number, been so arranged and connected with each other, either by design or accident, as to accomplish this purpose. What I claim, therefore, as my invention, and for which I ask a patent, is the before-described manner of arranging and connecting the eight wheels, which constitute the two bearing carriages, with a railroad car, so as to accomplish the end proposed by the means set forth, or by any others which are analogous and dependent upon the same principles.

“ROSS WINANS.”

Witnesses:

G. BROWN.

JNO. H. B. LATROBE.

Messrs. Charles M. Keller and Samuel Blatchford, for the plaintiffs in error:

As to the first exception, the rule of evidence which excludes depositions under such circumstances, is well settled by authority.

Richardson *v.* Golden, 3 Wash. C. C. 109; Dodge *v.*

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Israel, 4 Wash. C. C. 323; Kimball *v.* Davis, 19 Wend. 437; Brown *v.* Kimball, 25 Wend. 259, 265; Smith *v.* Griffith, 3 Hill 338.

As to the exceptions which relate to the offers to prove, made on the part of the plaintiff and overruled by the court below, these offers relate to expert testimony on the facts presented and proved by the plaintiffs' letters patent, which were in evidence as the foundation of the action; the said expert testimony being essential to enable the court to construe, as matter of law, the claim in the patent, and to enable the jury to ascertain, as matter of fact, the principle or mode of operation of the invention patented, and to determine the novelty thereof, as well as the infringement of the patent by the defendants. This testimony was admissible:

1st. As addressed to the court, with a view to the correct construction of the claim in the patent.

Winans *v.* Denmead, 15 How. 330, 340 [6 Am. & Eng. 107]; Curt. Pat., secs. 123, 395; Washburn *v.* Gould, 3 Story 122; Neilson *v.* Harford, Webst. Pat. Cas. 370; Silsby *v.* Foote, 14 How. 218, 226 [5 Am. & Eng. 411].

2d. Testimony was admissible as addressed to the jury as matter of fact. The claim is to be liberally construed, to give effect to the patent, and to secure the invention actually made and described, if the language of the specification would admit of it.

Winans *v.* Denmead, and cases cited, 15 How. 330, 311 [6 Am. & Eng. 107].

And it was susceptible of proof that the invention described in the plaintiff's patent was substantially different, and had a different mode of operation from a car of prior date. No construction of the claim of the patent can be sound in judgment of law, which includes in its scope both the patent and the prior car.

Messrs. J. C. Bancroft Davis and William White, for the defendants in error:

As to the first exception:

1st. The exception assumes that the paper was asked for

Argument o

by the 102d cross interrogatory the interrogatory itself shows t

2d. The objection was not to been properly raised only before trial.

Rules of the Circuit Court of New York: Rule 6, Conkling of the District Court for the York: Conkling's Treatise, Rule 83, 835; Rev. Stat. N. Y sec. 23, 4th ed., Vol. II., p. 64 Union Bank of N. Y., 19 Barb Bank of Sandusky *v.* Torrey, 5

The counsel have waived the Brown *v.* Kimball, 25 Wend The evidence asked for is not Smith *v.* Griffith, 3 Hill. 383 It was a copy of a copy and Burton *v.* Plummer, 2 A. & 437.

The witness having testified to all the facts contained in his answer to have it in court.

Morse *v.* Cloyes, 11 Barb. 10 cases already cited.

The evidence also shows that the witness' control.

Mr. Justice GRIER delivered the patent, which the defendant infringed, purports to be "for a improvement in the construction of cars to travel upon railroads."

The specification commences difficulties attending short curves and the consequent necessity of four only are used, near together, so that the shocks from obstructions or thus greatly increased; so that

Opinion of the court.

made between the evils consequent on too great a separation and too near approach, wherein the advantage of one is necessarily sacrificed for sake of the other. The incessant vibration felt in traveling on railroad cars is mainly imputed to the minute obstructions which unavoidably exist, and the approximation of the wheels necessary to avoid friction tends to increase the effect of this motion, and its power to derange the machinery of the road.

The important object which the plaintiff's invention seeks to obtain, as regards comfort, safety, and economy, "is to devise a mode of combining the advantages derived from placing the axles at a considerable distance, with those of allowing them to be situated near each other.

The specification then states the methods heretofore used to remedy these difficulties; such as making the track wheels conical, which, in case of slow traveling, has been found an effectual correction. But in high velocities it caused a serpentine motion, not only on curves, but where the track was straight. To avoid this effect, an additional motive is furnished for placing the axles at a considerable distance apart.

For this purpose the patentee proposes to construct two bearing carriages, each with four wheels, to sustain the body of the cars, one at or near each end thereof; the two wheels on either side of these carriages to be placed very near each other. These wheels may be connected by a strong spring, double the usual strength employed for ordinary cars. The use of this spring, though preferable, is not absolutely required, as the end in view may be obtained by constructing the bearing carriages in any of the modes usually practiced, provided the fore and hind wheels of each of the carriages be placed near together; because the closeness of the fore and hind wheels of each bearing carriage, coupled remotely from each other, is considered as the most important feature of the invention.

On each of these carriages a bolster is placed, on which the car body rests, connected with each by a center pin or bolt passing down through them, thus allowing them to swivel or turn upon each other.

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After this description of the improvement contemplated, and the objects to be gained by it (of which we have given a brief summary), the specification concludes with the following disclaimer and statement of what the patentee claims to have invented:

"I do not claim as my invention the running of cars or carriages upon eight wheels, this having been previously done; not, however, in the manner or for the purposes herein described, but merely with the view of distributing the weight carried more evenly upon a rail or other road, and for objects distinct in character from those which I have had in view, as hereinbefore set forth. Nor have the wheels, when thus increased in number, been so arranged and connected with each other, either by design or accident, as to accomplish this purpose. What I claim, therefore, as my invention, and for which I ask a patent, is the before-described manner of arranging and connecting the eight wheels, which constitute the two bearing carriages, with a railroad car, so as to accomplish the end proposed by the means set forth, or by any others which are analogous and dependent upon the same principles."

The defense set up in the pleadings does not deny that defendants use cars constructed as described in the patent, but takes issue on the originality of the invention, averring, among numerous other matters, that the same, or substantially the same, improvement had been previously made and used on the Quincy Railroad, near Boston.

The first bill of exceptions taken on the trial is to the refusal of the court to reject a deposition taken on interrogatories, because the witness had not annexed to it a copy of a former deposition, which, in answer to a previous interrogatory, he admitted he had seen and had used to refresh his memory.

There are two sufficient reasons why this exception cannot be sustained. 1st. By the rules of practice in force in the Circuit Court, such an objection cannot be made on the trial of a "cause, when the party, as in this case, had full

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time and opportunity to move for a suppression of a deposition or a re-examination of the witness.

And second, the paper was not in the power of the witness, but in that of the commissioner, or the plaintiff himself, who might have used it if he thought proper.

After the parties had each given evidence tending to prove the issues between them, and the defendants had closed their testimony, the plaintiff's counsel made nine distinct offers of proof, which were severally overruled as irrelevant, and exceptions taken.

They then proposed eight several instructions, which they requested the court to give to the jury, and took exceptions to the court's refusal. Besides all this, the charge was parceled out into fourteen paragraphs, and an exception taken to each.

To state each one of these thirty-one propositions at length, and discuss them severally, would be a tedious as well as an unprofitable labor.

There was in fact but one question to be decided by the court, viz.: the construction of the patent; the question of novelty being the fact to be passed on by the jury.

The testimony of experts which was rejected, had no relevancy to the facts on which the jury were to pass, but seemed rather to be intended to instruct the court on some mechanical facts or principles on which the court needed no instruction, or to teach them what was the true construction of the patent.

Experts may be examined to explain terms of art, and the state of the art, at any given time.

They may explain to the court and jury the machines, models, or drawings exhibited. They may point out the difference or identity of the mechanical devices involved in their construction. The maxim of "*cuique in sua arte credendum*" permits them to be examined to questions of art or science peculiar to their trade or profession; but professors or mechanics cannot be received to prove to the court or jury what is the proper or legal construction of any instrument of writing. A judge may obtain information from them, if he desire it, on matters which he does

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not clearly comprehend, but consider their opinions as matter of evidence; that opposite opinions of persons may be obtained to any amount, not only many days, but even examinations to test the skill and correctness of time and wearying the patient perplexing, instead of elucidating the issue.

If the construction given by us be correct, and in fact the only capable, as we think it is, it will be to examine experts to teach them to clearly perceive without such instruction how coned wheels to avoid friction and consequence of the fact that the whole

The improvement claimed by us is to remedy, among other things, the difficulty of motion of such wheels in high places offered concerning them, if it would tend only to mislead but not to issue in the case.

The following extracts from the specification given by the judge has given the only language of this specification will have been previously given by Mr. COOPER and again by Mr. Justice NELSON.

"According to the import of the plaintiff's patent and specification, the inventor of 'a new and useful invention for connecting the eight wheels of cars and carriages intended for use upon railroads' which improvement consists in connecting the eight wheels of the car, with a railcar, so as to make such an adjustment of the bearings of the car, as shall enable it to pass curv

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safety and less friction, and as shall at the same time cause the body of the car to pursue a more smooth, even, direct, and safe course over the curvatures and irregularities, and over the straight parts of the road.

"*The manner* of such arrangement and connection is to place upon the upper bolsters of two bearing carriages, each having four wheels, with the flanches of each pair of wheels very near together, the body of a car, so as to rest its weight and have the bearing of the load upon the center or central portion of the bolsters, being also the center or central portion of the bearing carriages; the bolsters of the bearing carriages and car body, respectively, being connected by center pins or bolts, so as to allow them to swivel and turn upon each other, in the manner of the front bolster of a common road wagon, and the bolsters being placed at, near, or beyond the ends of the body.

"And the closeness of the fore and hind wheels of each of the two bearing carriages coupled as remotely from each other as may be desired, or can conveniently be done, for the support of one body, is a most important feature of the invention, with a view to the objects and on the principles set forth in the specification.

"The patentee does not claim to be the inventor of a car body (either for freight or for passengers) of a new or peculiar construction in size or form, nor of any single and wholly separate part of the entire car; but he claims, as his invention, *the manner* of arranging and connecting the eight wheels, which constitute the two bearing carriages, with a railroad car, in the mode and by the means described in his specification, for the ends before described, whether such railroad car is adapted to the transportation of freight or of passengers.

"The leading principle set forth in the specification, upon which the arrangement and connection act to effect the objects aimed at, is, that by the contiguity of the fore and hind wheels of each bearing carriage, and the swiveling motion of the trucks or bearing carriages, the planes of the flanches of the wheels conform more nearly to the line of the rails, and the lateral friction of the flanches on

Notes and Citations.

Patent in suit:

No. . Winans, R. Oct. 1, 1834. Eight-Wheeled Car.

OTHER SUITS ON SAME PATENT:

Winans v. Schenectady & Troy R. Co., 1851. 2 Blatch. 279.

Winans v. Eaton, 1854. 1 Fish. 181.

York & Maryland Line Road Co. v. Winans, 1854. 17 How. 30
[6 Am. & Eng. 221.]

Winans v. New York & Harlem R. Co., 1855. 4 Fish. 1.

Winans v. New York & Erie R. R., 1856. 1 Fish. 213.

Cited:**IN SUPREME COURT OF UNITED STATES:**

Spring Co. v. Edgar, 1879. 99 U. S. 645; Bk. 25, L. ed. 487.

IN CIRCUIT COURTS:

Day v. Stellman, July, 1859. 1 Fish. 487.

IN STATE COURTS:

Jackson v. Allen, March, 1876. 120 Mass. 64.

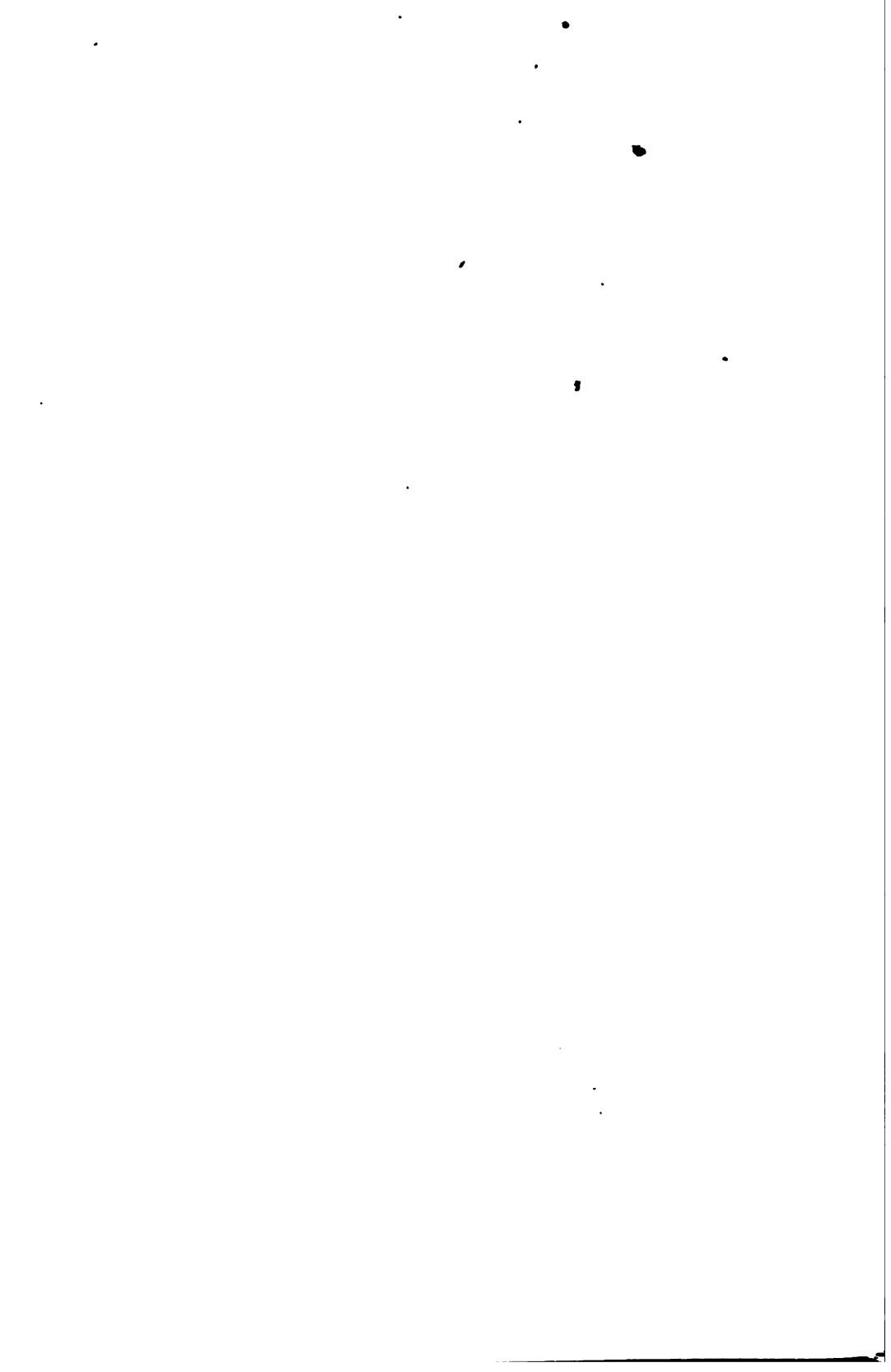
IN TEXT-BOOKS:

2 Abb. Pat. Law, 1886, p. 231.

Curtis on Pats., 4th ed., § 285, note.

Merwin on Pat. Inv't, 1883, p. 422.

Walker on Pats., 1883, p. 134.



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1. Where objection was taken "an Acting Commissioner record contained no ave office, held that it was Line Road *v.* Winans..

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2. The law gives the party aggrieved an appeal from a final decree of an inferior court, but it does not give the party who is not aggrieved an appeal from a decree in his favor, because the judge has given no reasons, or insufficient ones, for a judgment admitted by the appellant to be correct. *Corning v. Troy Iron & Nail Factory*..... 144
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5. By the 23d section of the Judiciary Act, as modified by section 2, Act 1803, the appeal is a *supersedeas*, and stays execution when taken within ten days (Sundays excepted) after *rendering* the judgment or *passing* the decree complained of. The time of rendering the decision or of passing the decree stated. *Silsby v. Foote*..... 388

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Bill of Exceptions.

1. Where the verdict was rendered on December 13, and the bill of exceptions was filed on the next day and no exceptions were taken on the trial, *held* there were no exceptions before the court. *Phelps v. Mayer*..... 10
2. To make a bill of exceptions valid, it must appear by the transcript, not only that the instructions were given or refused at the trial, but also that the party who complains of them excepted to them while the jury were at the bar. *Phelps v. Mayer*..... 10
3. The bill of exceptions need not be drawn out in form and signed before the jury retires, but it must be taken in open court, and must appear, by the certificate of the judge, who authenticates it, to have been so taken. *Phelps v. Mayer*..... 10

Change of Form.

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1. Mere change of form is not patentable invention; but to change the form of an existing machine, and by means of such change to introduce a new mode of operation, and thus attain a new and useful result, is the subject of a patent; and it is the new mode of operation which gives it the character of an invention. *Winans v. Denmead*..... 107

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1. Where, during a subsequent term, a motion was made to dismiss a case on the ground of irregularity in the citation, held that the appearance of the party in this court without making a motion to dismiss during the first term, was a waiver of any irregularity in the citation, and an admission that he had received notice to appear to the writ of error. *Chaffee v. Hayward*..... 371

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1. Under Act 1836, § 6, the claim is required so that the public may know what they are prohibited from doing during the existence of the monopoly, and what they are to have at the end of the term, as a consideration for the grant. *Brooks v. Fiske*..... 15
2. The claim is not to be taken alone, but in connection with the specification and drawings. *Brooks v. Fiske*..... 15
3. A claim is not to be given a limited construction if it can fairly be construed otherwise. *Winans v. Denmead*..... 107
4. When a patentee describes a machine, and then claims it as described, he claims not only the precise forms he has described, but all other forms which embody his invention; and it is an infringement to copy the principle or mode of operation described. *Winans v. Denmead*..... 107
5. The law interprets the claim to extend to the thing patented, however its form or proportions may be varied, without the addition of these words, unless an intention to disclaim some of these forms is manifested. *Winans v. Denmead*. 107
6. Where the claim was ambiguous and equivocal in terms, which might be construed to mean either a process or a machine, but the title of the patent and the specification were for a machine, the claim was construed most favorably for the patentee, "*ut res magis valeat quam pereat*" and not to be for a function, effect or result which would endanger the patent. *Corning v. Burden*..... 69

See Combination, 2; Particular Patents, 5; Patent, 2.

Failure to claim. See Reissue, 2.

Combination.

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1. If a combination has three different known parts, and the result is proposed to be accomplished by the union of all the parts, arranged with reference to each other, the use of two of these parts only combined with a third, which is substantially different in the manner of its arrangement and connection with the others, is not the same combination, and no infringement. *Brooks v. Fiske*..... 15
 2. A claim for a combination of mechanical devices or parts is not infringed by one who uses a part of the combination. *McCormick v. Talcott*..... 410
- See Particular Patents, 3, 8, 9, 10.

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Construction of a Machine.

1. The time when a particular apparatus was "constructed" in the sense of the stipulation was the time when it was attached to the machine (substantially complete in its operative parts); it not being necessary that the machine should be geared and doing work. *Troy Iron & Nail Factory v. Odiorne*..... 238

Construction of Patents.

1. What is the thing patented is a question of law for the court; has it been constructed, used, or sold by the defendants is a question of fact to be submitted to the jury. *Winans v. Denmead*..... 107

Construction of Statutes.

1. Rules governing the construction of statutes. *Brown v. Duchesne*..... 310
2. The 11th section of the Judiciary Act, 1789, is excepted out of, and stands unaffected by, the subsequent process acts or the act conferring jurisdiction on Circuit Courts in patent cases. It applies in its terms to *all* civil suits. *Chaffee v. Hayward*..... 371

Contract.

1. A copartnership agreement between two joint owners of letters patent for the manufacture and sale of the patented machines, stipulating that one of them should conduct the business alone, is not a contract in restraint of trade. *Kinsman v. Parkhurst*..... 273
2. Where, in consideration of an annuity and an indemnity for the expenses of procuring the extension of a certain patent, A appointed B his "trustee and attorney irrevo-

cable to hold said patent, and to have control thereof," in order that it might "inure to the benefit of C," a part owner, "and those who hold a right to the use of said patent under and in connection with his (C's) licensees," reserving the right to use the improvement in his own business, and C acquiesced in the agreement; <i>held</i> that the entire interest and ownership in the patent passed to B for the benefit of C, his licensees, and those holding under him. <i>Hartshorn v. Day</i> 330
3. <i>Held</i> further, that the right to the annuity was not a condition to the vesting of the interest in B, but rested in covenant of an agreement of prior date, and that on a failure to pay it regularly, the power of attorney could not be revoked. <i>Hartshorn v. Day</i> 330
4. The agreement being a sealed instrument, having been partly executed, and long standing rights having grown up under it, evidence that it had been procured through fraudulent representations on the part of B, should not have been admitted. <i>Hartshorn v. Day</i> 330
5. Where it was alleged that a certain instrument was procured by fraud from C, <i>held</i> , that it was too late to set up any such ground of defense after C himself had carried the agreement into execution and acted under it, receiving its benefits for three years. <i>Day v. The Union India Rubber Company</i> 383
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Copartnership.

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Corporation.

1. The law will strip a corporation or individual of every disguise, and enforce a responsibility according to the very right, in despite of all artifices. *York & Maryland Line Road v. Winans*..... 221

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Counsel.

2. The absence of one or of all the counsel employed by one
party in pursuit of other business, furnishes no ground
for delaying a case in this court, without the consent of
the adverse party. *Chaffee v. Hayward*..... 371

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Damages.

1. Where punitive damages had been granted by a master in chancery on an account of profits for the use of an infringing machine and a decree awarded thereon, *held* that they were not warranted by the well-established rules of equity, and the decree was reversed. *Livingston v. Woodworth* 167
 2. The patent Act of 1836 confines the jury to the assessment of "actual damages." The power to inflict punitive damages is committed to the discretion and judgment of the court. *Seymour v. McCormick* 200
 3. Actual damages must be actually proved, and cannot be assumed as a legal inference from any facts which amount not to actual proof of the fact. *Seymour v. McCormick* 200
 4. Where an inventor finds it profitable to exercise his monopoly by selling licenses to make or use his improvement, he has himself fixed the average of his actual damage, when his invention has been used without his license. *Seymour v. McCormick* 200
 5. Measure of damages. Acts of 1790, 1800, and 1836 reviewed. *Seymour v. McCormick* 200
 6. There can be no general rule of damages which will apply equally to all cases. The reason stated. *Seymour v. McCormick* 200
 7. In the suit for the infringement of patent No. 5335, McCormick, C. H., October 23, 1847, Harvester, which was an improvement on a prior patented machine of his, *held* that it was error to instruct the jury, that as to the measure of damages the same rule is to govern, whether the patent covers an entire machine or an improvement on a machine. *Seymour v. McCormick* 200
 8. Where plaintiffs were exclusive territorial assignees, the rule of damages for the user complained of was the amount of profits received by the unlawful use of the machines, and not the amount defendant might have made by reasonable diligence. *Dean v. Mason* 361
 9. Decree as to amount of damages, but with interest disallowed, affirmed by a divided court. *Silsby v. Foote* 392
- See Mitigation of Damages, 1, 2, 3.

Decree.

1. The court below having not yet acted upon the mandate of this court, and entered a final decree in pursuance thereof, there is no final decree from which only an appeal can be taken. *Corning v. Troy Iron & Nail Factory* 144

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2. A decree by consent "that the complainants are entitled to the perpetual injunction and the account prayed for by the bill," does not bind the defendants not to object to the report of the master on an accounting for profits, and not to appeal from the order confirming it. <i>Livingston v. Woodworth</i>	167
3. The time of rendering a decision or of passing a decree stated. <i>Silsby v. Foote</i>	388
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Delay.

In filing disclaimer. See Disclaimer, 1, 2.	
In reissuing. See Reissue, 5.	

Disclaimer.

1. The granting of a patent for the improvement, together with the opinion of the court below maintaining its validity, repel any inference of unreasonable delay in filing a disclaimer to a claim alleged to be wanting in novelty. <i>Seymour v. McCormick</i>	282
2. Where the alleged anticipating device had been produced after suit had been commenced, and its relevancy had been questioned from thence to the present time, and disclaimer thereto was not yet entered, held there was no unreasonable delay in entering it. <i>Silsby v. Foote</i>	392

Drawing.

See Claim, 2.	
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Equivalents.

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Estoppel.

1. Held that the defendant, partner and joint owner with complainant respecting a patent right, could not secretly acquire and set up an outstanding right against his joint owner. <i>Kinsman v. Parkhurst</i>	273
2. Where defendants (partners of complainants) had made and sold patented machines under complainant's title and for his account, held that they were estopped from alleging the invalidity of complainant's patent. <i>Kinsman v. Parkhurst</i>	273

See Decree, 2.	
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Evidence.

1. Under the Acts of 1836 and 1839 the patent is <i>prima facie</i> evidence of the truth of the facts asserted in it. <i>Corning v. Burden</i>	69
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2. Where defendants infringers justified under a later patent, held that the court erred in refusing to permit them to read it to the jury. <i>Corning v. Burden</i> 69
See Contract, 4; Experts, 2; Publication, 1.

Exceptions.

1. Exceptions to master's report should be taken in the court below; it is too late to object to it here for the first time. <i>Kinsman v. Parkhurst</i> 273
2. Where on a bill for an injunction to restrain a defendant for the use of a patented machine, the objection of misjoiner of the plaintiffs, the assignor and his assignee within a limited locality was first raised after the hearing and final decree, held that the objection came too late; held, further, that the objection had been waived by defen- dants having expressly consented to a decree upon the record. <i>Livingston v. Woodworth</i> 167
3. Where exception was taken to the refusal of the court to reject a deposition taken on interrogatories before a com- missioner it was overruled, because by the rules of prac- tice in the Circuit Court of New York such an objection cannot be made on trial of a cause, when the party had full time and opportunity to move for a suppression of the deposition or a re-examination of the witness. <i>Winans v. New York & Erie R. R. Co.</i> 440
4. And because the copy of a former deposition referred to by witness, but not annexed to his deposition, was not in his power, but in that of the commissioner. <i>Winans v. New York & Erie R. R. Co.</i> 440

See Acting Commissioner, 1; Bill of Exceptions, 2.

Experts.

1. Experts may be examined as to the meaning of terms of art, but not as to the construction of written instruments. The refusal of the court to hear their opinion as to the construction of a patent held proper. <i>Corning v. Burden</i> . 69
2. Experts may be examined to explain terms of art, and the state of the art at any given time. They may explain to the court the machines, works, or drawings exhibited; they may point out the difference or identity of the mechanical devices involved in their construction, but they cannot be received to prove to the court or jury what is the proper or legal construction of any instrument in writing. Expert evidence construing the patent held properly excluded. <i>Winans v. New York & Erie R. R. Co.</i> 440

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Form.

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| 1. Where form and substance are inseparable it is enough to look
but to the form only to determine the question of infringement; where separable, the substance must be looked for.
<i>Winans v. Denmead</i> | 107 |

See Change of Form, 1; Particular Patents, 7.

Fraud.

See Contract 4, 5; Reissue, 1.

Function.

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| 1. "Function" of a machine defined; it is not patentable.
<i>Corning v. Burden</i> | 69 |
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Identity.

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| 1. Of original and reissue letters patent.
See Questions for Jury, 1. | |
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Improvement.

- | | |
|--|-----|
| 1. But if the invention be an improvement on a known machine
by a mere change of form or combination of parts, the
patentee cannot treat another as an infringer who has
improved the original machine by the use of a different
form or combination performing the same functions.
<i>McCormick v. Talcott</i> | 410 |
|--|-----|

See Damages, 7; Infringer, 2; Particular Patents, 6.

Infringer.

- | | |
|--|-----|
| 1. Where the York and Maryland Line Railroad Co. (plaintiffs), whose stock was subscribed for by a Maryland company, partly owned the motive power on the road, employed and paid the agents and officers, and the cars constituting the alleged infringement were fitted and repaired at the common expense of the two corporations, held that plaintiff was a principal, coöperating with another corporation in the infliction of a wrong, and directly responsible for resulting damages. <i>York and Maryland Line Road v. Winans</i> | 221 |
| 2. The original inventor of a device or machine will have a right to treat as infringers all who make machines operating on the same principle and performing the same functions by analogous means or equivalent combinations, even though the infringing machine may be an improvement of the original and patentable as such. <i>McCormick v. Talcott</i> | 410 |

See Evidence, 2; Improvement, 1.

Infringement.

- PAGE
1. The rights of property and exclusive use granted to a patentee do not extend to a foreign vessel lawfully entering one of our ports, and the use of an improvement patented in the United States in the construction, fitting out, or equipment of such vessel, while she is coming into or going out of a port of the United States is not an infringement of the right of an American patentee, provided it was placed upon her in a foreign port, and authorized by the laws of the country to which she belongs. *Brown v. Duchesne*... 310
See Claim, 4; Combination, 1, 2; Form, 1.

Innocent Infringer.

See Mitigation of Damages, 1, 2, 3.

Interest.

See Damages, 9.

Invalidity of Patent.

1. Where defendants (partners of complainants) had actually received profits from the sales of the patented machines, which profits they did not show to have been, or to be, in any way liable to be affected by the invalidity of the patent, held in view of a certain agreement between defendants and complainants, that the invalidity of the patent was immaterial, and no bar to complainant's right to an account. *Kinsman v. Parkhurst*..... 273

See Estoppel, 2.

Invention.

See Change of Form, 1; Patent, 1.

Inventor.

1. An inventor has no right of property in his invention upon which he can maintain a suit, unless he obtains a patent for it according to the acts of Congress. *Brown v. Duchesne*..... 310

Joint Owners.

See Contract, 1; Estoppel, 1.

Judicial Notice.

See Notice 1.

Jurisdiction.

1. Where, after a case decided and a mandate issued to the court below, a second writ of error was sued out, bringing up for revision only the proceedings subsequent to the man-

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date, the only question before the court was that of costs, which had been taxed less than \$2,000, held that the court had no jurisdiction under Act 1789. <i>Sizer v. Many</i> ... 189	
2. Held further that the court had no jurisdiction under Act 1836, § 17, which is confined to cases involving the construction of the patent laws, and the claims and rights of patentees under them. That the amount of costs which either party shall be entitled to recover is not regulated by these laws. <i>Sizer v. Many</i> 189	
3. Section 11 of Judiciary Act 1789, construed to mean that jurisdiction of the person of a defendant who is an inhabitant of another State, can only be obtained in a civil action, by service of process on his person within the district where the suit is instituted; and that no jurisdiction can be acquired by attaching property of a non-resident defendant, pursuant to State law. <i>Chaffee v. Hayward</i> 371	
4. Where complainants sought the aid of the court to prevent the fraudulent violation of certain contracts, and asked for an injunction, held that it was a proceeding founded on a contract, and the matter in controversy being less than \$2,000 in value, the court had no appellate power. <i>Brown v. Shannon</i> 354	
5. The value of the matter in controversy cannot be estimated from the penalty of the bond, when the injunction was granted in order to confer jurisdiction on appeal, where it would otherwise be less than \$2,000. <i>Brown v. Shannon</i> 354	
6. The patent laws of the United States have no extra territorial jurisdiction. <i>Brown v. Duchesne</i> 310	

License.

1. Licensee, and rights of licensees thereunder, construed in conformity with the decision in <i>Hartshorn v. Day</i> , 19 How. 211 [p. 330 <i>ante</i>], <i>Day v. The Union India Rubber Co</i>	383
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License Fee.

See *Damages*, 4.

Machine.

See *Claim*, 4; *Construction of Machine*, 1; *Function*, 1; *Process*, 1.

Mandate.

See *Decree*, 1; *Writ of Error*, 1.

Master's Report.

See *Exceptions*, 1.

Method.

See Process, 2.

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Mitigation of Damages.

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| 1. Where a defendant uses a patented machine he has a presumption in his favor, arising from the grant of the patent, that it is new and not an infringement of the patent previously granted to the plaintiff. <i>Corning v. Burden</i> | 69 |
| 2. It shows that the defendant has acted in good faith, is not a wanton infringer, and subject to the same stringent rule of damages which might be justly inflicted on a mere pirate. <i>Corning v. Burden</i> | 69 |
| 3. Where defendants were operating under a patent, held that they were not wanton infringers, neither subject to punitive damages, but were liable only to the extent of their actual gains and profits. <i>Livingston v. Woodworth</i> | 167 |

Notice.

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|---|-----|
| 1. Held further that the court will take notice judicially of the persons who from time to time preside over the Patent Office, whether permanently or transiently. <i>York & Maryland Line Road v. Winans</i> ,..... | 221 |
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- See Assignee, 1 ; Citation, 1.

Novelty.

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| 1. Presumption of, on grant of patent.
See Mitigation of Damages, 1 ; Questions for Jury, 1. | |
|---|--|

Particular Patents.

- | | |
|--|-----|
| 1. Patent granted Winans, R., October 1, 1834, Eight-Wheeled Car construed to be for an improvement consisting in the manner of arranging and connecting the eight wheels. <i>Winans v. New York & Erie R. R. Co</i> | 440 |
| 2. Held that a particular machine was set up and substantially finished prior to the application of H. Burden, made April 18, 1839, for letters patent No. 1757, granted Sept. 2, 1840, "spike-making machine." <i>Troy Iron & Nail Factory v. Odiorne</i> | 238 |
| 3. Patent No. 1890, Burden, H., Dec. 10, 1840, Rolling Puddle Balls, the claim in view of its ambiguity, construed, in order to be sustained, to be for a new machine or combination of mechanical devices, and not for a process. <i>Corning v. Burden</i> | 69 |
| 4. Claim 2 of Letters Patent No. 2636, Foote, E., May 26, 1842, cooking stove disproved by prior construction and use of Saxon stove; otherwise sustained. <i>Silsby v. Foote</i> | 392 |

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5. Claim 2 of patent No. 3895, C. H. McCormick, January 31, 1845, Havester, viz.: "I claim the reversed angle of the teeth of the blade in the manner described," construed to claim the reversed angle of the teeth of the blade, and not to be in combination with another element, in view of the words "in the manner described," as charged by the court below. <i>Seymour v. McCormick</i>	282
6. Claim 4 of Letters Patent No. 3895, McCormick, C. H., January 21, 1845, Harvester, construed to be for a novel form or combination, constituting an improvement on prior machines, and therefore the doctrine of equivalents cannot be invoked to treat as an infringement defendant's machine differing in combination because it performs the same functions as well or better; fifth claim is not infringed. <i>McCormick v. Talcott</i>	410
7. Patent No. 5175 granted Winans, R., June 26, 1847. Coal Car construed to be for a patentable change of form introducing a new mode of operation, and held that while patentee described and claimed a car-body "in the form of a frustum of a cone," it also included (in view of words "substantially as described") such variations of form as substantially embodied his mode of operation and thereby attained the same result. <i>Winans v. Denmead</i>	107
8. Claim 2 of reissue, letters patent No. 239, McCormick, C. H., May 24, 1853, Harvester, construed and limited in order to be sustained, to the location of one of its elements, a combination of the reel with a seat "arranged and located as described," and not infringed by device differing in form, principle, and combination. <i>McCormick v. Talcott</i>	410
9. Reissue No. 71. Woodworth, July 8, 1845. Planing mill, construed to be for a combination of three elements. <i>Brooks v. Fiske</i>	15
10. The combination of three elements claimed in reissue No. 71, held not infringed by the different combination in Norcross' Patent No. 7,087, February 12, 1850, Planing Machine, which is a novel and independent invention. <i>Brooks v. Fiske</i>	15

Patent.

1. It is for the discovery or invention of some practical method or means of producing a beneficial result or effect that a patent is granted, and not for the result or effect itself. *Corning v. Burden*.....
- 69
2. Under Act 1837, § 9, notwithstanding that patentee claims too much, the patent is good for what is truly his, and he is entitled to maintain a suit at law for its infringement. *Silsby v. Foote*.....
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See Evidence, 1, 2; Inventor, 1; Mitigation of Damages, 1, 2, 3.

Patentability.

See Function, 1; Process, 2.

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Power of Attorney.

See Contract, 3.

Practice.***Motion to Dismiss.***

1. Motion to dismiss complainants' bill upon proof that they had parted with their interest in the subject matter of the suit, held properly overruled, where the transfer was subsequent to the date to which the account of profits had been brought down. *Dean v. Mason*..... 361

Motion to File an Answer.

2. A motion to amend or file an answer after default is generally addressed to the discretion of the court, and is not subject to the revision of this court. *Dean v. Mason*..... 361
3. Where motion to file an answer was not made until three years after the decree *pro confesso* had been entered, and a reference made to a master for an account, held that on such grounds the decree could not be reversed. *Dean v. Mason*..... 361

Motion to Argue.

4. The questions which go to the merits having been fully heard and decided in *O'Reilly v. Morse*, 15 How. 62 [5 Am. & Eng. 483], the motion to argue the points certified overruled and the case remanded to the Circuit Court. *Smith v. Ely*..... 1

Presumption.

See Mitigation of Damages, 1.

Process.

1. "Process," "art," and "machine" distinguished and defined. *Corning v. Burden*..... 69
2. It is when the term process is used to represent the means or method of producing a result, that it is patentable, and it will include all methods or means which are not effected by mechanism or mechanical combinations. *Corning v. Burden*..... 69

See Claim, 6; Particular Patents, 3.

Publication.

1. Under Act 1836, § 15, a prior publication describing a partially successful working machine is no evidence of its continued successful operation in the interim between such date of publication and a subsequent date when it was also shown to be in successful operation. *Seymour v. McCormick*..... 282

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Punitive Damages.

See Damages, 1, 2; Mitigation of Damages, 3.

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Questions for Jury.

1. It is the right of the jury to determine; whether the specifications, including the claim, were so precise as to enable any one skilled in the structure of machines to make the one described; the novelty of the invention; the identity of the invention in the original and renewed patent; the abandonment of the invention to the public. Battin *v.* Taggart 243

See Construction of Patents, 1.

Reissue.

1. Procuring a reissue to cover the use of a device, not hinted at as necessary in the original claim and specification, raises a question of fraud committed on the public, by giving such matter the date of the original discovery, and thereby overreaching similar inventions made between the date of the original and reissued patent. Brooks *v.* Fiske 15
2. Where suit was brought on a reissue made nearly six years after the original patent, and claiming matter therein shown but not claimed, and the judge charged the jury that the failure to claim in the original, the matter described, was a dedication of it to the public, and could not be revoked after it had passed into public use, either by reissue or otherwise. The instruction was held erroneous. Battin *v.* Taggart 243
3. Whether the defect be in the specifications, or in the claim under Act 1836, § 13, the patentee may surrender his patent, and by an amended specification or claim cure the defect. Battin *v.* Taggart 243
4. But a new and different invention cannot be claimed. Battin *v.* Taggart 243
5. Where on reissue made six years subsequent to the original patent, the reissue "described essentially the same machine as the former one did, but claimed as the thing invented the breaking apparatus only," whereas the original claimed the breaking and screening apparatus, held that patentee had a right to do this; he had a right to restrict or enlarge his claim, so as to give it validity and effectuate his invention. Battin *v.* Taggart 243

See Particular Patents, 8, 9, 10; Questions for Jury, 1.

Reversal.

See Practice, 3.

Right of Action.

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See Inventor, 1; Patent, 2.

Right of Property.

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See Infringement, 1; Inventor, 1.

*Specification.**Sufficient Description.*

PAGE

See Claim, 2; See Questions for Jury, 1.

Statutes.

- Act 1789, § 11; Judiciary Act. See Construction of Statutes, 2; Jurisdiction, 1, 3.
- Act 1790. See Damages, 5.
- Act 1800. See Damages, 5.
- Act 1836. See Damages, 2, 5; Evidence, 1.
- " " " § 6. See Claim, 1.
- " " " § 13. See Abandonment, 1; Reissue, 3.
- " " " § 15. See Publication, 1.
- " " " § 17. See Jurisdiction, 2.
- Act 1837, § 9. See Patent, 2.
- Act 1839. See Evidence, 1.

"Substantially as Described."

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See Particular Patents, 5, 7.

Territorial Assignee.

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See Damages, 8.

Waiver.

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See Citation, 1; Exceptions, 2.

Writ of Error.

1. After a case has been brought to the Supreme Court and decided and a mandate issued to the Court below, if a second writ of error is sued out, it brings up for revision nothing but the proceedings subsequent to the mandate. *Sizer v. Many* 189

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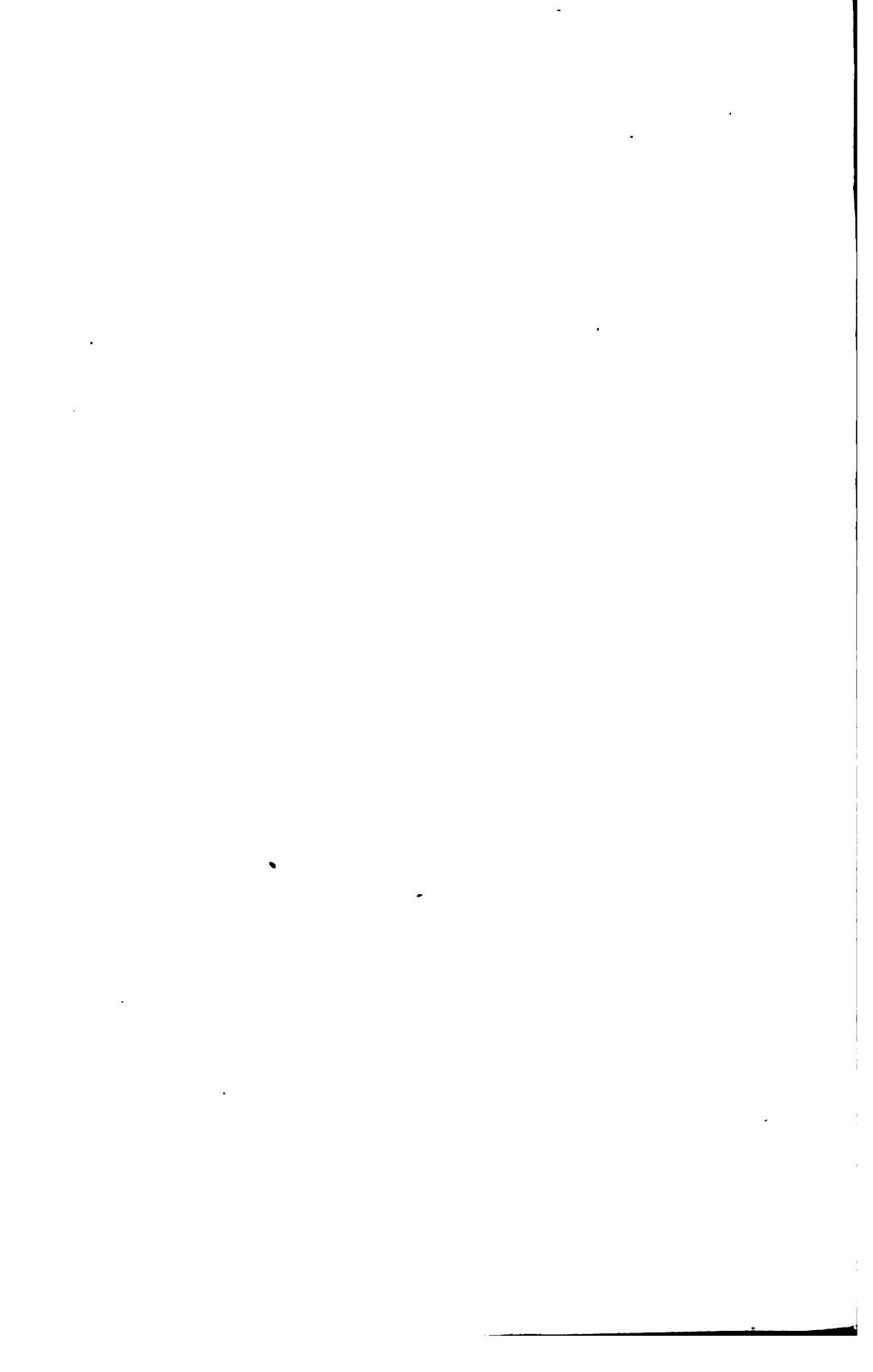
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